A

TREATISE ON THE LAW

RELATIVE TO

PATENT PRIVILEGES

FOR

THE SOLE USE OF INVENTIONS:

AND

THE PRACTICE OF OBTAINING

LETTERS PATENTS FOR INVENTIONS,

WITH AN

APPENDIX OF FORMS AND ENTRIES.

By W. M. HINDMARCH, Esq.,
BARRISTER-AT-LAW.

AND WITH A SECOND APPENDIX OF THE ACTS OF CONGRESS, AND DECISIONS OF THE COURTS OF THE UNITED STATES, AND FORMS FOR OBTAINING LETTERS PATENT.

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PREFACE.

THE improved state of the law relating to Patent privileges, and the great and increasing importance of the subject to the profession and the public, seem to demand a treatise exhibiting the law and practice in all its details.

It was with the view of supplying the acknowledged want of such a treatise, (*a*) that I commenced this work; but it is not without apprehension as to the success of my performance, that it is now submitted to the public.

The difficulty attending the performance of such an undertaking, however, will be readily acknowledged by all, who have given any attention to this branch of the law; and if I have succeeded in producing a work which throws any additional light upon the subject, or facilitates the labours of the practitioner, I shall be amply repaid for my exertions.

In preparing those parts of the work which relate to the practice in *Scire Facias*, and in the Privy Council, and the practice of obtaining patents, entering disclaimers, &c., I have been favoured with the assistance of the officers by whom the various proceedings are conducted or prepared. To each of those gentlemen I have submitted so much of the following sheets, as relates to his particular office or department; and I have not stated any thing on the subject of practice, which has not been approved of by the authorities I have mentioned.

The Forms which I have given in the Appendix, have been prepared with the greatest care, and with very few exceptions, have been actually used in practice. In order to make the use of these forms in practice more readily understood, the blanks have been filled up, and printed in italic letters, so as to represent more accurately the forms of real proceedings.

In conclusion, I beg to tender my best thanks to all my professional friends; and also to all the gentlemen in the public offices, for the valuable information which they have so liberally afforded me respecting the various matters treated of in this work.

7, KING'S BENCH WALK,
February, 1846.

(*a*) This is not intended as any disparagement of the many useful works on Patent Law which have been published.

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A

TREATISE

ON

THE LAW OF PATENTS.

CHAPTER I.

INTRODUCTION.

THE right of property in moveable chattels was recognized in the earliest periods, and is founded on the law of nature. (*a*) But it was very different with respect to the sole right to use an invention, which had its origin in an advanced state of society, and not until after improvements in the arts had made considerable progress.

It has often been asserted, that according to the principles of universal equity, an inventor has an exclusive property in his invention. But it is clear, that independent of positive law, he has no such exclusive property, any longer than he keeps it secret; for no one who first makes any discovery can thereby acquire the right to prevent others from *making* and using the same discovery. He may, if he pleases, conceal his discovery from the world, but the moment he publishes it, he abandons his *exclusive* property in it, and others acquire a right to use the invention in any manner they please. The exclusive right to use an invention after it is published, can only have existence therefore by virtue of some positive law, which is made with the actual or implied consent of the whole community.

Every member of the community receives many benefits from the society in which he lives, and he is therefore bound, *by every means in his power, to advance its interests. And it seems to be but reasonable [*2] that he should be expected to promote the public weal by putting the community in possession of any discovery he makes which may be for the public good. But invention is generally the result of much study and labour, accompanied with a considerable expenditure of time and money, and few persons have the requisite ability and inclination, without the hope of reward, to search for improvements in the arts for the benefit of the public.

The whole community is benefited by the promotion of the useful arts, and, therefore, it is for the public good to hold out the promise of rewards to the inventors of new and useful arts and manufactures, who may first put the public in possession of them.

(*a*) See Wollaston's Religion of Nature, s. vi; Locke on Government, b. 2, c. 5; 2 Bl. Com. cc. 1. 24, 25, 26, and the authorities there referred to.

In some cases, where meritorious inventors could not be otherwise adequately rewarded, sums of money have been granted to them out of the public purse; (*b*) but such a mode of recompense, it is clear, could not be generally adopted.

The mode of rewarding inventors, which has been adopted in this country, seems to be the best that could be devised:—it is by granting the inventor a monopoly in his invention for a limited time. It is true that by such a grant every other person is restrained during the continuance of the monopoly from using the patent invention, even if he makes a similar discovery himself. But at the time the grant is made, it is by no means certain that the invention will be given to the public, or even made by any other person, and by the temporary suspension of their right, the people acquire the certainty of being able to use the invention at the expiration of the monopoly. The reward which an inventor thus obtains, will, in general, be in proportion to the benefit which he confers upon the public, for the greater the utility of the invention, the more profitable will it be to the grantee of the monopoly.

Speaking of such a grant, *Sir Edward Coke* says, (*c*) "The reason wherefore such a privilege is good in law is because the inventor bringeth to and for
[*3] the commonwealth a new manufacture *by his invention, costs, and charges, and therefore it is reason that he should have a privilege for his reward, (and the encouragement of others in the like) for a convenient time."

Utility to the public is, in fact, the consideration for every grant of the sole use of an invention, and letters patent, containing such grants, always state the public good to be the motive of the Crown in making the grants. (*d*) It is not every thing invented, therefore, to the sole use of which the inventor can become entitled, for the thing itself (although perfectly new) may be of no value whatsoever to the public. And an exclusive right vested in any one to use a thing, which at the time it is given or offered to the public, is of itself of no value, might prevent others from bringing forward useful and profitable inventions, by reason of such otherwise useless thing forming part of their inventions. If an invention is useful to the inventor, and useless to the public, the inventor does not suffer any injury by having no legal right to the exclusive use of it; for no one would infringe the right if he had it, and the legal right could not be any source of profit to him; and if he should fear that he himself would be deprived of the right to use his invention by reason of its being included in a grant to some other person, he might most effectually prevent that by publishing it to the world. Still less will the inventor be injured for want of such an exclusive right if the invention is of no utility either to himself or the public, and he cannot have any right by means of his useless invention to anticipate and appropriate to himself any part of the profit to arise from the subsequent invention of any other person who may be able by his ingenuity to confer an actual benefit upon the public.

The total absence of utility to the public in any invention will at all times, therefore, vitiate a grant of the sole use of it; but it will not be void on that ground, if the invention was of any utility to the public, although such utility may be very small. (*e*)

But an invention may happen to be of some use to the public, and yet it
[*4] may be so trifling or frivolous that the inconvenience to the public, arising from the grant of the sole *use of it, would not be adequately

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(*b*) See a list of cases in Parl. Rep. on Patents, 1829, App. p. 181.
(*c*) 3 Inst. 184.
(*d*) See c. iv. and c. v. s. 3, *post*, and the Index, tit. Utility.
(*e*) Vide *post*, c. v. s. 3.

compensated by the benefit which the public would receive from it. The law has deemed it right, therefore, that mere discovery of any new manufacture shall not vest the sole right to use it in the inventor; but that in order to become entitled to such a sole privilege, he must obtain a grant of it from the Crown, in whom the law has vested the power (which it exercises through its ministers) of judging, not only whether the invention is likely to be of so much utility to the public as to render the making of the grant *a matter of public expediency*, but also what duration of privilege (not exceeding fourteen years) the invention merits.

Accordingly inventors are *never entitled as of right* to letters patent, granting them the sole use of their inventions, but they must obtain them from the Crown by petition, and *as a matter of grace and favour*, and letters patent always express that the grant is so made.

It is impossible to ascertain with certainty when such grants of the sole use of inventions were first made in this country, but there is reason to believe that this prerogative of the Crown is very ancient.

Thus in a case decided in the reign of Edward the Third, (*f*) it is said that arts and sciences which are for the public good are greatly favoured in law, and the King, as chief guardian of the common weal, has power and authority by his prerogative to grant many privileges *for the sake of the public good*, although *primâ facie* they appear to be clearly against common right.

And it is stated at the end of the report of the case of *Darcy* v. *Allen* in Sir Francis Moore's Reports, (*g*) that in the time of Edward III., some alchymists persuaded the King that a philosopher's stone might be made, that the King granted a commission to two fryers and two aldermen to enquire if it was feasible, who certified that it was, and that the King granted to the two aldermen a patent of privilege, that they and their assigns should have the sole making of the philosopher's stone.

There is reason to believe that the practice of making grants [*5] *of the sole use of inventions originated in England, and that the English system of rewarding inventors has since been copied more or less closely by almost every European power.

It is quite certain that in England the Crown derives its power to grant such letters patent from the Common Law itself, but restrained by the Statute of Monopolies, which was little more than a declaration of the Common Law on the subject.

Although it seems that the law has at all times permitted the grant of such limited monopolies as the exclusive right to use new inventions, (*h*) yet almost all other grants of monopolies by the Crown were contrary to the Common Law, and the legislature in former times frequently interfered to repress them. (*i*)

Nothwithstanding the illegality of all monopolies (except those for the sole use of new inventions,) they were very frequently granted in former times, but the continual encroachments of the prerogative upon the Common Law in this way, particularly during the reigns of Elizabeth and James I., led at last to the passing of the celebrated Statute of Monopolies in the 21st year of the reign of the latter monarch; by which the Crown was effectually restrained from making such extravagant and illegal grants.

It is by that statute declared, that all monopolies whatsoever are contrary to law, and void; with a saving however of letters patent and grants of the sole

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(*f*) Year Book, part iv. 40 Edw. III. fol. 17, 18.

(*g*) P. 675. (*h*) Vide *post*, c. ii.

(*i*) See Mag. ch. c. 30; 9 Edw. III. st. 1, c. 1; Stat. of Cloths, 25 Edw. III. c. 2; *Statutum de Stapulis*, 27 Edw. III. st. 2; 28 Edw. III. c. 13, s. 3; 31 Edw. III. c. 10; 2 Rich. II. st. 1, c. 1; 7 Hen. VII. c. 9, & 12 Hen. VII. c. 6.

privilege of working or making of new manufactures to the first inventors thereof. The provisions of this statute, material to the subject, will be minutely considered in the subsequent chapters of this work.

The 5 & 6 Will. IV. c. 83, the 2 & 3 Vict. c. 67, and 7 & 8 Vict. c. 69, are the only other public general acts relating to patents which have been passed since the Statute of Monopolies. These statutes provide a remedy for many of the deficiencies of the old law, and they also will be considered in the following pages.

For many years after the passing of the Statute of Monopolies the arts and manufactures continued in a low state in this *country, few of the [*6] inventions for which letters patent were obtained were of any value, and the demand for novelties being very limited, no one was tempted to infringe the rights of patentees. Our law reports, from the time of the passing of that statute, therefore, until the reign of George III., are almost entirely silent respecting such patent privileges; and indeed the case of *Edgeberry* v. *Stephens*, reported in the second volume of Salkeld's Reports, (*j*) is almost the only case to be found during that period.

The first case of importance respecting a patent was an action of *scire facias* brought against Mr. Arkwright, to repeal his patent for an invention of certain instruments or machines for preparing silk, cotton, flax, and wool for spinning, which was tried in June, 1785. (*k*)

About ten years afterwards the important cases of *Boulton and Watt* v. *Bull*, (*l*) and *Hornblower* v. *Boulton and Watt* (*m*) were tried, in which this branch of our law was much discussed, and many of its difficulties and obscurities cleared away.

Since that period the number of causes respecting letters patent has gone on steadily increasing, in consequence of which, and the magnitude of the interests concerned in it, the patent law of his country has become of the greatest importance to the community, more particularly those engaged in trade or manufactures.

There is now, perhaps, hardly any part of the law relating to patents which has not been made the subject of judicial investigation and determination; and this branch of our law may therefore now be said to have at last assumed the form of a regular system, and the relative rights of the public and of patentees, as well as the prerogative of the Crown, to have been determined with at least a very considerable degree of certainty.

There is yet, however, much wanting to render the law any thing like perfect; but the greater part of the deficiencies can only be supplied by the legislature. Unfortunately there is little chance of the required remedies being applied at present, or indeed at all, whilst party strife shall continue to occupy so much of the time and attention of parliament.

(*j*) P. 447.
(*k*) See a report of the case in Davies's Patent Cases, p. 61.
(*l*) 2 H. Bl. 463. (*m*) 8 T. R. 95.

*CHAPTER II. [*7]

OF THE GRANTOR OF A PATENT, AND THE POWER OF THE CROWN TO GRANT THE SOLE USE OF INVENTIONS.

It is quite clear that the prerogative of the Crown to grant the sole use of inventions is derived from the Common Law itself, and not from any statute.

This prerogative is vested in the Crown, as the depositary of the supreme executive power of the state, to be exercised on the behalf of, (*a*) and for the benefit of the public. (*b*) It is inseparably annexed to the Crown, and cannot be granted to a subject, (*c*) nor can any private person create a legal monopoly. (*d*)

There is no statute to be found made prior to the Statute of Monopolies, (*e*) which relates to grants of the sole use of inventions, although many acts have been passed for suppressing various illegal monopolies. (*f*) There are authorities, however, in our ancient law books, which show that before the passing of the Statute of Monopolies, the Crown had power at the Common Law to make such grants.

Thus in the case of monopolies, *Darcy* v. *Allin*, (*g*) it is said that "Where any man, by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before: and that for the good of the realm: that in such cases the King may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth bring by his invention to the commonwealth: otherwise not."

And in the same report (*g*) it is stated, that in the 9 Elizabeth, [*8] *there was a patent granted to Mr. Hastings of the Court, that in consideration that he brought in the skill of making of frisadoes, as they were made in Harlem and Amsterdam beyond the seas, being not used in England; that, therefore, he should have the sole trade of the making and selling thereof for divers years; charging all other subjects not to make any frisadoes in England during that time, under a penalty of 100*l.* The patentee having filed a bill in the Exchequer against certain clothiers of Coxall, for making frisadoes contrary to the intent of the patent, it appeared, upon the examination of the cause, that the same clothiers did make baies very like to Mr. Hastings's frisadoes, and that they used them before Mr. Hastings's patent, for which cause they were neither punished nor restrained from making their baies like to his frisadoes.

So in the report of the case of monopolies contained in Moore's Reports, (*h*) it is said that the Queen could not grant a patent to restrain the people in their usual trades and occupations; and that no occupation could be prohibited or put into a monopoly, but solely such thing as is newly invented by the skill of man, which may be granted by patent.

In the *Clothworkers of Ipswick* case, (*i*) it is said, "If a man hath brought in a new invention, and a new trade within the kingdom in peril of his life, and

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(*a*) Per Lord Eldon, L. C., in Harmer v. Playne, 14 Ves. 132.

(*b*) Bac. Abr. tit. Prerog. and see Year Book, 40 Edw. III. fol. 18.

(*c*) 3 Shep. Abr. Prerog. p. 57, s. (7) and p. 54; Skin. 606; Jenkins, p. 304; Bro. Pat. 13, and ibid. Prerog. 18.

(*d*) Hawk. P. Cr. bk. I. c. 79.

(*e*) 21 Ja. I. c. 3.

(*f*) See those referred to, *ante*, p. 5, n. (*i*).

(*g*) Noy, R. 182.

(*h*) Darcy v. Allen, F. Moore, 672.

(*i*) Godb. 252, 254; S. C. 1 Rol. R. 4.

consumption of his estate, or stock, &c., or if a man hath made a new discovery of any thing: in such cases the King, of his grace and favour, in recompense of his costs and travail, may grant by charter unto him, that he only shall use such a trade or trafique for a certain time, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it: but when that patent is expired, the King cannot make a new grant thereof. For when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it."

In the case of *Mitchell* v. *Reynolds*, (*k*) it is laid down by *Parker*, C. J. that "the grant of the sole use of a trade is void, but a grant of a trade newly invented and for a time is good; for the public has an advantage in the invention of a *useful trade, which, after a limited time, is to be public, and the inventor's industry is sufficiently encouraged by the sole use of it secured to him by charter for such a time."

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In Sheppard's Abridgment, (*l*) it is laid down that it is generally held by the Judges, that the King may, for a reasonable time, grant a monopoly patent of that which any man at his own charge, wit, and invention, shall bring in as a new trade or device into the realm; or any new engine tending to the furtherance of it, for the good of the realm.

And Serjeant *Hawkins* says, (*m*) "It seemeth clear that the King may, for a reasonable time, make a grant to any one, of the sole use of an art invented, or first brought into the realm by the grantee."

And *Sir Edward Coke* says, in his Chapter of Monopolies in the Third Institute, (*n*) that such a monopoly is good, and gives the reasons for it. (*o*)

The extent of the prerogative thus vested in the Crown having been grossly abused, a declaratory statute was passed in the 21st year of the reign of James I., (1623) by which the power of the Crown to make such grants was confined within certain limits; and all other grants of monopolies were declared to be void. (*p*) This act has been frequently, but erroneously, supposed to *create* the power exercised by the Queen, in making grants of the sole use of inventions; but it will be seen from the statute itself, that such grants are merely excepted out of its provisions, and are left to depend upon the Common Law for their legality.

The statute (*p*) is intituled "An Act concerning monopolies and dispensations with penal laws, and the forfeitures thereof;" but it is usually called the Statute of Monopolies.

The preamble of the act contains the following recitals:—

"Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God one thousand six hundred and ten; publish in print to the whole realm and to all posterity, that all grants of monopolies, and of the benefit of any penal laws, or of power to dispense with *the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm.

[*10]

"And whereas your Majesty was further graciously pleased expressly to command, that no suitor should presume to move your Majesty for matters of that nature. Yet, nevertheless, upon misinformations, and untrue pretences of public good many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's sub-

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(*k*) 1 P. Wms. 181; 10 Mod. 130, S. C. (*l*) Part III. tit. Prerog. p. 61.
(*m*) Hawk. P. Cr. bk. I. c. 79, s. 20. (*n*) 3 Inst. 184.
(*o*) See the passage given at length, *ante*, p. 2.
(*p*) 21 Ja. I, c. 3.

jects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention so published as aforesaid. For avoiding whereof, and preventing the like in time to come, may it please your excellent Majesty," &c.

Sir Edward Coke says, (*q*) "It appeareth by the preamble of this act (as a judgment in parliament) that all grants of monopolies are against the ancient and fundamental laws of this kingdom, and therefore it is necessary to define what a monopoly is—

"A monopoly is an institution or allowance by the King, by his grant, commission, or otherwise, to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using of any thing, whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade."

In the case of monopolies, (*r*) *Coke* says, "Our Lord the King that now is, in a book which he in zeal to the law and justice commanded to be printed, anno 1610, intituled 'A declaration of his Majesty's pleasure,' &c., p. 13, has published that monopolies are things against the laws of this realm, and, therefore, expressly commands that no suitor presume to move him to grant any of them," &c.

And in the Third Institute (*s*) he says, "That the judgment in the case of monopolies (*t*) was the principal motive for publishing that book, and that the book was a great motive of obtaining the royal assent to the statute." The second *recital in the preamble shows that the misinformations or false suggestions, and the untrue pretences of public good upon [*11] which grants of monopolies had been obtained, made them contrary to law. And this part of the preamble also shows that the intent of the legislature was to pass an act for avoiding and preventing "such grants; that is to say, grants obtained upon misinformations and untrue pretences of public good."

After thus reciting the grievances under which the people laboured, in consequence of the illegal grants of monopolies, the first section of the act proceeds to say that "for avoiding whereof, and preventing of the like in time to come," it was declared and enacted, "That all monopolies, and all commissions, grants, licenses, charters, and letters patents heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty, to dispense with any others; or to give license or toleration to do use or exercise any thing against the tenor or purport of any law or statute; or to give or make any warrant for any such dispensation, license, or toleration, to be had or made, or to agree or compound with any others for any penalty or forfeitures limited by any statute, or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any statute before judgment thereupon had, and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in ure or execution."

By the grant of the sole privilege of using a new manufacture to an inventor, all other persons are restrained from using it during the continuance of the privilege, including every person, who, being ignorant of the prior invention, may

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(*q*) 3 Inst. 181.
(*r*) 11 Co. R. 88, b.
(*s*) 3 Inst. 182.
(*t*) 11 Co. R. 88, b.

[*12] himself make a discovery precisely similar. And as the effect *of such a grant is therefore to restrain persons of a freedom and liberty which they had before, that is to say, a freedom and liberty themselves to invent the art or manufacture, and use it in the way of trade for their own profit and benefit; it follows that such an exclusive privilege is a monopoly within the meaning of the word as defined by *Coke*. (*u*)

In the case of *Boulton and Watt* v. *Bull*, (*x*) Lord Chief Justice *Eyre* said, that by section one of this statute, a monopoly is defined to be, "the privilege of the sole buying, selling, making, working, or using any thing within the realm." And it is clear that this is so, for the act, immediately after mentioning "all commissions, grants, licenses, charters and letters patents of or for the sale, buying, selling, making, working, or using of any thing within this realm," adds the words, "or any *other* monopolies," clearly indicating that all the commissions, grants, &c., previously mentioned are in law deemed to be monopolies.

But even if it were doubtful whether the sole privilege granted to an inventor is a monopoly according, to the Common Law, the words "all commissions, grants, licenses, charters and letters patents, of or for the sole buying, selling, making, working or using of anything within this realm," but for the subsequent exception would have been sufficient to include letters patent for inventions.

The first section of the act concludes by declaring, that the matters and things before mentioned "are altogether contrary to the laws of this realm; and so are, and shall be, utterly void and of none effect, and in nowise to be put in ure or execution." These words plainly show that it was the intention of the legislature to declare what the Common Law was on the subject, and not to introduce any new law.

By section 2, it is declared and enacted, that all monopolies, and all such grants, letters patents, &c., ought to be and shall be tried by the Common Laws of the realm, and not otherwise.

The 3rd section enacts, that all persons shall be disabled and incapable to have or exercise any monopoly, or any such grant, letters patent, &c., as aforesaid.

[*13] Section 4 provides, that any person aggrieved by any monopoly, *or any such commission, grant, letters patent, &c., shall have a remedy by action to recover treble damages and double costs, aud imposes the penalties of premunire upon persons delaying such actions except by authority of the Court.

These four sections of the statute effectually suppressed all illegal monopolies, and deprived the Crown, not only of all claim to grant such monopolies in future, but also of all power to prevent persons aggrieved by them from pursuing their legal remedies; the statute being, as *Sir Edward Coke* observes, (*y*) "forcibly and vehemently penned for the suppression of all monopolies:—for monopolies in times past were ever without law, but never without friends."

This statute, however, as has been already observed, was only intended to be declaratory of the Common Law respecting monopolies, and as the generality of the terms used in the first and third sections would have extinguished the power of granting to inventors the sole use of their inventions, the authority of the Crown to make such grants is excepted and preserved within certain limits by the fifth and sixth sections of the act.

The first exception is in favour of letters patent made *prior* to the statute, and it is as follows: section 5. "Provided, nevertheless, and be it declared

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(*u*) 3 Inst. 181; vide *ante*, p. 10. (*x*) 2 H. Bl. 463.
(*y*) 3 Inst. 182.

and enacted, that any declaration before mentioned shall not extend to any letters patent, and grants of privilege for the term of one and twenty years or under, *heretofore made*, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of making of such letters patent and grants did not use, so they be not contrary to the law, nor mischievous to the state by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be, if this act had not been made, and of none other: and if the same were made for more than one and twenty years, that then the same for the term of one and twenty years only, to be accompted from the date of the first letters patents, and grants thereof made, shall be of such force as they *were or should have been, if the same had been made but for term of one and twenty years only, and as if this act had never been had or made, and of none other." [*14]

The 2nd exception is in favour of letters patent to be made *after* the passing of the act. It is as follows:

Section 6.—"Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patents, and grants of privilege, for the term of fourteen years or under, *hereafter to be made*, of the sole working, or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patents or grants of such privilege hereafter to be made, but that *the same shall be of such force as they should be if this act had never been made, and of none other.*"

The Chapter of Monopolies in *Sir Edward Coke's* Third Institute of the Laws of England, (*z*) contains the following commentary respecting the exceptions in this statute in favour of letters patent for new inventions; speaking of the proviso in section *five*, he says, "The first is, that this act shall not extend to any letters patents or grants of privilege heretofore made of the sole working, or making of any manner of new manufacture, but that new manufacture must have seven properties."

"*First*, it must be for twenty-one years, or under."

"*Secondly*, it must be granted to the first and true inventor."

"*Thirdly*, it must be of such manufactures which any other at the making of such letters patent did not use, for albeit it were newly invented, yet if any other did use it at the making of the letters patents, or grant of the privilege, it is declared and enacted to be void by this act."

"*Fourthly*, the privilege must not be contrary to law: such a privilege as is consonant to law must be substantially and essentially newly invented; but if the substance was *in esse* before, and a new addition thereunto, though that addition *make the former more profitable, yet is it not a new manufacture in law: and so was it resolved in the Exchequer Chamber, Pasch. 15 Eliz. in *Bircot's* case, for a privilege concerning the preparing and melting, &c. of lead ore: for there it was said, that that was to put but a new button to an old coat, and it is much easier to add than to invent. And there it was also resolved, that if the new manufacture be substantially invented according to law, yet no old manufacture in use before can be prohibited." [*15]

(*z*) 3 Inst. c. 85, p. 181, 184.

"*Fifthly*, nor mischievous to the state by raising of prices of commodities at home. In every such new manufacture that deserves a privilege, there must be *urgens necessitas*, and *evidens utilitas*."

"*Sixthly*, nor to the hurt of trade. This is very material and evident."

"*Seventhly*, nor generally inconvenient."

"There was a new invention found out heretofore that bonnets and caps might be thickened in a fulling mill, by which means more might be thickened and fulled in one day, than by the labours of four-score men who got their living by it. It was ordained that bonnets and caps should be thickened and fulled by the strength of men and not in a fulling mill, for it was holden inconvenient to turn so many labouring men to idleness."

"If any of these seven qualities fail, the privilege is declared and enacted to be void by this act: and yet this act, if they have all these properties, set them in no better case than they were before this act."

Speaking of section *six*, he says,

"The *second* proviso concerneth the privilege of new manufactures *hereafter* to be granted: and this also must have seven properties; first, it must be for the term of fourteen years, or under; the other six properties must be such as are aforesaid, *and yet this act maketh them no better than they should have been if this act had never been made, but only except and exempt them out of the purview and penalty of this law.*"

The cause wherefore the privileges of new manufactures, either before this act granted, or which after this act should be granted, having these seven properties, were not declared to be good was, for that the reason wherefore such [*16] a privilege *is good in law is, because the inventor bringeth to and for the commonwealth a new manufacture by his invention, cost and charges; and therefore it is reason that he should have a privilege for his reward (and the encouragement of others in the like) for a convenient time: but it was thought that the times limited by this act were too long for the private before the commonwealth should be partaker thereof, and such as served such privileged persons by the space of seven years, in making or working of the new manufacture, (which is the time limited by law of apprenticehood) must be apprentices or servants still during the residue of the privilege, by means whereof such numbers of men would not apply themselves thereunto as should be requisite for the commonwealth after the privilege ended. And this was the true cause wherefore, both for the time past, and for the time to come, they were left of such force as they were before the making of this act."

In the case of *Boulton and Watt* v. *Bull*, (*a*) Lord Chief Justice *Eyre* said, respecting this commentary of Coke's, "*Sir Edward Coke* discourses largely, and sometimes not quite intelligibly, upon monopolies, in his Chapter of Monopolies, Third Inst. 181; but he deals very much in generals, and says little or nothing of patent rights as opposed to (illegal) monopolies."

Bircot's case we shall see hereafter is not now law, having been again and again expressly overruled. Nor would a patent be deemed generally inconvenient within the meaning of the sixth section of the act, because it turned many labouring men to indleness. Indeed, it seems to have escaped the notice of our great commentator, that ordaining "that bonnets and caps should be thickened and fulled by the strength of men," is to give labouring men a monopoly of thickening and fulling bonnets and caps.

It appears most clearly, both from the words of the statute, and also the Commentary of *Sir Edward Coke*, that the power of the Crown to grant the sole use of an invention is derived from the Common Law, and not, as many

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(*a*) 2 H. Bl. 463.

persons have erroneously supposed, from the Statute of Monopolies. For the sixth section, respecting letters patent to be made after the passing of the act, expressly declares, (*b*) that the excepted *grants shall be of such force as they should be if the act had never been made, *and of none other;* and *Sir Edward Coke* says, (*c*) that the act makes them no better than they should have been if the act had never been made, but only excepts and exempts them out of the purview and penalty of it. And all the cases decided in favour of patentees, whether before or since the passing of the act, are so many authorities that the Crown has power *at the Common Law* to make such grants. [*17]

The prerogative of the Crown to make such grants is, however, confined within definite limits, both by the Common Law and the Statute of Monopolies. At the Common Law such grants could only be made by the Crown, by charter, or letters patent under the Great Seal, to the first inventor; the invention must have been new in England, and useful; and the term of the privileges reasonable. The statute seems merely to have further provided that the term shall not exceed fourteen years.

This, like every other prerogative, being vested in the Crown, for the benefit of the people, a discretion is to be exercised with respect to the making of such grants; and that discretion is exercised through the medium of certain officers and advisers appointed by law for that purpose. Thus, the petition for such a grant must be presented to her Majesty, through one of the Secretaries of State, who is always a privy councillor, and bound by his oath to advise her Majesty respecting the expediency of granting the prayer of the petition. The petition is also referred to the Attorney or Solicitor General, to report upon the petitioner's title, and the propriety of granting him the privilege which he seeks to obtain. And even after it has been decided that the grant shall be made, the proceedings necessary for obtaining it must pass through several public offices before the Lord Chancellor is authorized by writ under the privy seal to make the patent; (*d*) and the making of the patent may be stopped at any stage of the proceedings.

And although the Queen has determined to make the grant *requested by an inventor, and in consequence commands a patent to be made; that command is to be understood as having an implied condition annexed to it; namely, that the making of the grant will not be contrary to law or inconsistent with justice to any others of her Majesty's subjects, and therefore it is that, as we shall see in a subsequent part of this work, the Lord Privy Seal, and the Lord Chancellor exercise judicial authority respecting the making of the writ of privy seal and letters patent. (*e*) [*18]

The power of the Crown to grant patent privileges is not suspended by the minority, or any other personal incapacity, of the reigning Sovereign. (*f*)

(*b*) Vide *ante*, p. 13–14. (*c*) Vide *ante*, p. 15.

(*d*) The various proceedings for obtaining a patent and the offices through which they pass, will be detailed, *post*, in Chapter XII., respecting the practice upon obtaining patents.

(*e*) See further on this subject in Chapter IV. respecting the patent, and the practice as stated in Chapter XII. respecting the writ of privy seal and letters patent.

(*f*) Co. Lit. 43, b; 5 Co. 27, a; 7 Co. 13, a; 1 Black. Com. 248.

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*CHAPTER III.

OF THE GRANTEE OF A PATENT PRIVILEGE, OR THE PERSON TO WHOM THE SOLE USE OF AN INVENTION MAY BE GRANTED.

SECT. I.—*Of the Grantee of a Patent Privilege*, p. 19.
II.—*Of the true and actual Inventor or Discoverer of a new Art or Manufacture*, p. 22.
III.—*Of the true and actual Importer of a new Art or Manufacture*, p. 26.
IV.—*Of the first Inventor, or first Importer of a new Art or Manufacture*, p. 31.
V.—*Of the Persons incapacitated from becoming Grantees of Patent Privileges*, p. 34.

SECTION I.

Of the Grantee of a Patent Privilege.

THE next subject of enquiry is,—to whom may the sole use of an invention be granted? We shall see that a patent granting such a privilege is to be considered as containing a bargain between the public and the grantee, (*a*) the Crown on behalf of the public making the grant in consideration of a benefit conferred upon the public *by the grantee*. And *Sir Edward Coke* says, (*b*) that the reason why such a grant to an inventor is good, is "because the inventor bringeth to and for the commonwealth a new manufacture, *by his invention*, cost and charges, and therefore it is reason that he should have a privilege *for his reward, and the encouragement of others.*"

The object of the law is, therefore, to procure new inventions for the benefit of the public, and letters patent, are *granted for new inventions for the purpose, not only of recompensing particular grantees, but also of stimulating and encouraging others by the hope of similar rewards to confer similar benefits upon the public.

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The persons to be rewarded therefore, by such letters patent, are those who *invent, and give to the public the benefit of their inventions;* to such persons, and such alone, is the Crown authorized by law to grant the sole use of inventions; and we shall see that the prerogative of the Crown is limited in this manner, both by the Common Law and the Statute of Monopolies.

In the case of monopolies, *Darcy* v. *Allin*, (*c*) which was decided before the passing of the Statute of Monopolies, it was laid down that such a monopoly may be granted to any man, who, "by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm." And in the *Clothworkers of Ipswich* case, (*d*) (also decided before the statute) it is

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(*a*) *Post*, Ch. IV. and vide Williams v. Williams, 3 Mer. 157; and Harmar v. Playne, 14 Ves. 131—6.

(*b*) 3 Inst. 184.

(*c*) Noy, 182.

(*d*) Godb. 252, 254.

said that if a man hath brought in a new invention and a new trade within the kingdom, in peril of his life and consumption of his estate or stock, &c., or if a man hath made a new discovery of anything," the King may grant him the monopoly of his invention for a time. In the case of *Mitchell* v. *Reynolds*, (*e*) Lord Chief Justice *Parker* states the opinion of the Court of Queen's Bench at some length respecting monopolies, and he there says, that "a grant of the sole use of a new invented art is good, being indulged for the encouragement of ingenuity, but is tied up by the statute of 21 Jac. I. c. 3, s. 6, to the term of fourteen years." He also states, that "patents for the sole use of a new invented art" are not within any of the reasons against illegal monopolies, and that "as to a new invented art nobody can be said to have a right to that which was not in being before; and, therefore, it is but a reasonable reward to ingenuity and uncommon industry." And although this case occurred after the passing of the statute, it is evident from the language of the judgment, that the Court was laying down what was deemed to be the Common Law on the subject.

*In Sheppard's Abridgment (*f*) it is laid down that the King may grant a monopoly "of that which *any man at his own charge, wit, and invention*, shall bring in as a new trade or device *into the realm.*" And the person who brings in the trade or device must of course be the grantee of the monopoly. [*21]

By the sixth section of the Statute of Monopolies, an exception is made out of the preceding condemnation of all monopolies in favour of future letters patents and grants of privilege for the term of fourteen years, "of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures." It seems that this enactment must be read, as if the grants were permitted to be made to the true and first inventors within the realm, for it will be seen that a valid patent may be granted to a person who imports an invention from abroad, if it be new in this country.

Letters patent for inventions are always framed in such a way as to impose conditions upon the grantee in affirmance of the provisions of the Common and Statute Law upon this subject. (*g*) Therefore every patent granting the sole use of an invention to the actual inventor or discoverer, contains a proviso for avoiding the grant if the invention was "not invented or found out" by the grantee. (*h*) And in a patent granted for an imported invention, there is a similar proviso for avoiding it if the invention was not first introduced into this kingdom by the patentee.

Letters patent always recite the patentee's petition for the grant, (*i*) and the recital shows whether the petitioner stated himself to be an inventor or an importer. And if the statement made to the Crown was false, the grant is void by reason of the false suggestion. (*k*)

It is evident from what has been stated, that no person can be the grantee of a privilege in an invention, except the *true* and *first* inventor of the invention. To be capable of supporting such a grant therefore, the patentee must be the person *who has not only actually invented or imported the invention, but who has been the first to give the invention to the public. [*22]

(*e*) 1 P. Wms. 181; 10 Mod. 130, S. C. (*f*) Part. III. tit. Prerog. p. 61.
(*g*) 21 James I. c. 3, s. 6. (*h*) See this clause, in the patent.
(*i*) See the form of patent, in the Appendix, Chapter II. s. 1.
(*k*) See Chapter IV. *post*, on this subject.

SECTION II.

Of the true and actual Inventor of a new Art or Manufacture.

An inventor is a person who discovers or finds out something new, a framer, contriver, or deviser of what was before unknown. A person who founds his claim to a patent privilege upon discovery, and not importation merely; must be the person who really and actually invented or discovered the invention, which is made the subject of the privilege.

To be an actual inventor or discoverer of a manufacture, a person must himself make the discovery or invention, the idea of it must originate in his own mind; (*l*) and must not be suggested to him by another, (*m*) or taken from a book, (*n*) or from any thing else; (*o*) but whether the discovery be the result of accident, of some happy thought, or of great study, labour and expense, (*p*) is perfectly immaterial as respects the validity of the bargain made by the patent, between the patentee and the public. If the patentee was enabled by his own discovery to communicate to the public the knowledge of the invention, he is the person whom the law enables the Crown to reward by a patent for the benefit conferred upon the public.

Thus in the case of *Jones* v. *Pearce*, (*q*) *Patteson*, J., said, that the plaintiff's patent would be good if the patent "*was his own invention.*"

In *Tennant's* case, (*r*) it appeared that the principal part of the process claimed by the patentee in his specification had been suggested to him by another person, and therefore it was held that he was not the true inventor, and that his patent was void.

[*23] *In the case of *Barber* v. *Walduck*, (*s*) it appeared that the invention was made by a workman whilst employed in the workshop of the patentee, and it was held that the patent could not be sustained. It must, however, be presumed, that in this case the patentee obtained a knowledge of the invention from his workman, and that the workman when he made the discovery was not employed in carrying out the ideas of his master.

In the case of *Minter* v. *Wells* (*t*) Mr. Baron *Alderson* said to the jury, "Minter and Sutton were together about the time the invention took place; which of the two suggested the invention, and which carried it into effect, is a question for you to decide. If Sutton suggested the principle to Mr. Minter, then he (Sutton) would be the inventor. If, on the other hand, Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor."

In the case of *Lewis and another* v. *Marling*, (*u*) Lord *Tenterden*, C. J., said, that if the plaintiffs had borrowed their invention from some one else, their patent would fail. And also that if they had seen a model of the invention, or a description of it contained in *an American specification*, that would be an answer to their claim of invention (*x*) And in the same case *Bayley*, J.,

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(*l*) Jones v. Pearce, 1 Webs. 124. (*m*) Tennant's case, 1 Webs. 125.

(*n*) Arkwright's case, Dav. P. C. 61; Hill v. Thompson, 8 Taunt. 375; 2 B. Mo. 424, S. C.; and vide *post*, Chapter V. s. 3, as to the novelty of an invention.

(*o*) Carpenter v. Smith. 1 Webs. R. 535. (*p*) See Crane v. Price, 1 Webs. R. 411.

(*q*) Webs. R. 124. (*r*) Webs. 125, Davies, P. C. 429.

(*s*) Cit. 1. C. & P. 567; S. C. *nom.* Barber v. Shaw, Holroyd. Pat. p. 60.

(*t*) 1 Webs. R. 132. (*u*) 4 C. & P. 52; 10 B. & C. 22.

(*x*) 10 B. & C. 27.

said, "If it had been shown that the plaintiff had seen the model, *and had borrowed from it*, he would not have been the true inventor."

The reason why the grantee of an invention is required to be the true and actual inventor is, that the *consideration* for the grant made to him by or on the behalf of the public, must proceed from the grantee himself, (*y*) and it is intended to reward him for his ingenuity, labour, and expense, and not another who may by any means obtain a knowledge of his invention. It is difficult to prove an actual inventing or discovering by the patentee in any case, (*z*) and, indeed, the only evidence of it which an inventor is ever capable of giving in our Courts of Law is, that he was the first person to give a *knowledge of the invention to the world; for, according to the rules of evidence which obtain in those Courts, no one can be a witness in his own cause. [*24]

But although a patentee may have been the first to put the public in possession of the invention, yet it is open to any one to show that he was not the real inventor, or that he had borrowed it from some other person, or had obtained a knowledge of it (in this country) from some other source than his own actual discovery. (*a*)

Thus, in *Cornish* v. *Keene*, (*b*) the Lord Chief Justice (*Tindal*) said, "Sometimes it is a material question to determine whether the party who got the patent was the real and original inventor or not; because these patents are granted as a reward, not only for the benefit which is conferred upon the public by the discovery, but also to the ingenuity of the first inventor: and although it is proved that it is a new discovery so far as the world is concerned, yet if any body is able to show that although that was new,—that the party who got the patent was not the man whose ingenuity first discovered it; that he had borrowed it from A. or B., or taken it from a book that was printed in England, and which was open to all the world,—then although the public had the benefit of it, it would become an important question whether he was the first and original inventor of it."

And not only must the patentee have been the actual inventor, but he must have invented every part of what he claims to have invented. (*c*) Thus in the case of *Losh* v. *Hague*, (*d*) Lord *Abinger*, C. B., said, "That if a man claims by his patent a number of things as being the inventor of them, whether they consist of improvements or original inventions, and it turns out that some of them are not original, his patent is void."

But although the invention must have been the patentee's own invention, it is not necessary to show that it has been the result of great labour, pains, or expense. For, indeed, a patentee would seldom be in a position to prove the extent of his labour or cost in bringing his invention to perfection; *and besides, if there are persons in the world who are capable, without much mental effort, and without the aid of experiment, to make inventions useful to the public, is very desirable that they should be encouraged and rewarded, by the grant of temporary privileges, to bestow their time and talents in the production of new inventions, which may be of the greatest benefit to the public. [*25]

Thus in the case of *Crane* v. *Price and others*, (*e*) the Court of Common Pleas held that it was unnecessary to consider the labour, pains, or expense

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(*y*) A similar rule of law prevails with respect to the consideration necessary to support a promise in an action of assumpsit.

(*z*) See Chap. XI. and Index, tit. Evidence.

(*a*) Vide *post*, Evidence, Chap. XI. (*b*) 1 Webs. R. 507.

(*c*) See Tennant's case, 1 Webs. R. 125; Arkwright's case, Dav. P. C. 61.

(*d*) 1 Webs. R. 203. (*e*) 4 M. & G. 580; 1 Webs. R. 410, 411.

incurred by the patentee in bringing his discovery to perfection, and that in point of law the labour of thought or experiment, and the expenditure of money, are not the essential grounds of consideration on which the question whether an invention is or is not the subject-matter of a patent ought to depend. And there can be no doubt that the same law is applicable to the question whether a patentee was the true inventor of the invention, for it is sufficient if the patentee was really the inventor, and gave the invention to the public in consideration of the patent. And in the case last cited, the Court said, "If the invention be new and useful to the public, it is not material whether it be the result of long experiment and profound research, or whether by some sudden and lucky thought, or mere accidental discovery."

The law does not prevent an inventor from availing himself of the assistance of workmen or servants in the prosecution of his search after a new manufacture. Many processes cannot be conducted by the unaided exertions of a single individual, and in order to discover any thing new in the arts and manufactures, it is almost always necessary to have recourse to actual experiment in order to discover how any particular object may be best obtained. And indeed the previous ignorance of the world respecting a process or mode of producing a new manufacture, points out the necessity for questioning nature, as it were, by experiments, and thus endeavouring to discover in what way her laws allow us to attain any object we may have in view. It would, therefore, be most impolitic to confine the rewards given to inventors to that class of them only who have entirely and without any assistance whatever brought their inventions
[*26] to perfection; and indeed *it may be doubted whether, properly speaking, any such would be found.

Our law, therefore, permits an inventor in the prosecution of his discovery to avail himself of the labour of servants, they being in fact considered as mere tools or instruments working by his directions, and carrying out the views which he has formed in his own mind.

Thus in the case of *Minter* v. *Wells*, (*e*) *Alderson*, B., said, if Mr. Minter suggested the principle to Sutton, and Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Minter used for the purpose of enabling him to carry his original conception into effect.

And in the case of *Bloxam* v. *Elsee*, (*f*) which was an action for the infringment of two patents granted to John Gamble, the first of which was for a new paper machine, and the second for improvements made upon the invention comprised in the first. One ground of defence at the trial was, that these improvements were the invention of Mr. Donkin, an engineer.

Mr. Donkin proved that the improvements were of his invention; but he stated that at the time he invented those improvements he was employed by Mr. Gamble, the patentee, and Mr. Foudrinier, his partner, as an engineer, for the purpose of bringing the machine to perfection, and was paid by them for so doing; and therefore he was acting as their servant for the purpose of suggesting improvements in the machine. For the plaintiff it was contended that the improvements were the patentee's inventions, and that Mr. Donkin was employed by them to carry their ideas into effect in the best manner. And the objection to the patent on this ground seems to have been disregarded.

(*e*) 1 Webs. R. 132. (*f*) 1 C. & P. 558; 6 B. & C. 169.

SECTION III.

Of the true and actual Importer of a New Art or Manufacture.

Some of the old cases respecting monopolies already cited, show that the importer from abroad of an invention unknown in this kingdom was, at Common Law, entitled to maintain a patent for the sole use of the invention.

*Thus, in the case of monopolies, (*g*) it is laid down that a grant may be made to a man who "doth bring any new trade into the realm." In the same case it appears that a patent had been granted to Mr. Hastings, "in consideration that he brought in the skill of making of frisadoes as they were made in Harlem and Amsterdam." And no objection was made to the patent on the ground, that Mr. Hastings was not the actual inventor. So in the *Clothworkers of Ipswich* case, (*h*) it is said that the King may make a grant to a man who "hath brought in a new invention, and a new trade, within the kingdom." [*27]

In Sheppard's Abridgment, (*i*) it is laid down that the King may grant a monopoly of any new trade or device which any man may *bring into the realm.* And Serjeant *Hawkins* (*k*) says, that such grants may be made "of an art invented *or first brought into the realm* by the grantee."

It is clear that the exception contained in the sixth section of the Statute of Monopolies, (*l*) was intended by the legislature to be in affirmance of the Common Law upon the subject, with the exception perhaps of the length of the term for which a patent might be granted, and which, before the passing of the statute, was uncertain, and merely required to be reasonable.

And the language of the preamble of the act plainly indicates that the grants intended to be rendered void, were such only as would be void at Common Law, independently of the statute. (*m*) Our Courts have therefore construed this section of the statute as permitting grants of privilege in new arts or manufactures, to be made to the true and first inventors of such arts or manufactures *within the realm*, and therefore patents for foreign inventions, unknown in this country, have been held to be good ever since the passing of the statute, and very many of such patents are continually granted to the importers of such inventions.

Thus, in the case of *Edgeberry* v. *Stephens* (*n*) it was held that if an invention be new in England, a patent may be granted though the thing was practised beyond the sea *before; that the act intended to encourage new devices useful to the kingdom, and whether learned by travel or study, it is the same thing. [*28]

This case has ever since been acted upon as law; and indeed there is no subsequent case reported in which the validity of a patent has been questioned on the ground of the invention comprised in it being a foreign invention, and merely imported into this country by the patentee.

It is clear, therefore, that if an invention be unknown in this realm, a person who imports a knowledge of it from a foreign country, will be able to support a patent for it as the true inventor of it, within the meaning of the Statute of Monopolies.

(*g*) Noy. 182.
(*h*) Godbolt, 252, 254.
(*i*) Part 3, tit. Prerog. p. 61.
(*k*) Hawk. pl. Cr. bk. i. c. 79, s. 20.
(*l*) 21 Ja. I. c. 3.
(*m*) See *ante*, p. 10.
(*n*) 2 Salk. 447; Dav. P. C. 36; and 1 Webs. R. 35, *S. C.*

But it seems that if an invention be publicly known in any part of the realm, as Ireland or Jamaica, for example; a person who afterwards imports the knowledge of it into England cannot be an inventor within the meaning of the law. The case of *Brown* v. *Annandale* (*o*) shows, that if an invention be known in any part of the realm, a subsequent patent for it in England or Scotland, would be void on the ground of a want of novelty in the invention, even if it were perfectly new at the date of the patent in that part of the realm for which the patent was granted.

There can be little doubt that whenever the question does arise, it will be held that a mere transportation of a knowledge of an invention from one part of the realm to another, will not make a person an inventor within the meaning of the patent law. And in the case of *Brown* v. *Annandale*, (*p*) just cited, Lord *Lyndhurst*, L. C., said, "It would be a monstrous thing if an invention having full publicity in one part of the United Kingdom could be made the subject of a patent in another part of it." And in the same case Lord *Campbell* said, that "If the Crown were made aware of that fact the grant would be refused."

In *Tennant's* case, (*q*) one ground upon which the patent was held to be void was, that the plaintiff (the patentee) was not the inventor of an indis-
[*29] pensable part of the process for which *he had obtained his patent; it having been shown that it was suggested to him by a chemist at Glasgow. It does not appear from any report of that case *where* the communication was made to the patentee, although from the language of the note of the case in Davies' Patent Cases, it is to be inferred that the suggestion was made in Scotland; but no attempt was made to support the patent on the ground that the communication was made to the patentee by a person residing out of England. Tennant's patent was, however, obtained for an invention by the patentee, and without mentioning it to be an imported or communicated invention, and therefore it may have been thought that the form of the representation to the Crown in that case, excluded the patentee from all right to support his patent as for a communicated invention.

It is quite clear that no patentee can support a patent as inventor of a new manufacture, when it is shown that he obtained a knowledge of the invention from any Englishman residing in his own country. (*r*) But it has never been decided whether a communication made from an Englishman residing abroad to a person residing here would be sufficient to support a patent. But the language of some of the old cases already cited, would seem to lay down the law in terms quite large enough to include such a case. (*s*)

Nor has there been any decision as to whether the communication made by a foreigner to the patentee may be made in this country, or by a foreigner residing here. The representation which is always made to the Crown in the petition, to obtain a patent for an imported invention, is that the petitioner is in possession of the invention, in consequence of a communication made to him by a foreigner *residing abroad*. And it would seem from this that if the communication was made by a foreigner *permanently* domiciled here, that it would not be sufficient; but if the foreigner at the time of the communication was only temporarily residing here, the communication would most probably be held sufficient to support the patentee's claim to be an inventor within the meaning of the law. For a foreigner is under no obligation of duty
[*30] to the people of this country to give them the invention, *either for a reward or without, and a native of this country having by pur-

(*o*) 1 Webs. R. 433; See also Roebuck v. Stirling, 1 Webs. R. 45 and 451.
(*p*) 1 Webs. R. 444.
(*q*) Dav. P. C. 429; 1 Webs. R. 125.
(*r*) Vide *ante*, p. 22, 23.
(*s*) Vide *ante*, p. 7, and p. 20.

chase or otherwise acquired from a foreigner temporarily here, the means of giving the public the benefit of a useful invention, would most probably be enabled as importer or introducer to support a patent for the invention. And it is to be observed, that our Courts do not put a patentee to very strict proof of the mode in which he became possessed of the invention. It is sufficient that he appears, *primâ facie*, to have been the inventor or (in the language of a patent for an imported invention) to have been the first to introduce the invention into this country. (*t*) There must however be no false representation made to the Crown respecting the nature of the patentee's title, or the patent will be thereby rendered void.

It has been erroneously supposed that there is a class of persons who may become true and first inventors within the meaning of the law, besides actual inventors and importers of foreign inventions. And it has been said, that in addition to discoverers of new inventions and importers of foreign inventions, the first publishers or introducers of inventions may maintain letters patent for them. But it is clear that this supposition is founded in error, for any new invention which a person may possess the knowledge of must either have been discovered by the possessor himself, or by some other person. We have seen that an actual inventor can maintain a patent for his invention, (*u*) but no one can support a patent for an invention communicated to him by a fellow-countryman in England, (*x*) and therefore it seems that the only other class of inventors within the meaning of the law, besides discoverers, are those who become possessed of foreign inventions, and who we have termed importers.

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*SECTION IV. [*31]

Of the first Inventor, or first Importer of a new Art or Manufacture.

It has already been shown that the object of the law is to procure for the public the benefit of new inventions. And it must now be added, that it is equally the object of the law to procure that benefit in every case as speedily as possible.

The law, therefore, as declared by the Statute of Monopolies, (*y*) requires not only that a patentee shall have been the true inventor, or person who actually invented or imported the invention into this country; but also that he shall have been "the *first* inventor thereof." And therefore, however clearly it might be shown in support of a patent, that the patentee had actually discovered or imported the invention, it would be of no avail, and the patent would be void if it should appear that, at the time when the grant was made, he was not also the *first* inventor.

But although the patentee is thus in terms required by the statute to be the first inventor, the words of the statute have been construed liberally for the benefit of the public, and so as to carry out the intent of the law; namely, to induce inventors to give the public the benefit of their discoveries and inventions as speedily as possible. And therefore it has been held, that *he* shall be deemed the first inventor of a new manufacture who shall *first* give, or contract by a patent to give, a knowledge of it to the public. (*z*) And the circumstance of a

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(*t*) See *post*, Ch. XI. and Index, tit. Evidence.
(*u*) Vide *ante*, p. 22.
(*x*) Vide *ante*, p. 23.
(*y*) 21 James I. c. 21. s. 6.
(*z*) Minter v. Wells, 1 Webs. R. 131.

patentee being the first to introduce an invention shows, *primâ facie*, that he was the first inventor. (*z*)

If two inventors were simultaneously to apply to the Crown for separate patents for the same invention, and both applications were to be referred to the same officer, (*a*) the grant would be made to the person who could show that he had first made the invention. But few, if any, persons are in a position to prove by direct evidence that they have invented any thing, *much less the time when they made their inventions; and, indeed, if the evidence of the inventor himself be excluded, the only way in which it can be shown that any particular person made an invention, is by proof that he communicated a knowledge of it to some other person; and consequently the only proof which can be given that any person made an invention before any other person, is to show by legal evidence that he was the first to communicate a knowledge of it to some other person.

[*32]

But if the applications should happen to be referred by the Crown to different officers, the applicants might both obtain reports in favour of grants being made to them, and then the applicant who first obtains a grant will be entitled to the sole use of the invention. Thus, in the case of *ex parte Dyer* in Chancery, in 1812, (*b*) Lord *Eldon*, L. C., held, that in concurrent applications for a patent for the same object, that which obtains the Great Seal first will have the right at Law. And it has frequently been decided that it is no objection to a patent that some one made the same invention prior to the patentee, unless the world was also put in possession of it by its being made public before the date of the patent. (*c*)

In *Dolland's* case, (*d*) it was objected that the patentee was not the (first) inventor of the new method of making object-glasses comprised in the patent, but that Dr. Hall had made the same discovery before him. But it was held that as Dr. Hall had confined the discovery to his closet, and the public were not acquainted with it, Dolland was to be considered as the (first) inventor.

In the case of *Forsyth* v. *Riviere*, (*e*) on the question of priority of invention, Lord Chief Justice *Abbott* held that, if several persons simultaneously discover the same thing, the party first communicating it to the public under the protection of letters patent becomes the legal inventor, and is entitled to the benefit of it.

In the case of *Lewis* v. *Marling*, (*f*) Mr. Justice *Bayley* said, "If I make a discovery and am enabled to produce an *effect from my own experiments, judgment and skill, it is no objection that some one else has made a similar discovery by his mind, unless it has become public. So, if I introduce a discovery *bonâ fide* made, I may have a patent for it, though a person might have privately a communication from abroad, which would have enabled him to have made the machine."

[*33]

In the case of *Carpenter* v. *Smith*, (*g*) Lord *Abinger*, C. B., said, that "A man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any other man having invented that before, and not made use of it; because the mere speculations of ingenious men which may be fruitful of a great variety of inventions, if they are not brought into actual use ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions *and apply them.*"

(*z*) Minter v. Wells, 1 Webs. R. 131. (*a*) See the Practice, *post*, Chapter XII.
(*b*) Holroyd, 59.
(*c*) See Hill v. Thompson, 1 Webs. R. 244; and per Erskine, J., in Gibson v. Brand, 4 M. & G. 198, 205. (*d*) 2 H. Bl. 470, 487, and Davies' P. C. 172.
(*e*) Chit. Prerog. Cr. 182; 1 Webs. R. 97.
(*f*) 10 B. & C. 22; 1 Webs. R. 496. (*g*) 1 Webs. R. 534.

But although a patentee's claim to be the first inventor of his invention will not be defeated by the prior discovery of the same invention by a person who kept it secret, it is otherwise if the invention was known or used by the public at any time before the date of the patent. For the public knowledge or use of an invention shows that some one must have given the invention to the public, and such a public knowledge or use of an invention comprised in a patent before the date of the patent, shows conclusively that the patentee was not at the time of the grant the first inventor of the invention.

If an inventor himself publishes a knowledge of his invention to the world, the law deems that he thereby dedicates it or gives it to the public; and when once the publication has been made, the act is irrevocable, and the Crown cannot afterwards grant the sole use of the invention either to the same or any other inventor. For the person who thus voluntarily gives the benefit of his invention to the public, becomes so far the true and first inventor of it, as to defeat the claim of any other person to be afterwards considered the true and first inventor of it.

If the public once becomes possessed of an invention by any means whatever, no subsequent patent for it can be granted either to the true and first inventor himself, or any other person, for the public cannot be deprived of the right *to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing every thing that he could give. [*34]

Thus in the case of *Stead* v. *Williams*, (*h*) it was held that if an invention has already been made public by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the first and true inventor within the meaning of the statute, whether he himself borrowed his invention from such publication or not, because the public cannot be precluded from the right of rising such information as they were already possessed of at the time the patent was granted. (*i*)

SECTION V.

Of the Persons incapacitated from becoming Grantees of Patent Privileges.

It has now been shown that the grantee of a patent privilege, must be the person whom the law adjudges to be the true and first inventor of the art which is made the subject of the privilege, or the person from whom the consideration for the grant is obtained by the public. It only remains to be seen what persons are by law incapable of becoming grantees of such patent privileges.

And first it seems that the Queen herself could not become the grantee of such a privilege, for she could not grant to herself.

Nor could a corporation aggregate become a grantee of a privilege for an actual invention, for invention is an act of the mind which clearly could not proceed from such a corporation. And even with respect to an imported invention, it seems difficult to conceive how such a corporation could become a grantee.

A corporation sole, *as such*, must also be incapable of becoming a grantee, for he must make the invention by his mind in his natural capacity; and in that capacity alone, therefore, could he become grantee.

(*h*) 8 Jur. 930.

(*i*) See also the cases cited in Stead v. Williams.

[*35] *It may be doubtful whether the exercise of a patent privilege by a beneficed clergyman, would not be a trading within the meaning of the statute 57 Geo. III. c. 99, (*k*) and therefore prohibited by section three of that act. And if that be so, it may be questionable whether the grant of a patent privilege to such a clergyman would not be void, because the Queen's intent, namely, that the patentee should derive a profit from the exercise of the privilege, cannot take effect.

There seems to be no reason why an alien may not hold such a privilege as grantee, and there are many instances of such privileges being granted to aliens. In one case, (*l*) a question was raised at *nisi prius*, respecting the validity of a grant to a person in trust for an alien enemy; the question was reserved for the determination of the Court of Queen's Bench, but the patent was held to be bad upon a different ground, and the point was not determined.

A married woman might, as an inventor, become the grantee of such a privilege; but the privilege, when acquired, would vest in her husband.

It is difficult to say what would be the effect of such a grant to an infant inventor, he could not exercise the privilege beneficially, for he could not buy or sell; or make any contract to bind himself. It is doubtful whether such a grant would be valid. (*m*)

[*36]

*CHAPTER IV.

OF THE GRANT OF A PRIVILEGE IN AN INVENTION BY LETTERS PATENT, AND THE CONSTRUCTION OF IT.

By the Common Law the Queen can make a good gift of moveable chattels without writing, (*a*) but no other grant by the Crown is available unless it be made by matter of record under the great seal; (*b*) and this is required by reason of the person of the Queen, and the dignity of her office. (*c*)

The grants of the Queen must be made by *charters* or *letters patent* under the great seal, and they are matters of *public* record. (*d*)

The seal under which these grants of the Crown were formerly made was the great seal of England; after the union with Scotland the great seal of Great Britain; and now since the union with Ireland the great seal of the United Kingdom. (*e*)

Sir Edward Coke calls the great seal *clavis regni*, or key of the kingdom; (*f*) and it is always in the custody of the Lord Chancellor, or of commissioners appointed for the purpose.

(*k*) See Hall v. Franklin, 3 M. & W. 259.

(*l*) Bloxam v. Elsee, 1 C. & P. 558; 6 B. & C. 169, S. C.

(*m*) For further information respecting persons who may and may not become grantees of any thing, see Co. Lit. 2, b; Shep. Touch. 234, 235.

(*a*) Vin. Abr. Prerog. (M. b. 7.)

(*b*) Com. Dig. Pat. (C. 2); Lane's case, 2 Co. R. 16, b; Moor, 476; 2 Rol. Ab. 182, l. 5; Bro. Ab. Prerog. 70; Noy, Dialog. Tenures, p. 33.

(*c*) Owen v. Saunders, 1 Ld. Ray. 163; Dr. & Stud. Dialog. i. c. 8, p. 34.

(*d*) Bro. Abr. Prerog. 70, 95; Com. Dig. Pat. (A.); 3 Lev. 223; 2 Bl. Com. c. 21, s. 2; Noy, Dialog. Tenures, p. 34.

(*e*) See the case of the King v. Bullock, 1 Taunt. 71; and the King v. Yandell, 4 T. R. 521.

(*f*) 2 Inst. 552.

By the statute of 6 Ann c. 7, s. 9, it was enacted that the great seal and other public seals in being at the time of the demise of her Majesty, or any of her successors, should continue and be made use of as the respective seals of the successor until such successor should give order to the contrary.

In the case of the *East India Company* v. *Sandys*, (*g*) it is laid down that "all the King's subjects are bound to take notice of the King's great seal." And, therefore, it is that the *great seal shall always be credited, (*h*) and can never be denied. (*i*) [*37]

The saving of the prerogative of the Crown, contained in the 6th section of the Statute of Monopolies, is in accordance with the Common Law upon the subject, for it extends only to *letters patent* and grants of privilege of the description which form the subject-matter of this work. (*k*) And, therefore, the sole use of an invention can only be granted within the meaning of the statute (*k*) by letters patent; and as such letters patent must, according to the Common Law, be under the great seal, they must also be written on parchment. (*l*)

"Letters patents, that is, open letters, *literæ patentes*, are so called because they are not sealed up, but exposed to open view, with the great seal pendant at the bottom, and are usually directed or addressed by the Queen to all her subjects at large." (*m*) And letters patent, or in common parlance, a patent such as forms the subject of this work, may be correctly defined an open record under the great seal, containing a grant of privilege in an invention made by the Crown to an inventor.

A record in our law is defined to be a memorial of an act or proceeding of a Court of record proceeding according to the course of the Common Law, entered on parchment for the preservation of it. (*n*) The Lord Chancellor is the sole judge of the Common Law branch of the Court of Chancery, in which all the Queen's letters patent are made; (*o*) and the making of letters patent by the Lord Chancellor, by affixing the great seal to them, is an act of the Court of Chancery, by which the Court makes a record of the Queen's grant, that is, makes her letters patent, containing her grant, in pursuance of her command.

The Queen cannot herself make her letters patent except by means of her ministers, who act according to her legal commands. The command given to the Lord Chancellor to make a patent for an invention is always made by means of a writ or bill, sealed with the privy seal; and, therefore, when the patent *has been written, the words, "By writ of Privy Seal," are subscribed, in order to show by what authority the Lord Chancellor seals the grant. (*p*) [*38]

But, notwithstanding the Queen's authority or command to make letters patent, the Lord Chancellor cannot knowingly affix the great seal to a grant which will be contrary to law; for the Queen cannot do, or intend to do, any thing wrong; (*q*) and, therefore, the command must be construed to be made conditionally upon the Lord Chancellor deeming the grant to be lawful. And if the Chancellor is of opinion that the proposed grant would be illegal or

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(*g*) Skin. 225. (*h*) Ben. & Dal. 19.
(*i*) 4 Co. R. 71, b; Doct. plac. 352; Plow. 232.
(*k*) 21 Ja. I. c. 3. s. 6. (*l*) 3 Shep. Abr. Prerog. p. 93.
(*m*) 2 Bl. Com. c. 21, s. 2. (*n*) Com. Dig. Record (A.); 3 Inst. 71.
(*o*) 4 Inst. 79, 80, 84; 1 Shep. Abr. 464.
(*p*) 2 Bl. Com. p. 347; 8 Co. R. 18. b; and see the Forms and Practice in a subsequent part of this work.
(*q*) Vide 3 Shep. Abr. 48; Jenk. Cent. 9, case 16; 1 Co. R. 44, b, 45, b.

unjust, or that for any reason it ought not to be made, he will not seal the patent. (*r*)

The original letters patent are always delivered out of Chancery to the patentee, as his evidence of his title to the grant which they contain, and therefore they are enrolled; that is, the grants which they contain are entered upon rolls called the Patent Rolls, in order that the records of the Court of Chancery may at all times show what patents the Lord Chancellor has made in pursuance of the Queen's writs. (*s*) These rolls are themselves records to which all persons may have access, (*t*) and every one is bound to take notice of the grants so enrolled. (*u*)

The Queen in making her grants is under the especial protection of the law, the reason of which seems to be, that she being so much occupied with public affairs, cannot be supposed to give the same attention to her grants as private persons can give to theirs; (*x*) and that the whole community has an interest in the Queen, and the grants which she makes, more particularly those which she makes in her public capacity.

The ordinary rules which are to be observed in the construction of grants made by private persons do not necessarily apply to the construction of grants by the Crown.

[*39] *as the Queen's grants proceed chiefly from her own bounty, and her letters patent are records of a high nature, they ought to contain the utmost truth and certainty, and have in all times been construed most favourably for the Crown, (*y*) and that contrary to the construction put upon the grants of common persons; (*z*) and accordingly in a great variety of cases we find, that uncertainty, misrecitals, false suggestions, and all such matters as show that the King was deceived in his grants, held to be sufficient reasons to vitiate the grants. (*a*) But it seems that where the Queen proceeds by and with the advice of parliament, she is not in that situation in respect of which she is under the special protection of the law, that she could be considered as deceived in her grant. (*b*)

If the grant of the Queen be founded upon a false suggestion, it will be void, because the Queen has been deceived. (*c*) And if the Queen be misinformed, (*d*) or be deceived in her grant, and grant more than she lawfully may, the whole grant will be void. (*e*) So the grant of the Queen will be void for a misrecital, (*f*) or for want of form, (*g*) or for uncertainty, (*h*) or if too general. (*i*)

(*r*) See 2 Inst. 566; and the Practice, *post*.

(*s*) Vide 3 Shep. Abr. 93 (7); Com. Dig. Pat. (E.)

(*t*) 1 Co. R. 45, a; 3 Inst. 71; and see the stat. 46 E. III. printed in the Preface to the 3rd part of Coke's Reports, p. vi.

(*u*) 1 Co. R. 45, a. (*x*) Godb. 295; 1 Co. R. 52, a.

(*y*) Plow. 333; 1 Co. R. 45, a; 8 Co. 56, a; Bac. Abr. Prerog. (F. 2), p. 514; Com. Dig. Grant (G. 12.)

(*z*) See Bac. Abr. Grant (I. 1); Shep. Touch. 83; 3 Atk. 136; Swan v. Fonnereau, 3 Ves. 41, 48.

(*a*) Vin. Abr. Prerog. (G. b. 2); Bac. Abr. Prerog. (F. 2); Com. Dig. Grant (G. 6, 7, 8 and 9.)

(*b*) Per Lord C. J. Eyre, in Boulton v. Bull, 2 H. Bl. 500.

(*c*) Com. Dig. Grant (G. 8 and 9); Earl of Devonshire's case, 11 Co. 90, a; Vin. Abr. Prerog. (N. b. 1.) (*d*) 1 Co. R. 52, a.

(*e*) Com. Dig. Grant (G. 8); case of Alton Woods, 1 Co. R. 49, a; Vin. Abr. Prerog. (G. b. 2.)

(*f*) Moore, 318; Hob. 224. (*g*) Hob. 323; Vin. Abr. Prerog. (G. b. 2.)

(*h*) 2 Rol. Abr. 196, l. 30; Com. Dig. Grant (G. 6); Vin. Abr. Prerog. (G. b. 2); per Heath, J., in Boulton and Watt v. Bull, 2 H. Bl. 483.

(*i*) 2 Rol. Abr. 193, l. 41.

The material parts of a patent for granting a sole privilege in an invention will now be considered in the following order:

1st. The address or direction.
2nd. The recitals.
3rd. The grant to the inventor.
4th. The prohibition to others.
5th. The conditions of the grant.

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*1st. *Of the Address or Direction.* [*40]

Letters patent always commence with the style (*k*) of the Queen, and a general direction or address in the following form:

"Victoria, by the Grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the faith: to all to whom these presents shall come, greeting."

Letters patent commence in the name of the Queen, because although they are made by the Court of Chancery, yet they cannot be made without the Queen's writ, and the grant is the Queen's grant, made by her as the head of the executive government, acting with the advice of her ministers, on behalf of the whole community; and the grant must be made in her name in order that the authority by which the privilege or monopoly is created and granted, may be thus announced to all those who reside within that part of the Kingdom to which the patent privilege extends.

Letters patents are directed to all persons to whom they shall come, because they contain bargains made between the public and the patentees; (*l*) they are public records, and all persons are bound to take notice of the grants which they contain, (*m*) and no one can excuse himself from the consequences of infringing a patentee's privilege by alleging that he was ignorant of its existence.

The Court of Chancery is always open, and any one upon payment of a small fee may have free access to peruse the enrolment of any patent, (*m*) and may also procure an office copy of it.

2nd. *Of the Recital.*

The recital in a patent always contains a short statement of the substance of the inventor's petition, and the motive of the Queen in making the grant.

*It has already been shown that an inventor is not entitled to a patent as of right, but only by the grace and favour of the Crown, [*41] acting on behalf of the public. (*n*)

And the Queen cannot have knowledge of an invention having been made until she is informed of the fact by the inventor; for until he applies for a patent, he keeps a knowledge of the invention from all the world.

Every person, therefore, who desires to secure to himself the sole use of any new manufacture which he has invented, must apply by petition to the

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(*k*) See as to the styles formerly used by the Kings of England in letters patent, &c., Co. Lit. 7, a, 7, b; 2 Inst. 1.

(*l*) 14 Ves. 131, 136.

(*m*) 1 Co. R. 45, a; 1 Skin. R. 225; 4 Co. R. 71, b; 6 Co. R. 15, b.

(*n*) Vide *ante*, Chapter I. p. 4.

Crown for a grant of privilege. The petition is the foundation of the proceedings by which an inventor is to acquire the exclusive privilege which he seeks to obtain, and as the Crown acts and proceeds upon the representations contained in the petition, the petition is always recited or stated in the patent.

The Queen ought always to be correctly informed respecting the subject-matter of her grants, so that she may not be deceived, and so fail in her intent. (*o*)

Every petition to the Queen for a grant ought therefore to be strictly correct, and for this reason it has always been the practice to require a petition for a patent to be verified; and as none can know the facts stated but the petitioner himself, no other person can verify them. The verification was formerly by the petitioner's oath; but in pursuance of a recent statute, (*p*) it is now by solemn declaration made before a Master in Chancery.

A petition to the Crown for such letters patent must state the name and addition of the petitioner, the title of the invention, and the grounds upon which the petitioner asks for the favour of the Crown, which is in substance that he has discovered or imported the invention for which he desires a privilege, that he believes it to be of public utility, and new in England. (*q*)

The effect of the petition is generally recited very shortly in the letters patent, as in the following example:—

"Whereas James Gowland, of Leathersellers Buildings, in the City of London, Chronometer Maker, hath by his petition humbly represented unto us that [*42] he hath invented certain *improvements in the mechanism of time-keepers, that he is the first and true inventor thereof, and that the same has never been practised by any other person or persons whomsoever to his knowledge or belief: the petitioner, therefore, most humbly prayed that we would be graciously pleased to grant to him, his executors, administrators, and assigns, our royal letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of the said invention within England, Wales, and Town of Berwick-upon-Tweed, for the term of fourteen years, pursuant to the statute in such case made and provided." And then, after mentioning the motive of the grant, it is stated that the Queen is "graciously pleased to condescend to the petitioner's request."

As a misrecital avoids a patent; if the recital of the inventor's petition be untrue in any material particular, the whole patent will be void. (*q*) The patentee being a party to the grant made by the patent, is bound by the recital, and estopped from denying any thing it alleges. And even if it did not appear in the recital itself that the matters recited had been represented to the Crown by the patentee, yet it would be deemed in law that the matters recited had been suggested to the Crown by the grantee. (*r*) It is the duty of every petitioner to the Crown for a grant to take care that the Queen is correctly informed respecting the subject-matter of the grant, (*s*) for it is a maxim that the Queen cannot deceive, and must not be deceived. (*t*) The representations contained in a petition are made at the petitioner's own peril; and if the information or suggestion to the Crown be false, neither the Queen or any one suing in her name is prevented by the recital in the patent from showing that it is so, and the grant made upon such false information will be absolutely void. (*u*) And that not only as against the Crown, but as against third persons." (*x*)

(*o*) 1 Co. R. 52, a.
(*p*) 5 & 6 Will. IV. c. 62, s. 11.
(*q*) See the Practice and Forms, *post*.
(*q*) Vin. Abr. Prerog. (Q. b.); 1 Co. R. 43, a.
(*r*) 6 Co. R. 55, b.
(*s*) 1 Co. R. 52, a.
(*t*) Jenk. 48.
(*u*) 1 Co. R. 43, a; Com. Dig. Grant (G. 8, G. 9.)
(*x*) Morgan v. Seaward, 2 M. & W. 544; Alcock v. Cook, 5 Bing. 340.

But it is not every false recital that will vitiate a grant by patent if the Queen's intent sufficiently appears. Thus where *a grant was made to a person as a knight, who in truth was no knight; yet, as [*43] the identity of the person of the grantee sufficiently appeared, the grant was good. This was decided by the House of Lords in the case of the King and the Bishop of Chester, reversing the judgment of the Court of King's Bench. (*y*)

The recital begins by stating that the patentee has alleged that he has invented the invention described in the title which follows. Or, if the invention has been imported from abroad, that the patentee is in possession of the invention in consequence of a communication from a foreigner, or words of a similar import.

And if either of these representations, being recited in a patent, is untrue in any particular, the patent will be held void in consequence of the Queen having been deceived. (*z*)

The title of the invention always appears in the recital, and in no other part of the patent; and the general vague description which the title gives is all the information which can be obtained from the patent respecting the nature of the invention granted.

In the patents which were granted before the time when a specification began to be required, the nature of the invention was fully recited, (*a*) and a patent without such a recital would most probably be held void if it did not contain a proviso dispensing with it by reason of the grant being too general, and not sufficiently certain. (*b*) And accordingly we shall see that in all modern patents there is a provision inserted that they shall be good, notwithstanding the want of a full description of the nature of the invention. (*c*)

The language in which an invention is described in a patent is the language of the patentee himself. (*d*)

The title of an invention ought accurately to describe the nature of it; it must not be too large so as to include any thing more than the patentee has actually invented, and it must not be too narrow, so as to exclude any part of the invention.

*Accuracy of description is required in order to prevent either [*44] the Crown or the public from being deceived. In the case of *Campion* v. *Benyon*, (*e*) in the Court of Common Pleas, it was laid down that a patent being a limited monopoly, an infringement on the rights of the public, and operating as a prohibition to persons in future from adopting the precise mode used by the patentee, it should be in precise and unambiguous terms, and describe with accuracy what the inventor claims as his own, as well as the precise extent of the privileges conferred on him by such patent. And that if there be any ambiguity in the patent in any material point, that is of itself a ground for rendering the patent absolutely void. And the same law is laid down in the case of *Hill* v. *Thompson*, (*f*) in which Mr. Justice *Dallas* said, in delivering the judgment of the Court of Common Pleas, "This, like every other patent, must stand on the ground of improvement or discovery. If of improvement, it must stand on the ground of improvement invented; if of discovery, it must stand on the ground of the discovery of something altogether new; and the patent must distinguish and adapt itself accordingly. If the patent be taken out for discovery, when the alleged discovery is merely an

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(*y*) See the case reported, 2 Salk. 560; 5 Mod. 297; Show. P. C. 212.
(*z*) See Chap. III. p. 21.
(*a*) See one of those patents in 1 Webs. R.
(*b*) See Vin. Abr. Prerog. (C. c.) (F. c.)
(*c*) Vide *post*, in this Chapter.
(*d*) The King v. Wheeler, 2 B. & Ald. 349.
(*e*) 6 B. Mo. 81; 3 B. & B. 5, S. C.
(*f*) 8 Taunt. 394.

addition or improvement, it is scarcely necessary to observe, that it will be altogether void."

In the case of the *King* v. *Metcalf*, (*g*) which was a *scire facias*, brought to repeal a patent obtained by the defendant for the manufacture of hair brushes, which were described to be *tapering brushes*, it appeared, that according to the defendant's mode of manufacturing brushes the bristles would be of unequal lengths, whereas, according to the usual mode, the bristles are of the same length. Lord *Ellenborough*, C. J. held this misdescription in the title of the patent to be fatal, and directed the jury to find a verdict for the Crown, which the Court of Queen's Bench afterwards refused to disturb. A similar objection was fatal to a patent in the case of the *King* v. *Wheeler*, (*h*) which was a *scire facias* to repeal a patent obtained by the defendant for "a new or improved method of drying and preparing malt." The specification described the invention to consist in so heating malt that it should *become of a deep brown colour, and be readily soluble in hot or cold water. At the trial Lord C. J. *Abbott* thought that the title of the patent showed that it was obtained for a different thing than that stated in the specification, the patent being for a method of preparing malt, which must mean making it from barley, whereas the specification appeared to be for drying malt already made; and his Lordship directed the jury to find a verdict for the Crown. And the Court of Queen's Bench being of opinion that the invention mentioned in the specification was entirely different from that mentioned in the patent, refused to grant the defendant a new trial. It was contended on the part of the defendant in this case, that the process was in truth a preparation of malt to answer a particular purpose, (the colouring of beer and porter) and that the purpose need not be noticed in the grant. But the Court said, that although it may be true in general that the purpose need not be mentioned in the grant, yet, if in any particular case the mention of the purpose be necessary to explain the words previously used, to show that they were not used in their ordinary and obvious sense, but in a sense limited and confined to that particular purpose; in such a case the purpose ought to be mentioned. If the patentee had represented himself to be the inventor of a method of preparing malt for the purpose of colouring beer and porter, every person who read his representation, would have understood that the malt prepared, according to his method, was not intended to answer the common and known purposes of that article, viz: the brewing of beer, but was intended only for the special and particular purpose of colouring the liquor, and to be used in addition to common malt. And the Court was of opinion that no person could conjecture that to be the object of the invention mentioned in the patent.

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So if the description contained in the title represent the invention to be an improvement in any particular manufacture or process, and it appears it is no improvement at all, or no improvement in the thing named, or in any of several things named, the patent will be void by reason of the Queen having been deceived. (*i*)

[*46] And if the title or description of the invention allege that *it is applicable to any particular purpose, and it turns out that it is not applicable in the way suggested, the patent would be void for the same reason.

Thus in the case of *Felton* v. *Greaves*, (*k*) the title of the plaintiff's patent described the invention to be a machine for giving a fine edge to knives, razors, scissors, and other cutting instruments; but it appeared that the invention, as described in the specification, was inapplicable for the sharpening of scissors;

(*g*) 2 Stark. R. 249.
(*h*) 2 B. & Ald. 345.
(*i*) Morgan v. Seaward, 2 M. & W. 544.
(*k*) 3 C. & P. 611.

and Lord *Tenterden*, C. J., therefore held the patent to be void, and nonsuited the plaintiff.

But in the case of *Nickels* v. *Haslam*, (*l*) in which the title of the invention was "improvements in the manufacture of plaited articles," and it appeared that the invention, as described in the specification, consisted of a single improvement only, it was held that the title was sufficient.

The generality of the terms in which a title describes an invention, appears to be no objection to the patent, if the description is not in any respect inaccurate. (*m*) The description must, however, unquestionably give some idea, and so far as it goes, a true idea of the alleged invention. (*n*)

It has been held that if a title is so large and indefinite in its terms as to be calculated to deceive any person reading it, as to the extent or object of the grant, it will render the patent void. Thus in the case of *Cochrane* v. *Smethurst*, (*o*) it appeared that the plaintiff's patent was for an improved method of lighting cities, towns, and villages; but his invention really was an improved street lamp: and it was held by Mr. Justice *Le Blanc* that the title was too general in its terms, and the patent void.

So in the case of *Campion* v. *Benyon*, (*p*) it appeared that the plaintiff had obtained a patent for "a new and improved method of making canvas and sail-cloth with hemp and flax, or either of them, without any starch whatever." The invention really was a new mode of preparing and twisting the hemp or flax for making the canvas and sail-cloth, and the Court of Common Pleas held that the title was too extensive, and that the patent was therefore void.

*The generality of the words in a title may be restrained and explained by the specification; and it is clear that for many purposes the specification must be considered as part of the patent itself. [*47]

A specification cannot, however, extend the meaning of the title so as to make the grant include any thing not within the natural and ordinary meaning of the language made use of in the patent to describe the invention. And we shall see hereafter (*q*) that the claim in the specification of any thing not within the true extent and meaning of the grant will render the patent itself absolutely void.

After giving the title or description of the invention from the patentee's petition, it is generally farther recited that the patentee had represented that he was the true and first inventor; and that the invention was new, or had not been practised before to his knowledge or belief; and it is sometimes added that the petitioner believes the invention to be of public utility.

As the Crown in granting the sole use of an invention acts upon such representations, and confiding in the truth of them makes the grant; if either of those representations be untrue the patent will be void. (*r*)

The recital then shows that the patentee humbly prayed for a grant of the patent, and that for the motive or consideration mentioned (and nextly to be considered) her Majesty was "graciously pleased to condescend to the petitioner's request."

These words show most clearly that the grant is made (as indeed it necessarily must be) upon the petition and representation of the grantee. And these words diminish the force of the words "of our especial grace, certain knowledge, and mere motion (presently to be noticed,) (*s*) for a patent shall not be

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(*l*) 8 Scott, 97.

(*m*) Cook v. Pearce, 7 Jur. 499; see per Lord Abinger, C. B., in Neilson v. Harford, 1 Webs. R. 331.

(*n*) Sturtz v. De la Rue, 5 Russ. 324.

(*o*) 1 Stark. R. 205.

(*p*) 6 B. Mo. 71.

(*q*) *Post*, Chap. VII.

(*r*) Vide *post*, Chap. V. s. 2 & 3.

(*s*) Vide *post*, in this Chapter.

taken to proceed from the grace of the Queen merely, and so to be taken more strongly against the Queen, and in favour of the patentee, unless it is merely of the motion of the Queen, and without suit of the party." (*t*)

The concluding part of the recital in a patent for an invention is, that her [*48] Majesty "being willing to give encouragement to all arts and inventions *which may be for the public good," is pleased to grant the petitioner's request for a patent.

These words show the motive or intent of the Queen in making the grant, and the whole of the recital taken together shows that the consideration which the Queen intended to have was a new and useful invention made by the patentee.

It is a rule that the letters patent of the Queen are to be construed according to her intent, and that if they cannot take effect, according to her intent expressed in the letters patent themselves, they are void. (*tt*)

And if the Queen be deceived in the consideration which she intends to have, the grant is void. (*u*) For it is a maxim that if the consideration, which is for the benefit of the Queen (or of her subjects,) be it executed or executory, or be it on record or not on record, be not true or not duly performed, or if any prejudice may accrue to the Queen (or her subjects,) by reason of the non-performance of it, the letters patent are void. (*x*)

Every part, therefore, of the consideration which the Queen appears by a patent to intend to have for her grant of the sole use of an invention, must be actually given and performed according to the intent of the Queen, as it appears in the patent.

Thus, if the statement in the petition (as recited) that the patentee had invented the invention mentioned, or that he is the true and first inventor thereof, be untrue, the Queen is deceived as to the consideration which she intended to have from the grantee, and the patent will be void. (*y*)

So if the Queen be deceived in any of the particulars already mentioned, she does not receive the consideration she intends, and the grants upon such false considerations will be void.

And if the allegation that the invention was new, or had not been used in this kingdom, be untrue, the patent cannot be sustained. And if the allegation be untrue in any respect, as if any part of the invention comprised in a patent was not new, although the remainder of it was so, yet the whole grant will be void.

[*49] *This was determined in the case of *Brunton* v. *Hawks*, (*a*) in which the patent was for improvements in ships' anchors, windlasses, and chain cables; and it having been proved that the alleged improvements in anchors were not new, the Court of King's Bench held that the patent was void, although the other parts of the invention were new. In that case, Lord Chief Justice *Abbott*, said (*b*) "It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The King could not, in consideration of a new invention in one article, grant a patent for that article and another." And, speaking of the patent in that case, his Lordship said, "The patent is granted upon the recital that he (the patentee) has made improvements in all the three (articles,) and that they are new; and the consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The

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(*t*) Plow. 337.
(*u*) Vin. Abr. Prerog. (M. c.)
(*y*) Vide *ante*, Chap. III.
(*b*) 4 B. & Ald. 551.
(*tt*) 1 Co. R. 46, a.
(*x*) 5 Co. 94, a.
(*a*) 4 B & Ald. 541.

consideration is the entirety of the improvement of the three, and if it turns out there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention." And in the same case, Mr. Justice *Bayley* said, (*c*) "If a patent is taken out for many different things, the entire discovery of all those things is the consideration upon which the King is induced to make the grant. That consideration is entire, and if it fails in any part it fails *in toto*."

So it was held by the Court of Common Pleas, in the case of *Hill* v. *Thompson*, (*d*) that if any part of an alleged discovery comprised in a patent, being a material part, fail, (the discovery in its entirety forming one entire consideration,) the patent is altogether void.

In the case of *Kay* v. *Marshall*, (*e*) it was held that whether an invention comprised in a patent is to be considered as one entire invention, or divided into distinct parts, yet if part of what is claimed by the patentee is not properly the subject of a patent, or not new, the whole grant must be void. And the same law was laid down by the Court of Exchequer in the case of *Morgan* v. *Seaward*. (*f*)

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*3rd. *Of the Granting Part of the Patent.* [*50]

After the recital in a patent for an invention follow the words, "know ye therefore that we of *our especial grace, certain knowledge, and mere motion*, have given and granted," &c.

Grants made by the Crown merely upon the petition of the grantee, have always been construed with much greater strictness than those which proceed from the Crown voluntarily, and without suit from the grantee. For this reason the words "of an especial grace, certain knowledge, and mere motion," have long been inserted in patents in order that they may be construed more favourably for the grantees.

The words "of our especial grace," import that the grant in a patent proceeds merely from the grace and bounty of the Crown, the grantee having no right or title to the grant except through the favour of the Crown.

The words "certain knowledge," in a patent, imply that the Queen has knowledge of the subject-matter of the grant, and if there was no recital, these words would show that the Queen was acting upon certain knowledge, which she possessed independent of the representation of the grantee. (*g*)

And the words of our "mere motion," import that the grant proceeds from the bounty of the Queen of her own mere motion, and without any suit of the grantee. (*h*)

The words "of our certain knowledge and mere motion," cause the Queen's grants to be taken in the most liberal and beneficial sense, according to the Queen's intent and meaning expressed in the grant; (*i*) and a grant with these words is taken more strongly against the Crown, and in favour of the grantee, than other grants are construed to operate. (*k*)

But it seems that the words "of our especial grace, certain knowledge, and mere motion," will not reduce a royal grant to the same standard of construc-

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(*c*) 4 B. & Ald. 552.
(*d*) 8 Taunt. 401.
(*e*) 5 Bing. N. C. 492.
(*f*) 2 M. & W. 544.
(*g*) See Vin. Abr. Prerog. (E. e. 3); 10 Co. 112, b.
(*h*) See 10 Co. 112, b.
(*i*) Bro. Abr. Pat. pl. 80; 6 Co. 56, a.
(*k*) Com. Dig. Grant (G. 12.); 1 Co. R. 45, b.

tion as the grant of a subject, or bring it within the principle that it is to be taken most strongly against the grantor. (*l*) For notwithstanding [*51] these *words the Queen's grant must be construed according to her intent as it appears in the letters patent, and not in deceit of the Queen, or so that any thing shall pass by the grant against the intent or purpose expressed in the patent, or so as to make any thing pass which is not actually expressed in the grant. (*m*) So it is laid down in the case of *Alton Woods*, (*n*) that in many cases the King's grants "*of his certain knowledge and mere motion*," shall be construed beneficially for the patentee, yet such words shall never produce a violent or strained construction, or any construction which is against the intent or purpose of the grant.

It was laid down in the case of *Needler* v. *The Bishop of Winchester*, (*o*) that when the King makes a grant expressed to be of his own mere motion, and yet expresses a consideration, not personal, moving him to make the grant, and the consideration is false,—since these are contrarieties and cannot stand together,—the law shall judge upon the consideration, and shall not regard the clause, "of his own mere motion," which is *clausula clericorum*, but shall reject that as the Court does the opinion of the jury when they find the fact, and conclude upon it contrary to law.

The recital in every patent for an invention, shows that the grant was made upon the petition of the patentee, and this diminishes the force of the words "of our especial grace," &c., for the patent cannot be taken to proceed purely from the grace and favour of the Queen; and a grant by patent cannot be construed more strongly against the Queen and favourably for the patentee, unless it is made merely of the Queen's own motion, and without the suit or petition of the patentee. (*p*)

And if the matters recited in the patent are untrue, so that it appears that the Queen was deceived in any respect, either by the false suggestion of the party, or as to the consideration or motive of the grant, the patent will be wholly void. For the words "of our especial grace," &c., are of no effect or operation if the Queen has been deceived, or if the intent or purpose of her grant cannot by law take effect. (*q*) These words are words of bounty and of great effect, if the Queen be not *deceived in the intent or purpose [*52] of her grant, but they shall never be of force to maintain a grant in deceit of the Queen. (*r*)

The next material words in the patent for an invention are "have, given, and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said James Gowland, his executors, administrators, and assigns," &c.

The object of inserting the words "for us, our heirs and successors," is to show that the grant is not intended to exist merely during the life of the reigning sovereign, but is to continue in force during the whole of the term granted, notwithstanding the demise of the Crown. The grant would, however, it seems, be binding upon the Queen's successor without those words. (*s*)

In making a patent for an invention, the Crown, in pursuance of the prerogative vested in it by law for the general benefit of the community, makes the grant *on behalf of the public* for the consideration which has already been adverted to, and the benefit of which the public are to have. (*t*)

(*l*) The King v. Capper, 5 Price, 261; 1 Co. R. 46, a, 46, b.
(*m*) 1 Co. R. 46, a, 46, b; Plowd. 333.
(*n*) 1 Co. R. 49, a, 52, b, 53, a.
(*o*) Hob. 221, 222.
(*p*) Plowd. 337.
(*q*) 1 Co. R. 51, b.
(*r*) 1 Co. 53, a.
(*s*) Com. Dig. Grant (G. 3.)
(*t*) Per Lord Eldon, L. C., in Harmer v. Plane, 14 Ves. 132.

The words "give and grant" are the proper operate words in a patent for an invention not only as respects the Queen, who is the grantor but also the nature of the thing which is granted. (*u*)

The grant must be made to the inventor of the invention, or the importer of it, if it be a foreign invention, and to no other person can such a grant be legally made. (*x*)

The subject of the grant, as expressed in a patent for an invention, is the Queen's "especial license, full power, *sole* privilege and authority, that he the said J. G., his executors, administrators and assigns, and every of them, by himself and themselves, or by his or their deputy or deputies, servants or agents, or such others as he the said J. G., his executors, administrators, or assigns, shall at any time agree, and no others, from time to time, and at all times hereafter, during the term of years herein expressed. shall and lawfully may make, use, exercise, and vend his said invention within that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and Town of Berwick-upon-Tweed, *and also in the islands of Guernsey. Jersey, Alderney, Sark, and Man, and in all [*53] our colonies and plantations abroad, in such manner as to him the said J. G., his executors, administrators and assigns, or any of them shall, in his or their discretions, seem meet; and that he the said J. G., his executors, administrators and assigns shall, and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention, for, and during the term of years herein mentioned."

The subject of the grant thus made by the patent is a sole and exclusive privilege (*y*) which extends to the using and exercising of the invention or art invented by the patentee; to the making of articles by means of the invention, or the exercise of it;—and to the vending of such articles to the public.

The patentee does not acquire the privilege of using his invention by means of the grant made to him by his patent, for an inventor would have a right to use his invention independent of the grant contained in the patent. But he could not exercise that right publicly without putting others in possession of his invention, and thus giving them a right to use it; for we have seen (*z*) that a public use of an invention, without previously obtaining a patent for it, amounts to a dedication of it to the public. The use of an invention under the protection of a patent is a dedication to the public only from the end of the term granted by the patent, and the privilege granted by the patent is a right to use the invention to the exclusion of all other persons, or, more correctly speaking, a right to exclude all others from the use or exercise of the invention during the patent term. By means of such a privilege an inventor is enabled to use his invention publicly, and thus acquire the profit intended to be given him as a reward, without giving the public any right to use the invention before the expiration of the term granted by the patent.

According to the terms of the grant contained in the patent the inventor is to have the sole privilege of *making* his invention; *but it seems clear that the word make must not here be understood in its ordinary sense. [*54]

One signification of the word "make," is to practise or to use, put in action, (*a*) and the word seems to be used in that sense in the patent. The use of the word in any other sense in this place would indeed be repugnant;

(*u*) Shep. Touch. 228.
(*x*) Vide *ante*, Chapter III. p. 21, 26.
(*y*) As to the nature and disposition of this privilege, see Chapter IX.
(*z*) *Ante*, Chapter III. p. 33.
(*a*) See Johnson's dictionary.

for *making* an invention in the other sense of the word *make*, would signify an inventing or discovering, which is clearly not what is intended.

The sole privilege of making the invention as expressed to be granted by the patent, is in truth the same in substance as the sole privilege of using and exercising it; but it is clear that such an exclusive right must necessarily extend to and include the sole privilege of making articles by the use or exercise of art invented by the patentee, and it is most probable that when the form of patent was first drawn, the sole privilege of making an invention was intended to signify the sole privilege of exercising the invention in the making of articles of manufacture.

By the first section of the Statute of Monopolies, (*b*) patents granting "the sole buying, selling, making, working, or using of any thing," are declared to be void, and the proviso in favour of inventions contained in the sixth section only extends to "grants of privilege of the sole working or making of any manner of new manufactures," leaving the sole buying or selling of any thing within the prohibition contained in the first section of the statute.

The sole privilege granted by a patent for an invention authorizes the inventor "to make, use, exercise, and *vend*" the *invention* mentioned in the recital; and the grant of the sole right of vending appears at first sight to be contrary to the first section of the statute, and not to be within the meaning of the proviso. But it will be observed, that by the sixth section the sole privilege permitted to be granted is to extend to the "working or making of any manner of new manufactures," and the word "manufactures" signifies things made by art, as well as the art or practice of making such things. (*a*) The things produced by the exercise of a patent invention *must, in fact, be what [*55] are popularly termed manufactures, or vendible articles, capable of being made the subject of transactions in trade and commerce.

It has already been shown that the object of the law in permitting these grants to be made, is to reward such inventors as shall give to the public the benefit of useful inventions; and that reward is, the profit to arise from the exercise of the invention during the patent term. That profit is to be produced by the sale of articles made by means of the art invented by the patentee, or in other words, according to the invention; the profit in fact being the sum charged by the patentee to the purchaser of an article beyond the cost of its production. Whether a patentee makes and sells these articles himself, or is merely paid by others for making such articles, it is quite clear that the patentee's reward must be derived from the same source; and as no one can use the invention except the patentee, none besides him can lawfully have such articles for sale. The sole right to vend articles made by means of a patent invention is therefore not only necessarily incident to the privilege granted by the patent, but is also absolutely necessary to enable the patentee to obtain the reward which the law intends for him; and although the exception contained in the sixth section of the Statute of Monopolies does not expressly save the right of the Crown to grant the sole privilege of vending such articles, there can be no doubt that it must be implied; and indeed all patents made since the passing of the statute, have invariably granted patentees the sole privilege of vending their patent articles, and this shows the construction put upon the statute, not only at the time it was made, but ever since.

Every part of the privilege granted by a patent for an invention when thus explained is, therefore, clearly within the meaning of the exception contained in the sixth section of the Statute of Monopolies; and the Common Law authorities already cited, (*c*) as well as the constant practice of making such

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(*b*) 21 Ja. 1 c. 3. (*a*) See Johnson's dictionary. (*c*) *Ante*, Chapter II.

grants, incontestably prove that the Crown has the prerogative of granting such privileges to inventors.

The privilege thus comprised in the grant, the patentee and those claiming under him (it is declared by the patent) shall *use in such manner as to them shall "in their discretions seem meet." And therefore [*56] a patentee is not bound to exercise his privilege in any particular manner, or perhaps at all during the continuance of his right.

A declaration in an action for infringing a patent, always indeed alleges that the patentee has "made, used, exercised, and vended the invention to his great advantage and profit;" but it has never been decided whether a patentee must have exercised his invention in order to enable him to prevent others from infringing his patent right. (*d*)

Although the Lord Chancellor of Great Britain is Keeper of the Great Seal of the United Kingdom, a patent for an invention made under that seal, cannot be extended to Scotland or Ireland. The treaty for the Union of England and Scotland provides that such patents for Scotland shall be made under a seal which is by the treaty ordained to be used in the place of the Great Seal of Scotland. By the treaty for the Union of Ireland with Great Britain, the Great Seal of Ireland is retained, which is in the custody of the Lord Chancellor of Ireland, and under that seal patents for Ireland must be made.

A patent for an invention made under the Great Seal of the United Kingdom in the ordinary form, therefore, only extends to "England, Wales, and Berwick-upon-Tweed." But if a patent privilege is intended to apply to the Channel Islands, and our colonies, plantations and possessions abroad, the grant must be made under the Great Seal of the United Kingdom; and therefore it is usual to include such a grant in an English patent. The mode of doing this is merely by adding the words, "and also in our islands of Guernsey, Jersey, Alderney, Sark, and Man, and in all our colonies and plantations abroad," or such of those words as may be necessary to extend the grant to the places intended to be comprised in the privilege.

If a patent privilege is made to comprise England only, it may afterwards be extended to the colonies and other British possessions by a separate patent, (*e*) which must be made under the Great Seal of the United Kingdom.

*So far as a patent relates to some of the colonies, the grant itself seems to be sufficient to entitle the patentee to the privilege [*57] comprised in the grant. But as to many of our colonies, it is necessary to have an act of the colonial legislature to make the grant available. For further information respecting these islands and colonies, the reader is referred to the first volume of Blackstone's Commentaries, (*f*) the second volume of Peere Williams' Reports, (*g*) and the cases of *the King* v. *Vaughan*, (*h*) and *Campbell* v. *Hall*. (*i*)

The privilege granted by a patent is usually extended over the whole of England, Wales, and Berwick-upon-Tweed; but there can be no doubt that the privilege might be restricted to any particular part or parts of England and Wales. (*k*)

The patent, it will be seen, mentions all those who may exercise the sole privilege granted to the patentee. They are not only the executors, adminis-

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(*d*) Vide *post*, Chapter X. and the form of declaration in the Appendix, Chapter II. s. 4.

(*e*) Per Lord Campbell in Brown v. Annandale, 1 Webs. R. 433.

(*f*) P. 105. (*g*) P. 75.

(*h*) 4 Burr. 2500. (*i*) 1 Cowp. 204.

(*k*) See the observations of Lord Lyndhurst, L. C., and Lord Brougham, in Brown v. Annandale, 1 Webs. R. 448, 449.

trators and assigns of the patentee, but also his and their deputies, servants, agents, and such others as he or they shall agree with. This form of patent seems to have had its origin in ancient times, and indeed patents for inventions are now granted with very little variation, in the same form as they always have been ever since the passing of the Statute of Monopolies. And it seems that the persons authorized to exercise the privilege are mentioned lest any of them should be subject to punishment for monopolizing or creating a monopoly without sufficient authority. (*l*)

The next clause in a patent is, what is technically called the *habendum;* it is usually in the following form:—

"To have, hold, exercise, and enjoy the said license, powers, privileges, and advantages hereinbefore granted or mentioned, or to be granted unto the said J. G., his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the date of these presents next and immediately ensuing, and fully to be complete and ended, according to the statute in such case made and provided."

[*58] It appears from this clause that the subject of the grant *which the patentee is to enjoy is the licenses, powers, privileges, and advantages before mentioned. (*m*)

The privileges granted are always limited to the inventor, his executors, administrators and assigns, and it is clear that they could not be limited to any other person. (*n*) The limitation is made to the inventors, executors, administrators and assigns, because without these words the grant would be personal only, and the privilege would cease in case of the death of the patentee during the term. Nor would the privilege be assignable if these words of limitation did not expressly make it so. (*o*) The 6th section of the Statute of Monopolies (*p*) excepts grants to inventors only, but the legality of the limitation to the executors, administrators and assigns has never been questioned, and there can be no doubt of its being good. (*q*)

The term usually granted by a patent is fourteen years, being the full extent of the time for which such a privilege is permitted to be granted by the sixth section of the Statute of Monopolies. The Crown has the power however of making the grant for any shorter term; but the full period allowed by law is rarely more than sufficient to enable an inventor to obtain a sufficient reward, and therefore the full term of fourteen years is never refused.

The words, "from the date of these presents," show that the time during which the patent is to run must be computed exclusive of the day of the date of the patent. (*r*)

The term allowed by law for the duration of a patent being frequently insufficient to remunerate a patentee for his expense and trouble, the Crown was authorized, by a recent statute, (*s*) upon the report and advice of the Judicial Committee of the Privy Council, to prolong the term for not exceeding seven years. (*t*)

(*l*) See Bac. Abr. tit. Monop. (A). (*m*) Vide *ante*, p. 53.

(*n*) Vide 21 Ja. I. c. 3, sec. 6, and *ante*, Chap. III.

(*o*) Per Littledale, J., in Duvergier v. Fellows, 10 B. & C. 826.

(*p*) 21 Ja. I. c. 3.

(*q*) See further as to the nature and disposition of the privilege granted by a patent, *post*, Chap. IX.

(*r*) See Co. Lit. 46, b; Watson v. Pears, 2 Camp. 294; Lester v. Garland, 15 Ves. 248; Webb v. Fairmaner, 3 M. & W. 473.

(*s*) 5 & 6 Will. IV. c. 83, sec. 4.

(*t*) See further as to the term granted by a patent, and the prolongation thereof, *post*, Chap. VI.

4th. *Of the Prohibition to all others except the Patentee, his Executors, &c.*

*The next clause is what is called the prohibitory part of a patent; it is in the following form:—"And to the end that he, the [*59] said J. G., his executors, administrators and assigns, and every of them, may have and enjoy the full benefit, and the sole use and exercise of the said invention, according to our gracious intention hereinbefore declared: we do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be within that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick-upon-Tweed [and also in the islands of Guernsey, Jersey, Alderney, Sark, and Man, and in all our colonies and plantations abroad] aforesaid, that neither they nor any of them, at any time during the continuance of the said term of fourteen years, hereby granted, either directly or indirectly do make, use, put in practice the said invention, or any part of the same so attained unto by the said J. G., as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make, or cause to be made, any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the license, consent, or agreement of the said J. G., his executors, administrators, or assigns, in writing, under his or their hands and seals, first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command; and further, to be answerable to the said J. G., his executors, administrators and assigns, according to law, for his and their damages thereby occasioned."

The operation of a patent for an invention is not to grant the patentee a mere right to use the invention, but a sole and separate right to the exclusion of all other persons; the effect of the grant is therefore to prevent all persons except the *patentee, and those claiming under him, from using the inven- [*60] tion during the term of the patent. (*u*)

We have seen that all persons are bound to take notice of these grants of the Crown. (*x*) And the object of the prohibition is to warn all persons of the effect of the grant, and what the law requires them to abstain from doing.

This clause commences with a declaration of the intention of the Crown that the patentee may have and enjoy the full benefit and sole use and exercise of the invention, which shows that the intention is to reward the patentee for the invention which he undertakes to put the public in possession of.

The prohibition extends to all persons living within those parts of the realm to which the privilege extends, and during the whole term granted by the patent.

The persons prohibited are commanded not to "made, use, or *put in practice*" the invention, or any part of it. These words differ from the words of the privilege granted, which authorize the patentee to "make, use, *exercise and vend*" the invention. The words "put in practice" seem to be of essentially the same signification as the word "exercise;" and the declaration of intention at the commencement of the clause uses the word exercise, which shows that the subsequent words intended to have at least as extensive a meaning as the word exercise. It is not easy however to suggest a reason why the word "vend" should be inserted in the granting part of the patent, and not in the prohibitory. The prohibition is however only declaratory of the law, and cannot diminish the effect of the preceding grant.

(*u*) Vide *ante*, p. 53. (*x*) *Ante*, p. 38.

The clause now under consideration then proceeds to command that the persons prohibited shall not in anywise counterfeit, imitate, or resemble the invention, or make any addition to it, or subtraction from it, whereby to pretend themselves to be the inventors or devisors thereof without the license of the patentee.

This part of the prohibition, like the preceding part, is only a declaration of what the law commands; and is intended to give notice to all persons what will be an infringement of the patentee's rights, and subject them to punishment. (*y*)

[*61] *The license, consent, or agreement which a person must have in order to take him out of the meaning of this clause, it is provided shall be under hand and seal. This provision seems to render it necessary that licenses to use a patent invention should always be granted by deed. (*z*)

The prohibition addressed to all the Queen's subjects is followed by a command to her justices and officers in the following form. "And moreover we do by these presents for us, our heirs and successors, will and command all and singular, the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever, of us our heirs and successors for the time being, that they or any of them do not, nor shall at any time hereafter during the said term hereby granted, in any wise molest, trouble or hinder the said J. G., his executors, administrators or assigns, or any of them, or his or their deputies, servants or agents, in or about the due and lawful use or exercise of the aforesaid invention, or any thing relating thereto."

All monopolies (except those preserved by the provisoes in the Statute of Monopolies) are contrary to law, and persons who put them in force may be punished by fine and imprisonment. (*a*) The grant to a patentee of the sole use of his invention being a lawful grant, this clause seems to have been introduced into the patent as a protection to the patentee, so that if he were to be charged before any justices or officers of the Crown, with putting an illegal monopoly in force, he might produce his patent to them in proof of his right, and to show by the command contained in it that they had no power to proceed against him.

5th. *Of the Conditions of the Grant.*

We have already, in a former part of this work, discussed the power of the Crown to grant the sole use of inventions, (*b*) and we have seen in what manner the prerogative is limited by the Statute of Monopolies. But there is nothing

[*62] either in *our Common or Statute Law, to prevent the Crown from annexing any legal conditions to such grants as those now under consideration; and there can be no doubt that such conditions are valid and binding upon the patentee. Thus in a pardon granted by the Queen under the Great Seal, she may annex any condition to it she may think fit. (*c*)

The first condition or proviso in a patent for an invention is in the following form:

"Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted, it shall be

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(*y*) See further as to what is an infringement of a patent, *post*, Chap. XI.
(*z*) See further as to licenses, *post*, Chap. IX.
(*a*) 2 Inst. 61; 3 Inst. 181; Hawk. P. C. bk. II. c. 79, sec. 2.
(*b*) Vide *ante*, Chap. II. p. 7. (*c*) 2 Hawk, c. 37, sec. 45.

made appear to us, our heirs or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof in that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and Town of Berwick-upon-Tweed [and also in the islands of Guernsey, Jersey, Alderney, Sark, and Man, and in all our colonies and plantations abroad] aforesaid, or not invented and found out by the said J. G., as aforesaid, then upon signification or declaration thereof to be made by us, our heirs or successors, under our or their signet or privy seal, or by the Lords and others of our or their Privy Council, or any six or more of them under their hands, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, any thing hereinbefore contained to the contrary thereof in anywise notwithstanding."

The first cause for voiding the grant under this condition is in case the grant is contrary to law, or prejudicial or inconvenient to the people of the kingdom in general. This provision is merely in affirmance of the law, which says that the Queen cannot do any thing against the law, (*d*) or against right or justice; hence the maxim that the Queen cannot do wrong.

And therefore all her letters patent which are contrary to law or common justice, or which are to the prejudice of the commonwealth, or to the general injury of the people, are null *and void. (*e*) And every grant from the Queen has this condition either expressly or tacitly annexed to it, that it be not a grievance or prejudice to her Majesty's subjects; and if a grant be contrary to this condition it is void. (*f*)

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The Statute of Monopolies (*g*) also provides that patents for inventions shall not be "contrary to the law; nor mischievous to the state, by raising prices of commodities at home; or hurt of trade, or generally inconvenient." (*h*)

Another cause for avoiding a patent under this proviso or condition, is, if the invention is not new as to the public use of it within that part of the kingdom to which the grant extends. This is in accordance with the law, which requires that every invention which is made the subject of a grant by patent must be new to the public; novelty in fact being a material and necessary part of the consideration for the grant which the Queen makes on behalf of the public. (*i*) The law, however requires much more than this condition in the patent; for the Statute of Monopolies provides that an invention must be new *in this realm*, which since the Union with Scotland and Ireland, includes the whole of the United Kingdom, together with all its colonies and possessions abroad. (*j*) There was indeed formerly a very general opinion amongst the profession, that it was only necessary that an invention should be new in England, Wales, and Berwick-upon-Tweed, but that opinion was exploded by the decision of the House of Lords in *Brown* v. *Annandale*. (*k*) In that case it seems to have been erroneously supposed that the effect or intent of a patent is to grant a privilege on the terms merely of the conditions comprised in the patent, excluding all others. But that is clearly not so, for it is declared by the habendum (*l*) in the patent, that the inventor his executors, administrators and assigns, shall have and enjoy the privilege *according to the statute in such*

(*d*) Godbolt, 254.
(*e*) See Shep. Abr. Prerog. 48, sec. 5 & 7, and the authorities there cited.
(*f*) 11 Co. 86, b. (*g*) 21 Ja. I. c. 3, s. 6.
(*h*) Vide *post*, Chap. V. sec. 3.
(*i*) See this subject fully discussed, *post*, C. V. sec. 3.
(*j*) Vide *post*, Ch. V. sec. 2. (*k*) 1 Webs. R. 433.
(*l*) Vide *ante*, p. 57.

case made and provided, and therefore it is manifest that the grant is intended to be made subject to all the conditions required by the Statute of Monopolies.

[*64] If the patent had provided that novelty within a smaller district *than required by law should *be sufficient*, the patent would have been void in that respect, if not *in toto*, for the Crown has no power to dispense with the provisions of an act of Parliament. But the Crown is not restrained from making conditions which are not *contrary* to law; and a condition which is in accordance with the law, will not be bad or avoid the patent because it is not so extensive as the law itself. The fact is, that the form of this condition in a patent was adopted at a time when the realm only included England, Wales, and Berwick-upon-Tweed, and the alteration in the law produced by the Union with Scotland and Ireland, not being adverted to, the officers of the Crown have adhered to the old form which was in use prior to the alteration of the law. The condition ought now to require an invention to be new within the realm.

The last cause for avoiding a patent under this proviso is, in case the invention was not invented or found out by the patentee; or, if the invention was imported, in case it was not first introduced by the patentee. The law respecting the grantees of inventions has already been fully considered in a preceding chapter of this work, (*m*) and this clause of the proviso is intended to be in accordance with the law on that subject.

The last clause of the proviso contains a provision, that upon signification made to the Queen of any such cause for avoiding the patent, as before mentioned, the patent shall cease and be void.

The only means which the law provides for the repealing of letters patent, is by action of *scire facias* at the suit of the Queen. This provision, which is contained in the patent itself, however, provides additional modes of determining the patent, and rendering it void. There is no instance in modern times of this provision in a patent having been put in force, although, if the clause were to be framed so as to vest the power of avoiding the patent in the Judicial Committee of the Privy Council, it might be of considerable service to the public.

The second proviso or condition which is always inserted in a patent for an invention is in the following form:—

"Provided also, that these our letters patent, or anything herein contained,

[*65] shall not extend or be construed to extend *to give privilege unto the said J. Gowland, his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever, which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised in that said part of our United Kingdom of Great Britain and Ireland called England, our dominion of Wales or town of Berwick-upon-Tweed, [in the islands of Guernsey, Jersey, Alderney, Sark, and Man, or in any of our colonies and plantations abroad,] aforesaid, unto whom like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof, it being our will and pleasure that the said J. Gowland, his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions, by them invented and found out, according to the true intent and meaning of the same respective letters patent, and of these presents."

In some cases, letters patent under the Great Seal operate so as to determine the powers or privileges granted by former letters patent. Thus a new com-

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(*m*) Chap. III.

mission of the peace, contained in letters patent under the Great Seal, at once determines all the powers and authorities of justices named in previous letters patent, who are not named in the new commission.

The proviso, now under consideration, seems to have been inserted by way of caution, and in order to prevent the rights and interests of different patentees from clashing with each other. And whatever might have been the construction of a patent without such a clause, it is quite clear that the lawful intent of the Crown, as declared in this proviso, is sufficient to control the effect of a grant in a patent, and to confine the effect of it within the true intent and meaning of the Queen, as here declared.

In the case of *ex parte Fox*, (*n*) Lord *Eldon*, L. C., said that a patent might be granted for an improvement upon an invention which was the subject of a prior patent, but that the subsequent patentee would be unable to use the invention of the prior patentee during the continuance of the first *patent. The same law was laid down by the Court of Common Pleas in the case of *Crane* v. *Price*. (*o*) [*66]

The next proviso in a patent for an invention is in the following form:

"Provided likewise nevertheless, and these our letters patent are upon this express condition, that if at any time hereafter these our letters patent, or the liberty and privileges hereby by us granted, become vested in more than the number of twelve persons or their representatives, at any one time, as partners, dividing or entitled to divide, the benefit or profit obtained by reason of these our letters patent, reckoning executors or administrators as and for the single person whom they represent as to such interest, as they are or shall be entitled to in right of such their testator or intestate, that these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, any thing hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner, and for such considerations as they may by law be granted." (*p*)

We have seen (*q*) that the privilege granted by a patent cannot be assigned except by virtue of the express provisions of the patent itself. The third proviso in a patent is intended to restrain the previously unlimited power of alienation which is given to the patentee.

The object in restraining the alienation of these patent privileges has always been, firstly, to prevent the public being imposed upon by specious projects, under the colour of letters patent, which too often terminate in the ruin of those who are induced to embark in them; and, secondly, to avoid the oppression which might be practised if large and powerful companies were to be permitted to become possessed of such privileges.

In order to render a patent void under this proviso, two things are necessary, *firstly*, that the privilege granted by the patent shall become vested in more than twelve persons; *secondly*, *that more than twelve proprietors of the patent privilege shall, as partners, divide, or be entitled to divide, the benefit or profit obtained by reason of the patent. [*67]

As to the number of persons in whom a patent may become vested, the clause itself provides that executors and administrators shall only be reckoned

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(*n*) 1 V. & B. 67.

(*o*) 4 M. & G. 580; and see Harmar v. Playne, 14 Ves. 130; 11 East, 101; and Lewis v. Davis, 3 C. & P. 502.

(*p*) This clause was first introduced in the year 1832, in the place of a condition against assigning to more than *five* persons; see the form of the old clause in the Appendix; see also Carpmael Law of Patents, 2nd edit. p. 78.

(*q*) *Ante*, p. 58.

as the single person whom they represent. And it was decided by the court of Queen's Bench in the case of *Bloxam* v. *Elsee*, (*r*) that the vesting of a patent in the assignees of a bankrupt, in trust for the creditors of the bankrupt who were more than twenty in number, did not avoid the patent, on the ground that the assignees were merely "representatives" of the bankrupt; and that the object of the proviso applied to assignments by acts of parties, and not by operation of law. (*s*)

It seems also that there is another reason why a bankrupt's patent will not be avoided in consequence of his creditors exceeding twelve in number, which is, that the creditors do not acquire any right to use or exercise the patent privilege, but are only entitled to the proceeds to arise from a sale of the patent.

It seems from the form of the proviso in question that however numerous the persons may be in whom a patent becomes vested, it will not be thereby rendered void, if there are not more than twelve proprietors *as partners* dividing, or entitled to divide, the profits obtained by reason of the patent.

If therefore the patent privilege should become vested in more than twelve persons, in any other way than as partners so entitled to divide profits, the patent would not be thereby avoided. Thus if the patent were to be vested in twenty persons, in such a way that each of them should be entitled to use the patent privilege for his own profit and benefit, separate and apart from his co-proprietors, such a disposition of the patent right would not render the patent void within the meaning of this clause.

Where several persons by assignment become entitled to the privileges granted by a patent, it is difficult to determine what is the precise nature or extent of their rights amongst themselves. It seems that without some agreement amongst *them as partners to work the patent, or jointly to take the profits obtained by means of the patent, they could not be [*68] considered as partners dividing profit within the meaning of this proviso. For no proprietor of a share in a patent could be compelled to become a partner to work the invention, or to concur in granting licenses to enable others to use it, nor could he be prevented from working the invention himself separate and apart from his co-proprietors. (*t*)

This clause in a patent renders it necessary to apply to Parliament, whenever it is desired to transfer a patent to a company of more than twelve persons. Many acts of Parliament have been passed for this purpose, but few if any of the companies formed, solely for the working of inventions, have succeeded. It is clear indeed that public companies cannot conduct manufacturing or trading business so efficiently as private persons or ordinary co-partnerships, and the machinery necessary for the management and regulation of such companies, swallows up all the profit made by their trade or manufactures.

A license may be considered either as vesting in the licensee some right or interest in the privilege granted by a patent, or as granting him a dispensation from the prohibition contained in the patent, and in order to guard against a licensee being held to be an assignee, in whom a portion of the patent privilege is vested within the meaning of this proviso, it is expressly declared that nothing in the patent shall prevent the granting of legal licenses. (*u*)

We now come to the most important proviso in a patent, by which the patentee is compelled to enrol in Chancery an instrument usually called a specification; this proviso is now usually in following form :—

(*r*) 6 B. & C. 169.

(*s*) See further respecting the assignment or disposition of patents, *post*, Chapter IX.

(*t*) Vide *post*, Chapter IX.

(*u*) See further on the subject of licenses in Chapter IX. s. 3, *post*.

"Provided also that if the said J. G. shall not particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in our High Court of Chancery within [six] calendar months next, and immediately after the date of these our letters patent, that then these our letters patent, and all *liberties and advantages whatsoever hereby granted, shall utterly cease, determine and become [*69] void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding."

We have seen that it is not now the practice in a patent to give any further explanation of the invention which is comprised in it, than is contained in the title as mentioned in the recital of the patentee's petition for the patent. But certainty is an essential requisite in every grant, and more particularly so in grants by the Crown, (*x*) which are always construed strictly *against* the grantee. (*y*) And if there was no provision in a patent for obtaining a description of the invention, the subject of the grant would not only be uncertain, but incapable of being reduced to a certainty, and therefore the patent would be void.

We have already considered the effect of the grant, and of the prohibition contained in patents. (*z*) And it is evident that without some better description of an invention than a title usually affords, the public would have no means of knowing what they are prohibited from doing, during the term of the patent, or what it is they are to have at the end of the term as a consideration for the grant. The Lord Chancellor would not knowingly seal a patent which does not contain some proper provision for the benefit of the public, or, as Lord *Hardwicke*, L. C., said in the case of *ex parte O'Reilly*, (*a*) he would not seal a patent which did not put the parties under some control, even though there should be no caveat against it.

The practice of requiring a specification first commenced in the reign of Queen Anne, before which time it had been customary to introduce recitals into patents, containing descriptions of the inventions intended to be comprised in them.

By adopting the expedient of requiring a specification, at the end of a few months the patentee is benefited by the time and opportunity of completing and perfecting his invention, and producing a proper description of it; and the public have the advantage of a better description than a patentee *would be able to give if he were required to make it before or at [*70] the time he obtains his patent.

The proviso requires the patentee *particularly* to describe and ascertain the *nature* of the invention, and *the manner in which it is to be performed.* The instrument by which this is required to be done, must be under the hand and seal of the patentee, and this instrument is what is popularly termed a specification.

The specification is also required to be enrolled within *four* months in ordinary cases, and in *six* months if the patentee declares that he intends to apply for a Scotch patent. This indulgence is granted on the ground that if the specification were to be enrolled before the date of the Scotch patent, the Scotch patent would be void. (*b*)

The time within which the enrolment is to be made must be computed exclusive of the day of the date of the patent. (*c*)

(*x*) Per Heath, J., in Boulton v. Bull, 2 H. Bl. 483; and 1 Buls. 10.
(*y*) See *ante*, p. 39.
(*z*) *Ante*, p. 50, 59.
(*a*) 1 Ves. Jr. 112.
(*b*) Brown v. Annandale, 1 Webs. R. 433.
(*c*) Watson v. Pears, 2 Camp. 294.

The enrolment is also required to be in the Court of Chancery, which is the Court in which all the most important public records of the country are kept, to which the public has a right to resort for information. There are three offices for enrolments in the Court of Chancery; they are the Enrolment Office, the Rolls Chapel, and the Petty Bag Office; and an enrolment in any of these offices is a sufficient compliance with the proviso. Since the passing of a recent act of Parliament (*d*) there is some advantage in enrolling a specification in the office of the Rolls Chapel for copies obtained in that office, and stamped as the act directs, are admissible in evidence without further proof.

It seems that this proviso contained in a patent under which the grantee claims, amounts to a covenant by him that he will perform the conditions required of him. (*e*)

The clause in question concludes with a declaration, that if the condition it contains is not complied with, the patent shall become void. What is a sufficient compliance with this condition, and the essential requisite of a specification, will be fully discussed in a subsequent Chapter of this work. (*f*)

[*71] *Whenever the officers of the Crown think that an invention may be useful in any department of the public service, a condition is inserted in the patent in the following form,—or to a similar effect:—

"Provided also, that if the said J. G., his executors, administrators or assigns, shall not supply, or cause to be supplied, for our service all such articles of the said invention as he or they shall be required to supply, in such manner, at such times, and upon such reasonable prices and terms as shall be settled for that purpose by the Master General of our Ordnance, or the principal officers of the Ordnance (or by the Lords Commissioners of our Admiralty, &c.,) for the time being, that then," &c., the patent shall become void.

In such a case the performance of this proviso is one of the considerations which the patentee is to give to the public for the grant made to him by the Queen on behalf of the public. This proviso does not however enable the patentee to compel the officers of the Crown to settle the prices or terms upon which he is to supply articles according to the proviso. Thus in the case of *ex parte Perring*, (*g*) it appeared that Perring had obtained a patent for an invention of improvement in anchors, and the patent contained a proviso for making the patent void if the patentee should not supply for his late Majesty's service all such articles of the invention as he should be required to supply, in such manner, and at such prices as should be settled by the Lords Commissioners of the Admiralty for the time being. The patentee, upon an affidavit that the Admiralty had constructed anchors according to the invention, and had refused to give him adequate remuneration, moved the Court of King's Bench for a *mandamus* commanding the Lords of the Admiralty to settle the prices and terms according to the patent. But the Court held the application was not warranted by the terms of the patent, and refused the *mandamus*.

This clause also seems to amount to a covenant on the part of the patentee. (*h*)

The last clause in the body of a patent is usually the following:—

[*72] "And lastly, we do by these presents, for us our heirs and *successors, grant unto the said J. G., his executors, administrators, and assigns, that these our letters patent, or the enrolment or exemplification thereof,

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(*d*) 1 & 2 Vict. c. 94. See s. 12 & 13.

(*e*) See the case of Lord Ewre v. Strickland, Cro. Ja. 240; Brett v. Cumberland, Cro. Ja. 522; Mayor, &c. of Lyme Regis v. Henley, 3 B. & Ad. 77.

(*f*) Vide *post*, Chapter VII. (*g*) 4 A. & E. 949.

(*h*) See the cases cited, *ante*, p. 70, n. (*e*).

shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favourable and beneficial sense, for the best advantage of the said J. G., his executors, administrators, and assigns, as well in all our Courts of Record as elsewhere, and by all and singular the officers and ministers whatever of us, our heirs and successors, in that part of our said United Kingdom of Great Britain and Ireland called England, our dominion of Wales and town of Berwick-upon-Tweed, and in all our colonies and plantations abroad aforesaid, and amongst all and every the subjects of us, our heirs and successors whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereto conducing or belonging."

We have seen that the ordinary rules for construing grants of the Crown require them to be taken most strongly in favor of the Crown, and against the grantee. We have also seen that the words "of our especial grace, certain knowledge, and mere motion," are usually inserted in patents to cause them to be construed more favourably for the patentee. But notwithstanding these words, in consequence of the extremely general and vague terms in which a title usually describes an invention, it is very doubtful whether a patent would not be void for uncertainty, if it did not contain some particular provision such as that now under consideration. The provision follows almost immediately after the proviso requiring a specification of the invention, and the clause seems to have been adopted about the time when a full recital of the nature of an invention granted by patent began to be dispensed with, and a condition for a specification substituted in its place.

It is a rule that the intent of a grant, whether made by the crown or any private person, shall always be allowed to prevail as far as it is lawful; and it seems that there is nothing unlawful in making a grant of an invention named and to be afterwards described by the inventor, for the Queen cannot know anything respecting the invention, except from the representation of the inventor; and whether he gives the description* of it to the public, before or after the making of the grant cannot be material, if the description [*73] is but correct. It is true that the patentee might insert a false description of the invention in his specification, but the consequence of that would be to avoid the patent, and put an end to the grant, and the public could not receive any substantial injury from such a void grant.

This clause, in effect, provides that the patent, or the enrolment or exemplification thereof, shall be valid and construed in the most favourable sense for the patentee, notwithstanding the patent does not contain a full and certain description of the invention. If a patent, in the form we have been considering, did contain a full description of the invention granted, it would be construed favourably for the patentee; and therefore the object of this clause is to declare the intention of the Queen that that rule of construction is to prevail, and that the grant is to be valid notwithstanding the title in the patent does not fully describe the invention: or, in other words, it is intended to be a dispensation from the rule that the subject of a grant by patent must be described in it with certainty and particularity.

And as this dispensation does not produce any injury to the public, but coupled with the condition requiring a specification is rather beneficial to the public, it seems that the Queen may lawfully grant such a dispensation; (*i*) and indeed there cannot now be any doubt that patents containing this proviso are valid and sufficient in law.

(*i*) See Bozoun's case, 4 Co. R. 35—36; Attorney General v. Hungate, Hardres, 231; Vin. Abr. Prerog. (Y. a.) and (Y. a, 2;) and 3 Shep. Abr. Prerog. p. 95.

We now come to the formal conclusion of a patent, the first clause of which is—

"In witness whereof, we have caused these our letters to be made patent." The name "letters patent" is taken from the words of this clause, (*k*) by which it is in effect declared that the Queen makes her grant patent, or known to all persons by the affixing of the Great Seal to it, and publishing it to the world. The publication being the enrolment of the patent in the Chancery Rolls, to which all persons have access, (*l*) and the delivery of the patent to the patentee,

[*74] to be *shown as the evidence of his title to the privilege granted by the patent.

The patent then concludes thus, "Witness ourself at Westminster, this day of in the year of our reign." Patents for inventions, like commissions, writs, and Common Law proceedings issuing out of Chancery, are always tested in the name of the Queen herself; but commissions, writs, &c. issuing out of other Courts, are tested in the name of the chief or sole judge of the Court; thus those which issue out of the Queen's Bench, are tested, "Witness, Thomas Lord Denman, at Westminster," &c.

In *Lord Zouch and More's* case, (*m*) it is laid down that "the King's patent may be without date, for he may resort to the enrolment and privy seal, and so help it."

The deed of a subject has relation only to the time of the delivery, and not to the time of the date; but the Queen's patent has relation to the time of the date, and not to the time of the delivery; inasmuch as matters of record (which letters patent are) by presumption of law import truth in them. (*n*)

In order to prevent the mischievous effect of antedating patents, an act was passed in the 18th year of the reign of Henry VI., (*o*) by which it is provided that the day of the delivery of every warrant to the Chancellor shall be entered of record, and letters patent are to be made thereupon, bearing date the day of such delivery, and not before, and that letters patent made to the contrary are void.

Every patent for an invention has subscribed to it the words, "By writ of Privy Seal." These words are intended to show that the patent has been made in pursuance of a command contained in the Queen's writ, or warrant under her privy seal. (*p*)

And at the bottom is written the name of the clerk of the letters patent thus, "Edmunds," whose duty it is to prepare all patents which pass the Great Seal. (*q*)

[*75] To the bottom of the patent is affixed an impression of the *Great Seal, as already mentioned. (*r*) It is this seal which gives authority to the document, and all persons are bound to take notice that it is the Great Seal; so that when a patent under the Great Seal is produced, it is admissible in evidence without further proof.

By the statute 5 & 6 Will. IV. c. 83, s. 4. (*s*) the Queen in Council is enabled to grant an extension of the term comprised in a patent for an invention, and such extension is to be granted by new letters patent.

It is evident from the words of the statute that the effect of a patent for an extension can only be to extend the term granted by the first patent for such an

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(*k*) 2 Inst. 78.
(*l*) 1 Co. R. 45 a.
(*m*) Godbolt, 416.
(*n*) Plowd. 491.
(*o*) 18 Hen. VI. c. 1; see the act, Appendix, c. 1, s. 1.
(*p*) See 2 Inst. 555—556, and 8 Co. R. 18, b.
(*q*) The office is now regulated by the act 3 & 4 Will. IV. c. 84.
(*r*) Vide *ante*, p. 37.
(*s*) Amended by 2 & 3 Vict. c. 67, and extended by 7 & 8 Vict. c. 79.

additional term (not exceeding seven years) (*t*) as may be granted by the second patent; and therefore the second patent must be construed in like manner as the first; and indeed the validity of the second patent must depend upon the validity of the first.

If the first patent was void, the privilege which it purports to grant has no existence, and as a nullity cannot be extended, the second patent cannot have any effect, and will be void also.

For this reason the Privy Council will not entertain any question respecting the validity of a patent which is sought to be prolonged, unless, indeed, it has been repealed; but if the invention is of sufficient merit, will report in favour of an extension, the petitioner taking it at his own peril, subject to all objections to its validity, and for so much as it may be worth.

And it will be seen from the form of a patent for an extension (*u*) that it contains a proviso for avoiding it for want of novelty, &c., in precisely the same form as the proviso to that effect contained in an original patent.

Before the Queen in Council was enabled to prolong patent privileges, special acts of Parliament were sometimes passed for that purpose, but such acts always contained provisions for making the extended privilege liable to all the obligations which were applicable to the original grant of it by patent.

*An act of Parliament which merely enables a patentee to assign his patent privilege to a greater number of persons, or in a different [*76] mode from that allowed by the conditions contained in the patent, does not in any other way alter or affect the construction or validity of the patent. (*x*)

Nor will the confirmation of a patent under the 5 & 6 Will. IV. c. 83, s. 2, have any effect upon the construction of it, or alter it in any way except to give it validity, notwithstanding such a prior publication of the invention as mentioned in the statute, all other objections being left untouched.

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*CHAPTER V. [*77]

OF THE NATURE AND QUALITIES OF AN ART OR INVENTION WHICH MAY BE MADE THE SUBJECT OF A PATENT PRIVILEGE.

SECT. I.—*Of the Nature of the Art or Invention.*
II.—*Of the Novelty of the Art or Invention.*
III.—*Of the Utility of the Art or Invention.*

SECTION I.

Of the nature of an Invention which may be the Subject of a Privilege granted by Patent.

MUCH confusion has been introduced into Patent Law by the use of words to indicate things not within their proper and ordinary signification. Thus the word "patent" is frequently used instead of the word "invention;" sometimes it is employed to denote the *grant* contained in a patent, and sometimes the

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(*t*) Or fourteen years, under 7 & 8 Vict. c. 79.
(*u*) See the Form in the Appendix, Chapter II. s. 1.
(*x*) Hesse v. Stevenson, 3 B. & P. 565.

privilege which is the subject of such a grant. So the word "invention" is occasionally used to signify the act of discovering or finding out something; frequently to signify an art newly invented, and occasionally the article produced by means of such an art. The word "principle" has also been used in several different senses in various cases, so as to make it difficult to understand what is meant by the word.

In considering what kind of inventions may, and what cannot be made the subject of patent privileges; it becomes of the utmost importance, in treating of a subject so full of difficulty and so imperfectly understood, to use every precaution in order to guard against the improper use of these words, so as to avoid the confusion and uncertainty which would ensue if they were to be used in any sense at all loose or indeterminate.

[*78] *The word "patent" in its proper sense merely signifies an open record made by the Queen in Chancery and under the Great Seal; (*a*) and patents, or more correctly speaking, letters patent, are made for very many purposes besides granting sole rights to use inventions.

Patents (such as those which form the subject of this work) contain *grants* made by the Crown to meritorious inventors; and in some of the preceding Chapters of this work, (*b*) the policy of the law respecting such grants has been pointed out, and the law considered both as it relates to the grantor and the grantee.

A patent grant of this description confers upon the patentee a sole or exclusive *privilege*, the nature of which will be considered in a subsequent part of this work. (*c*) And the question what may be made the subject of such a sole privilege is what is purposed to be discussed in the present Chapter.

"Invention" is the general and popular name given to any thing which may be made the subject of such a privilege; or which, in the language of some of our old law books, may be *put into a privilege.*

The word invention signifies (in its proper sense) something invented, discovered, or found out, a device or contrivance; and therefore it includes many things, such as designs, patterns, models, drawings, &c., (*d*) which are clearly not inventions within the meaning of the patent law.

By the sixth section of the Statute of Monopolies, (*e*) it is declared that the previous clauses condemning all monopolies shall not extend to "any letters patent and grants of *privilege* for the term of fourteen years, or under, of *the sole working, or making of any manner of new manufacture*, within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising

[*79] prices *of commodities at home or hurt of trade or generally inconvenient," and that such grants "shall be of such force as they should be if the act had never been made, *and of none other.*"

The effect of this section of the act is in substance, that such letters patent, and grants of privilege as it describes, are not on the one hand to be taken to be within the meaning of the preceding sections, which in very general terms declare the illegality of all monopolies whatsoever: nor are they on the other hand to be rendered valid by virtue of the act: but they are to be of precisely the same force as if the act had not been passed, and no more. An invention which may legally be made the subject of a patent privilege must, therefore,

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(*a*) Vide *ante*, Chap. IV. p. 36. (*b*) Chapters I., II. and III.

(*c*) See Chap. IX. respecting the nature of a patent privilege and the disposition of it.

(*d*) The authors of such inventions derive their privileges from the express provisions of particular statutes by registration merely, and without the aid of any grant from the Crown.

(*e*) 21 Jas. I. c. 3.

not only be of such a nature as to come within the meaning of the exception contained in the statute, but it must also be such an invention as at Common Law the Crown possesses the prerogative of granting the sole use of.

In order to discover what was intended by this enactment, it will be necessary to consider the words of the enactment itself;—the Common Law which it was intended to preserve;—and the effect which a valid patent must have, which it will be seen, in the sequel, is to make a grant of the sole privilege of using a new ART for making or manufacturing vendible articles, or articles of commerce.

The material words of the act are, "letters patents, and grants of privilege, of the sole working or making of any manner of new manufactures, which others at the time of making such letters patents shall not use." (*f*) The words "letters patents and grants of privilege" show (what has already been stated) that the *subject of the grant* contained in a patent, must be a privilege, and the subsequent words point out what may be made the *subject of such a privilege.*

In order to discover what was intended by the legislature, we must have regard not only to the word "manufactures," upon which so much stress has always been laid; but also the prior words "working or making," and the subsequent words "which others at the time of making such letters patents shall not use," and give effect to the whole of them. The subject of such a privilege is to be the "working or *making of some manner of manufacture," and this indicates that the subject of the privilege must be the means by which some manufactures or articles of commerce are to be produced; and as novelty is required to be a quality in the subject of the privilege, it can only be *a new art* invented by the patentee, by means of which "working or making" is to be applied in the production of articles of commerce. [*80]

The words "which others shall not *use*," are plainly referrable to the "working or making," which is to be the subject of the privilege, and not to the articles of manufacture which are produced by means of such a working or making.

The meaning of the word "manufactures" in this section of the act has been much discussed, and almost all the cases decided respecting the subject of a patent privilege have turned upon the construction which is to be put *upon that word.* But in those cases, not only have the other words in this section of the act, which it has been shown are so material to be considered for the purpose of ascertaining what is to be the subject of a patent privilege, been entirely neglected; but the word "manufactures" has until recently had a much more limited construction put upon it than is warranted either by the context or the signification of the word itself.

The word manufacture in our language as a noun has two significations; firstly, the art or practice of making or constructing any piece of workmanship; secondly, anything made by art. (*g*)

It is extraordinary that notwithstanding this double signification of the word, the statute seems almost always to have been construed as if the word bore the latter only of these two significations.

The words "working or making," which are used in connection with the word "manufactures," in the sixth section of the act, (*h*) seem to show that the word manufactures was intended to bear both of those significations. Thus, construed with the word "working" in this section, "manufactures" signifies

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(*f*) See the clause, *ante*, p. 78, and the act in the Appendix, Chap. I. s. 1.
(*g*) See Johnson's dictionary, Webster's dictionary, &c.
(*h*) 21 Jas. I. c. 3, s. 6, *ante*, p. 78.

the arts or processes of making, and the words "working of manufactures" evidently refer to the *exercise of arts of making or constructing; [*81] and it seems indeed that the use of the word working as applied to "manufactures" in any other sense of the word than that of arts or processes of making or manufacturing would be repugnant. Construed with the word "making," the word "manufactures" signifies articles or things made, and the words "making of manufactures" appear therefore to mean the art of making articles or things which, when made, may properly be denominated manufactures. It appears from the words "any manner of," immediately preceding the words "new manufactures," in the sixth section of the statute, that the legislature intended that the word manufactures should not be understood in any narrow or limited sense; but on the contrary, that the word should be taken in the most extensive signification it will bear consistently with the context. And the subsequent words in the sixth section of the statute show that the articles to be produced by an art of working, or making, must be articles of trade or commerce. (*i*)

There were not many Common Law authorities in existence before the passing of the Statute of Monopolies, respecting the subject of such grants by patent; but those which are to be found in our books, are in perfect accordance with the construction which is here put upon the proviso in the Statute of Monopolies.

In the case of monopolies, (*k*) it is laid down that the Crown may grant a monopoly of "*a new trade*" or "*any engine tending to the furtherance of a trade that never was used before.*"

In the *Clothworkers of Ipswich* case (*l*) it is said, that "if a man hath brought in *a new invention, and a new trade,*" or "*a new discovery of anything,*" the Crown may grant to him that he only shall use such a trade.

In the case of *Edgeberry* v. *Stephens,* (*m*) it was held that the act (the exception contained in the Statute of Monopolies) intended to encourage *new devices* useful to the kingdom.

In Sheppard's Abrigment (*n*) it is said, that the King *may grant [*82] a patent for a new *trade* or *device*, or any new *engine* tending to the furtherance of it.

And Serjeant *Hawkins* says, (*o*) that the King may grant the sole use of "AN ART invented or first brought into the realm by the grantee."

These authorities, and indeed all the other old authorities on the subject, show that the object of the law in giving validity to patent privileges for new inventions was to encourage the introduction of new *arts* for the employment of the people in manufacturing articles of commerce, and to promote the trade of the country.

And the word "manufactures," coupled with the words "raising prices of commodities at home, or hurt of trade," in the exception contained in the statute, show that the intent of the exception was precisely the same as that of the Common Law.

The judgment delivered by the Court of King's Bench, in the case of *Mitchell* v. *Reynolds*, (*p*) (which occurred about eighty years after the passing of the statute,) contains a most important exposition of the law relating to monopolies in general, in which the Court lays down what they deemed capable of being made the subject of a grant by letters patent.

(*i*) See per Heath, J., in Boulton v. Bull, 2 H. Bl. 463.
(*k*) Noy, 182.
(*l*) Godb. 252—254.
(*m*) 2 Salk. 447.
(*n*) Part 3, tit. Prerog. p. 61.
(*o*) Hawk. P. Cr. Part I. c. 79, s. 20.
(*p*) 1 P. Wms. 181; 10 Mod. 130, S. C.

After stating that other monopolies granted by the Crown are void, the Court said, (*q*) that "A grant of the sole use of *a new invented* ART, is good, being indulged for the encouragement of ingenuity; but this is tied up by the statute of 21 James I. c. 3, s. 6, to the term of fourteen years; for after that time it is presumed to be a known *trade*, and to have spread itself among the people." And after stating the reasons why restraints of trade created by grants and charters from the Crown, and by-laws, are generally void, (*r*) the Court proceeds to say, "But none of the cases of customs, by-laws to enforce these customs, and *patents for the sole use of a new invented* ART, are within any of these reasons; for here no man is abridged of his liberty or disseised of his freehold; a custom is *lex loci*, and foreigners have no pretence of right in a particular society exempt from the laws of that society; **and as to new invented* ARTS *nobody can be said to have a right to that which was not in being before;* and therefore it is but a reasonable reward to ingenuity and uncommon industry." [*83]

The case of *Mitchell* v. *Reynolds* was cited, and highly approved of by the Court of Common Pleas, in the case of *The Master, Wardens and Society of Gunmakers* v. *Fell.* (*s*)

The same law is laid down in Bacon's Abrigment under the title Monopoly, (*t*) where it is said, "But it seemeth clear that the King may for a reasonable time make a good grant to any one of the sole use of *any* ART invented or first brought into the realm by the grantee."

And under the title prerogative, (*u*) in the same work, is the following passage to the same effect, "It is agreed that the King may for a reasonable time grant to a person the sole use of *any* ART first invented by him; *and this it seems the King might do at Common Law, and is therefore excepted out of the Statute of Monopolies.*"

It seems therefore that at Common Law, any new *art* of producing an article of trade or commerce might be made the subject of a patent privilege; and the grant of such a privilege appears to come precisely within the description of grants of privilege of the sole working or making of any manner of new manufactures excepted in the Statute of Monopolies.

The law as laid down in the Common Law authorities which have been cited respecting the subjects of patent privileges, appears to have been lost sight of in the cases which have been decided on the subject since the passing of the Statute of Monopolies. Indeed in almost all the subsequent cases the Courts appear to have decided the questions before them, merely upon the construction of the word "manufactures," contained in the sixth section of the Statute of Monopolies.

The consequence has been a great deal of confusion and uncertainty as to what might be made the subject of a grant by patent, within the meaning of the word "manufactures," much if not all of which might have been avoided if the old authorities had not been so entirely neglected.

According to the reported cases on Patent Law, it was long *doubted whether a mode, method, or process of itself, and apart from its produce or results, could legally be made the subject of a patent privilege; and this point remained doubtful until the question was expressly decided by the Court of Common Pleas, in favour of such a grant, in the recent case of *Crane* v. *Price.* (*x*) [*84]

Prior to that decision, however, there were many cases and dicta to be found

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(*q*) 1 P. Wms. 183.
(*r*) 1 P. Wms. 188.
(*s*) Willes, R. 388.
(*t*) Bac. Abr. tit. Monop.
(*u*) Bac. Abr. tit. Prerog. (F. 4.)
(*x*) 4 M. & G. 580.

in our books, which strongly supported the general opinion of the profession that such grants were valid.

Thus in the case of *Boulton and Watt* v. *Bull*, (*y*) the Lord Chief Justice *Eyer* said, "When the effect produced is some new substance or composition of things, it should seem that *the privilege* of the sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which though perhaps also new, will be only useful as producing the new substance. When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used *or for the process, if it be a new method of operating* with or without old mechanism by which the effect is produced." His Lordship also said, that in the list of patents with which he had been furnished, there were several for new methods of manufacturing articles in common use, where the sole merit and the whole effect produced were the saving of time and expense, and thereby lowering the price of the article, and introducing it into more general use. And his Lordship added, that he thought these methods might be said to be new manufactures in one of the common acceptations of the word, as we speak of the manufacture of glass, or any other thing of that kind. And speaking of the patent in question in that case, the same learned Judge said, "The patent cannot be for the effect produced, for it is either no substance at all, or what is exactly the same thing as to the question upon a patent, no new substance, but an old one produced advantageously for the public. It cannot be for the mechanism, for there is no new mechanism employed: it must then be for the method; and I would say, in the very significant words [*85] of Lord *Mansfield*, in the great *case of the copyright, (*z*) it must be for the method detached from all physical existence whatever." And in another part of his judgment his Lordship said, "Under the practice of making, we may class all new artificial manners of operating with the hand, or with instruments in common use, *new processes in any art* producing effects useful to the public."

In the case of *The King* v. *Wheeler*, (*a*) Lord C. J. *Abbott* said, in delivering the judgment of the Court, that the word "manufacture" might perhaps extend to a new process to be carried on by known implements or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better or more useful kind.

In the case of *Hall* v. *Jarvis*, (*b*) it appeared that the plaintiff's invention was, in substance, the application of the flame of gas instead of the flame of oil to remove the superfluous fibres from lace and other goods; and although it is evident that this is a mere process, yet it was held (at Nisi Prius) that the plaintiff's patent for this invention was good.

The case of *Hall* v. *Jarvis* was cited and approved of in the cases of *Losh* v. *Hague*, (*c*) and *Crane* v. *Price*. (*d*)

In the case of *Hill* v. *Thompson*, (*e*) Lord *Eldon*, L. C., said that there might be a valid patent for a new combination of materials previously in use for the same purpose, *or for a new method of applying such materials*. And in that case the patent was for improvements in the smelting of iron, and the invention consisted only in the use and application of lime and mine rubbish in the manufacturing of iron.

(*y*) 2 H. Bl. 463.
(*a*) 2 B. & Ald. 345.
(*c*) Ibid. 207.
(*e*) 3 Mer. 626; 1 Webs. R. 237.
(*z*) 4 Burr. 2397.
(*b*) 1 Webs. R. 100.
(*d*) 4 M. & G. 580.

In the case of *Morgan* v. *Seaward*, (*f*) Mr. Baron *Parke* said, in delivering the judgment of the Court of Exchequer, "The word 'manufacture' in the statute must be construed one of two ways; it may mean the machine when completed, *or the mode of constructing the machine.*

And in the case of *Gibson* v. *Brand*, (*g*) the Lord Chief Justice *Tindal* said, that it was not necessary in that case to go into the question, whether or not a patent can be supported for a *process* only. If the specification were properly prepared, *(his Lordship said) it probably might be considered a fit subject for a patent. And then his Lordship cited the [*86] words of Lord J. C. *Eyre*, in *Boulton* v. *Bull*, (*h*) and of Lord C. J. *Abbott*, in *The King* v. *Wheeler*, (*i*) which have already been given.

The case of *Crane* v. *Price*, (*k*) already mentioned, at length expressly decided, that a mere process may be made the subject of a patent privilege. In that case the plaintiff's invention consisted in the use of hot air blast and stone coal in the smelting of iron. The use of hot air blast in smelting was well known before the date of the patent, and stone coal had also been used in the smelting of iron, but the two things had never been used together before the plaintiff obtained his patent. It was objected for the defendant that this combined process could not be the subject of a grant by patent; but the Court of Common Pleas held that the combination of processes invented by the plaintiff was an invention within the meaning of the statute, and might well become the subject of a patent privilege.

There is another case which, when properly considered, also amounts to a decision, that a process may legally be made the subject of a patent privilege.

The case is *Russell* v. *Cowley*, (*l*) decided by the Court of Exchequer, in which the patent in question was granted to C. Whitehouse, for certain improvements in manufacturing tubes for gas and other purposes. According to the invention a long strip of flat iron was to be prepared for welding, by being bent up or turned over at the sides, until the edges met, or nearly met, so as to form a tube. The tube was then to be heated, and to be drawn through a circular hole by which the edges of the iron were pressed together and firmly welded. It appeared that prior to the date of the patent, tubes had been made by the defendants, in a mode precisely similar in principle, but with a stamp or maundril in the centre. In fact, the plaintiff's mode of making tubes was precisely the same as the defendant's, with the exception of the stamp or maundril, which according to the plaintiff's invention was entirely dispensed with, and the result was a very considerable saving in the *expense of manufacturing [*87] tubes, and the quality of the tubes was improved. The Court of Exchequer held that the invention was an invention to manufacture tubes without the use of any maundril or internal support, and that being new it was sufficiently distinct from the prior mode used by the defendant, to enable the plaintiff to support the patent. (*m*) The tubes in this case could not be the subject of the patent privilege, for they were not new; nor was there any machine which could be said to be the subject of the privilege. The only thing therefore which could be the subject of the privilege was the new art or process by means of which the edges of the strips of iron were welded together, for the purpose of manufacturing the tubes.

These cases show clearly that a process of manufacturing separate and apart, not only from the substances used in the process, but also from the things pro-

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(*f*) 2 M. & W. 544.
(*g*) 4 M. & G. 179.
(*h*) 2 H. Bl. 463.
(*i*) 2 B. & Ald. 349.
(*k*) 4 M. & G. 580.
(*l*) 1 C. M. & R. 864.
(*m*) The term granted by Whitehouse's patent was afterwards extended by the Privy Council for six years, and their Lordships highly extolled the invention; see 1 Webs. R. 473.

duced by means of it, may be made the subject of a patent privilege. Those cases appear however to have been decided upon the construction of the word "manufactures," contained in the sixth section of the Statute of Monopolies, and without considering what the subject of a patent privilege must in every case necessarily be; but it will be seen presently that the subject of a valid privilege must be *an art*, however it may be entitled, by whatever name it may be known. Patentees seem, indeed, to have found that this must be so, for there has been a most extensive use of such words as "mode" and "method" in the titles which have been given to patent inventions.

The meaning of the words mode and method was much discussed in the case of *Boulton and Watt* v. *Bull.* (*n*) Mr. Justice *Heath* said in that case, "When a mode of doing a thing is referred to something permanent, it is properly termed an engine; when to something fugitive, a method;" and that a "method is a principle reduced to practice." Mr. Justice *Rooke* said, that a new invented method conveys the idea of a new mode of constructing.

The narrow construction of the word "manufactures," as signifying merely things made, at one time caused great doubt *to be entertained [*88] respecting the validity of a patent, when the title described it as a mode or method, and the difficulty was only got over by disregarding the literal signification of the word used in the title, and construing it as meaning the article produced by means of the invention. The objection taken to a method being made the subject of such a privilege was, that it was a mere principle, and therefore not within the meaning of the word manufactures in the Statute of Monopolies.

The leading case on this subject is *Boulton and Watt* v. *Bull*, (*o*) which was an action for an infringement of a patent for an invention, intituled "a method of lessening the consumption of steam and fuel in fire-engines." The specification commenced as follows:—"My method of lessening the consumption of steam, and consequently fuel in fire-engines, consists of the following principles:" and then the patentee proceeded to describe the nature of the invention, according to which the cylinder of the engine was to be kept hot, the steam condensed in a separate vessel, the superfluous air, &c., was to be drawn out of the cylinder and condenser by air-pumps, the expansive force of steam was to be used in some cases instead of the pressure of the atmosphere, &c.

At the trial, a special case was reserved for the opinion of the Court of Common Pleas, in which it was twice argued. The principal objection taken to the patent on behalf of the defendant was that the patent was for a principle, and that a principle is not a manufacture within the meaning of the exception contained in the 6th section of the Statute of Monopolies.

The Court was equally divided in opinion respecting the validity of the patent, two of the Judges being of opinion that the invention was a manufacture within the meaning of the Patent Laws, and the other two, that it was not such a manufacture.

Mr. Justice *Rooke* said, "The term 'principle' is equivocal; it may denote either the radical elementary truths of a science, or those consequential axioms which are founded on radical truths, but which are used as fundamental truths by those who do not find it expedient to have recourse to first principles." Mr. Justice *Heath* said, "The Marquis of Worcester *discovered, [*89] in the last century, the expansive force of steam, and first applied it to machinery. As the original inventor he was clearly entitled to a patent. Would the patent have been good applied to all machinery, or to the machines which he had discovered? The patent decides the question. It must be for

(*n*) 2 H. Bl. 463.

(*o*) 2 H. Bl. 463; Dav. P. C. 162.

the vendible matter and not the principle. Another objection may be urged against the patent upon the application of the principle to an old machine, which is, that whatever machinery may be hereafter invented would be an infringement of the patent if it be founded on the same principle. If this were so, it would reverse the clearest positions of law respecting patents for machinery, by which it has been always holden; that the organization of a machine may be the subject of a patent, but principles cannot." Mr. Justice *Buller* said, that "The very statement of what a principle is, proves it not to be a ground for a patent; it is the first ground and rule for arts and sciences; or, in other words, the elements and rudiments of them. A patent must be for some new production from those elements, and not for the elements themselves." And Lord Chief Justice *Eyre* said, "Undoubtedly there can be no patent for a mere principle; but for a principle so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent."

All the four Judges before whom this case was argued were of opinion, that a principle could not be made the subject-matter of a grant by patent; but they differed in opinion as to the construction of the title and specification, two of them deeming that the intention of the patent was to grant, and of the specification to claim, the sole use of a principle which did not come within the meaning of the law in favour of patents; whilst the other two Judges were of opinion, that notwithstanding the alleged improper use of the words method and principle in the patent and specification, the invention was substantially the engine or machine by which the method or principle was to be carried into effect, and that the misapplication of the terms method and principle did not signify, because it was clear that the words in the patent and specification were substantially intended to describe the machine, *engine, and effect produced, and not merely the principle upon which the invention [*90] was founded.

In the case of *The King* v. *Wheeler*, (*p*) the Court of King's Bench laid it down as law, that no merely philosophical or abstract principle can answer to the word manufactures, in the proviso in the Statute of Monopolies; and that something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or *at the least some new mode of employing practically his art and skill, is requisite to satisfy this word.*

It is clear indeed that first principles, such as the fundamental laws of mechanics, chemistry, or any other science, cannot be made the subject of a patent privilege. First principles are capable of an endless variety of uses or applications, and they are the common property of all men, who are at liberty to make any use of them they may think fit, or apply them in any manner their ingenuity may suggest, provided they do not attempt to appropriate to themselves exclusively any ground preoccupied by any other person. No principle or primary law of science can of itself, and apart from the practical application of it, be capable of producing any vendible article or manufacture; and therefore unless a person who discovers such a principle or law makes some practical use of it, so as to produce some article which the public requires and will purchase, he cannot give the public the consideration which the law requires to be given for the grant of a sole privilege. The object of the law was not to reward mere speculative discovery, but to encourage industry, and procure for the public the benefit of new manufactures.

(*p*) 2 B. & Ald. 349.

But every art or invention must adopt principle, or include the application of it to some extent, (*q*) and the principle of an invention thus becomes an essential part of it; indeed any new art which is made the subject of a grant by the Crown can only be some new practical application of principles or laws, which has been invented by the patentee, for the purpose of producing articles of manufacture useful to the public.

[*91] The word "principle" is frequently used in such phrases *as "principle of the invention," to designate some peculiar mode or method of constructing any thing according to a particular invention. In this sense a principle signifies the particular practical application of some principle or principles, for the purposes of an invention which is properly speaking an art. Thus the principle of an invention of a new machine, signifies the peculiar art by means of which the new machine is constructed. There is nothing improper in this use of the word principle; and when it is so used, that is, when it is used to designate the peculiar mode of constructing anything according to an invention, it is clearly an art which may be made the subject of a patent privilege.

The form of patent for granting privileges in the useful arts, has continued to be the same in all essential particulars ever since the passing of the Statute of Monopolies; and if such a grant be examined, it will be seen that the form and effect of it are in perfect accordance with what has been stated respecting the subject of a patent privilege.

It has already been shown that the effect of a patent is to grant a sole or exclusive privilege. (*r*) The patent itself purports to grant such a privilege in the *invention*, and the question is, what is meant by the word invention, which according to the patent the patentee is to have the sole use of?

It is important to distinguish between the use of an invention which a patentee has thus granted to him, and the articles or results which may be produced by means of the invention. At the time a patent is granted the patentee must have made the discovery or invention to which the grant relates; but an inventing or discovering of any thing is essentially an operation of the mind, and it is not necessary that the inventor should have actually made or produced any thing by means of his invention; and, indeed, one class of inventions, viz: imported inventions, are hardly ever used, even experimentally, in this country before the date of the patent. And if a patentee happens to have produced any article of manufacture by means of his invention prior to the date of his patent, the privilege granted to him by the Crown does not vest in him the sole use of such article; for unless he has transferred it to some other person, he

[*92] remains the proprietor *of it, and has the sole dominion over it as being part of his own property; and he alone has the privilege of using it as he pleases, *and that wholly independent of the privilege granted to him by his patent.* And with respect to articles which are to be made by the patentee *after* the date of the patent, it is clear that he does not acquire the sole use of them by force of the grant of privilege contained in the patent; for they must necessarily be composed of materials which he must purchase or acquire a right to without the aid of the patent; and they must also be produced by power or labour, which the patentee must pay for or bestow upon those materials in some shape or other.

If any person, except the patentee, make articles according to the patentee's invention, he commits an infringement of the patent, and yet the privilege granted by the patent did not vest any right in the patentee to make the parti-

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(*q*) Vide per Lord Lyndhurst, C. B., in Minter v. Wells, 5 Tyr. 165.
(*r*) Vide *ante*, Chap. IV. p. 53, and *ante*, p. 78.

cular articles which have been made in violation of the patent, for the materials of which they are composed were never his property, and therefore he could not exercise any control over them. But the person who thus makes such articles must necessarily use the art invented by the patentee, and so infringes the patent.

The only thing therefore which can be the subject of the privilege granted by a patent, is the ART by means of which the articles are made or manufactured; and the privilege granted by the patent not only secures to the patentee the right of using the art himself, but gives him the sole right, or the right to exercise it to the exclusion of all other persons during the term limited by the patent.

And when any one makes any thing contrary to a patent privilege, the infringement consists in the use of the art invented by the patentee, and which the patentee has, by virtue of the patent, acquired the sole privilege of exercising for his own profit and benefit. (*s*)

To illustrate the meaning of this, let us suppose a person to have obtained a patent for an invention of a new chair. The patent privilege does not include the sole use of every or any chair made or to be made according to the invention, *but it grants the sole use of the art, by means of which such [*93] chairs may be produced. That the patent would not in such a case grant the sole use of chairs made according to the invention is evident, because no one could be liable to an action for infringing the patent by merely sitting down upon or using a chair which may have been made by some other person in violation of the patent.

The word invention then in a patent grant means the art which the patentee alleges that he has invented, and therefore that art is the subject of the privilege which is granted by the patent.

If a valid patent be thus construed, the subject of the privilege which it grants, will appear to be an art within the meaning of the Common Law authorities, which have been cited.

It has been stated already that the object of the proviso contained in the sixth section of the Statute of Monopolies (*t*) was to preserve the Common Law authority vested in the Crown, and the words of that proviso are in accordance with the construction here put upon the grant of a patent privilege. (*u*)

The recital which has always been inserted in a patent for an invention, ever since the passing of the Statute of Monopolies, after stating the substance of the patentee's petition for a patent, *pursuant to the statute in such case made and provided*, concludes with these words, "and we being willing to give encouragement to all *arts* and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request." (*x*) This shows that the exception in the statute has always been construed to extend to grants of the sole use of useful *arts* and inventions, and that the intent of a grant by patent is to vest in the patentee the sole use of such an art, and not of the articles made according to it.

The language of Lord *Ellenborough*, in the case of *Huddart* v. *Grimshaw*, (*y*) strongly confirms the view here taken respecting the subject-matter of a privilege granted by letters patent. His Lordship there said, "In inventions of this sort, and every *other through the medium of me- [*94] chanism, there are some materials which are common, and cannot be supposed to be appropriated in the terms of any patent. There are common

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(*s*) See further respecting what is an infringement of a patent, *post*, Chaps. X. and XI.
(*t*) 21 Ja. I. c. 3.
(*u*) Vide *ante*, p. 91.
(*x*) Vide *ante*, Chap. IV. p. 47, 48.
(*y*) Dav. Pat. Cas. 278.

elementary materials to work with in machinery, but *it is the adoption of those materials, to the execution of any particular purpose, that constitutes the invention:* and if the application of them be new, if the combination in its nature be essentially new, if it be productive of a new end, and beneficial to the public, it is that species of invention, which, protected by the King's patent, ought to continue to the person the sole right of vending it."

The invention in that case was intituled "a new mode, or art, of making great cables and other cordage so as to attain a greater degree of strength therein by a more equal distribution of the strain upon the yarns." And, according to the construction which it is contended must necessarily be put upon the patent, the privilege it granted was the sole use of the art of making cables and cordage of a particular description; and the cables and cordage produced being clearly manufactures, the subject-matter of the grant was an invention of an art, of making a manufacture within the proviso contained in the Statute of Monopolies.

There cannot be a valid patent privilege for a new use of an old invention. This was in effect decided by the recent case of *Kay* v. *Marshall*, (*z*) which was ultimately determined by the highest tribunal in the kingdom. In that case the patentee applied to flax-spinning machinery of a description which had been before applied to the spinning of cotton and other fibrous materials, and it was held by the Court of Common Pleas, afterwards by the Master of the Rolls, and ultimately by the House of Lords, that the patent was void.

The mode of producing the machinery used in that case was really an old art, and so also was the mode of spinning used by the patentee; and therefore neither of those arts could be made the subject of the privilege which the patent purported to grant. And the reason why such a patent is void, is, that there is no new art which can be made the subject of the patent privilege, the patentee having merely applied an old art to a new use.

[*95] *In the case of *Losh* v. *Hague*, (*a*) which was an action for infringing the plaintiff's patent for "improvements in the construction of wheels for carriages to be used on railways," tried before Lord *Abinger*, C. B., it was contended that wheels invented before the date of the patent were substantially the same as the plaintiff's; and his Lordship, amongst other things, said to the jury, that, "If the wheels had been made and sold to any one individual, the public's not wanting them, because there were no railways, their not being adapted to any particular use which at that time was open to the public to apply them to, makes no difference."

In the same case, Lord *Abinger* also said to the jury, (*b*) "The learned counsel has mentioned to you a particular case (*c*) in which an argand lamp, burning oil, having been applied for singeing gauze, somebody else afterwards applied a lamp supplied with gas for singeing lace, which was a novel invention, and for which an argand lamp is not applicable, because gas does not burn in the same way as oil in an argand lamp. But a man having discovered by the application of gas he could more effectually burn the cottony parts of the gauze by passing it over the gas, his patent is good. That was the application of a new contrivance to the same purpose; *but it is a different thing when you take out a patent for applying a new contrivance to an old object, and applying an old contrivance to a new object*—that is a very different thing: if I am wrong I shall be corrected. In the case the learned counsel put, he says, if a surgeon goes into a mercer's shop, and sees the mercer cutting velvet or silk

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(*z*) 5 Bing. N. C. 492; 1 Beavan, 535; and 8 Cl. & Fin. 245.
(*a*) 1 Webs. R. 202. (*b*) Ibid. 207.
(*c*) Hall v. Jarvis, 1 Webs. R. 100.

with a pair of scissors with a knob to them, he seeing that would have a right to take out a patent in order to apply the same scissors to cutting a sore or a patient's skin. I do not quite agree with that law. I think, if the surgeon had gone to him (the mercer) and said, 'I see how well your scissors cut,' and he said, 'I can apply them instead of a lancet, by putting a knob at the end,' that would be quite a different thing, and he might get a patent for that; but it would be a very extraordinary thing to say, that because all mankind have been accustomed to eat soup with a spoon, that a man could take out a patent because he *says you might eat peas with a spoon. The law on the subject is this; that you cannot have a patent for applying a well known thing which might be applied to 50,000 different purposes, for applying it to an operation which is exactly analogous to what was done before. Suppose a man invents a pair of scissors to cut cloth with, if the scissors were never invented before, he could take out a patent for it. If another man found he could cut silk with them, why should he take out a patent for that?" His Lordship also said to the jury, "If you are of opinion this wheel has been constructed according to the defendant's evidence by the persons who have been mentioned, long before the plaintiff's patent, that although there were no railroads then to apply them to, and no demand for such wheels, *yet that the application of them to railroads afterwards by Mr. Losh will not give effect to his patent*, if part of that which is claimed as a new improvement by him, is, in fact, an old improvement, invented by other people, and used for other purposes."

[*96]

The subject of the patent privilege in the case of *Losh* v. *Hague*, (*d*) was the art of manufacturing a certain description of carriage wheels, which were described as capable of being used on railways. And if it were shown that this art had been known and used before the date of the patent in the manufacture of wheels *for any purpose whatsoever*, the art was not new when the patent was granted; and therefore notwithstanding the new use or application of the wheels to run on railways instead of common roads, the patent would be void. Such a new use, as we have shown already, not being capable of being made the subject of a patent privilege.

The observation made by Lord *Abinger*, in *Losh* v. *Hague*, that "it is a different thing when you take out a patent for applying a new contrivance to an old object, and applying an old contrivance to a new object," is most important, and shows that what the law requires is, that the art or contrivance, which is *the subject of the privilege*, *must be new*, and that it is not sufficient that the object or application of a contrivance is new if the contrivance itself be old.

That the invention of a mere process may be made the subject of a grant by patent, has been established by the case of *Crane* v. *Price*, (*e*) although the object or produce of the invention is old and well known; but that case shows that the process itself must be new, in order to be the subject of a valid patent privilege. The "applying of a new contrivance to an old object," means a new art invented for the manufacturing articles or producing effects previously known; but the art itself, which (as we have seen) must be the subject of the patent, being new, the want of novelty in the produce of the art is no objection to the patent.

[*97]

But the "applying an old contrivance to a new object," is merely a new use or application of an art or invention previously well known; and as the art or invention is not new, it cannot be granted by patent; nor, as we have already seen, (*f*) can the new use of it be made the subject of such a grant of privilege.

(*d*) 1 Webs. R. 202.
(*e*) 4 M. & G. 580.
(*f*) Vide *ante*, p. 94, 95.

In the case of *Hall* v. *Jarvis*, (*g*) referred to by Lord *Abinger* in *Losh* v. *Hague*, (*h*) the invention was of a new process of singeing the superfluous fibres of gauze or lace by means of the flame of gas; the flame of oil having been previously applied to a similar purpose; but the flame of gas, which produces a very different effect, had never been applied in the same or in any similar way. This application of gas flame was, therefore, an entirely new art; and being also an art applicable in the manufacture of vendible articles, it was clearly capable of being made the subject of a grant by patent. But if, before the date of Hall's patent, gas flame had been applied to any purpose similar to that of singeing gauze or lace, then the *art* would not have been new, and the patent would have been void.

The same law is also applicable to the produce of any art, or the articles produced by means of the exercise of an art; and, therefore, a new use of such articles cannot be made the subject of a patent privilege, unless, indeed, such new use form an essential part of some other art of working or making vendible manufactures, which may legally be made the subject of a privilege.

[*98] *In the case of *Boulton* v. *Bull*, Mr. Justice *Buller* said, (*i*) "Suppose the world were better informed than it is how to prepare Dr. James's fever powder, and an ingenious physician should find out that it was a specific cure for consumption, if given in particular quantities? I think it must be conceded that such a patent would be void: and yet the use of the patent (invention) would be new, and the effect of it as materially different from what it is now as life is from death. So in the case of a late discovery, which as far as experience has hitherto gone, is said to have proved efficacious—that of the medical properties of arsenic in curing agues—could a patent be supported for the sole use of arsenic in aguish complaints?"

In the case of Dr. James's fever powder mentioned by the learned Judge, it is clear that if the original inventor had obtained a patent privilege, the subject of it would have been the new art of manufacturing the powder, which is notoriously a vendible article, and therefore, according to the definition already given, the invention would come within the meaning of the law which authorizes the grant of patent privileges for inventions. The description of the powder, "*fever* powder," would merely point out a use which *may* be made of the article produced by means of the art or invention, which would be comprised in the patent privilege: but such use of the powder would not be any part of the subject of the privilege, which would be merely the art by means of which the powder is manufactured. For the art of using the powder in curing fevers, would not be an art of manufacturing vendible articles, which, as we have seen, is requisite in order to make an art the subject of a grant by patent, (*k*) and the art of using the powder in curing pulmonary consumptions would be an art of precisely the same description, totally inapplicable in the manufacturing of any vendible article, and therefore clearly not such an art as could be made the subject of a patent privilege. The only thing therefore respecting Dr. James's fever powder, which could be made the subject of a patent privilege, was the art by means of which the powder is manufactured or produced; and as that

[*99] art had been known and *practised in the production of the powder for the purpose of curing fevers, it could not be deemed new merely because some new use of its produce had been discovered, nor could the new use of the powder itself be made the subject of a privilege for the reason already given.

(*g*) 1 Webs. R. 207. (*h*) Ibid. 100.
(*i*) Dav. P. C. 199, 200.
(*k*) Vide *ante*, p. 55, 81, and *post*, p. 101, 102.

The same observations evidently apply with equal force to the supposed case of a patent for the use of arsenic in curing aguish complaints. The particular use or application of any preparation of arsenic *in curing any disorder*, not being the subject of a patent, and the art of preparing the drug for some use or purpose being known, the sole use of the art of preparing it cannot be made the subject of a patent privilege, merely because some new use or application of it has been discovered, nor could the new use of the drug be made the subject of such a privilege.

If we consider the nature of the articles or manufactures produced by the exercise of an art or invention, we shall find the strongest confirmation of what has been said respecting the subject of a patent privilege.

In the case of *Hornblower* v. *Boulton*, (*l*) Lord *Kenyon*, C. J., said, that he understood a manufacture to be something made by the hand of man. This was doubtless one of the primary significations of the word manufacture at a time when manual labour was the chief, if not the only power applicable in the production of manufactures; but that state of things has long passed way, and very few of the articles which are properly called manufactures, are now produced by the direct or immediate application of manual labour. As, however, all the machinery used in our manufactories is made directly or indirectly by the hand of man, and the machines themselves require the hand of man to direct and regulate them, there does not seem to be any thing improper in the application of the term manufactures, as explained by Lord *Kenyon*, to signify the products of such machinery. (*m*)

In order to produce a manufacture or manufactured article, three things or classes of things only are necessary: *firstly*, The crude or raw material; *secondly*, The power by which the material is operated upon; and, *thirdly*, The art, skill, or *cunning, by means of which the power is directed in its operation upon the raw material. [*100]

Whilst matter remains in a state of nature, and before it has been operated upon, it cannot come within the meaning of the word manufacture; and for the production of many manufactures, the original elements found in nature, which enter into their composition, must be subjected to many, and frequently extremely complicated, processes.

The power which is applied to matter in its original state in order to render it fit for the use of man, may be of any description sufficient to produce the desired effect, such as manual labour, the power of the steam-engine, water power, &c. And without the requisite physical power it is clear that the raw material could not be transformed into the manufactured state.

And however numerous and excellent our materials for manufacturing may be, and however great the extent of the physical power we have at command, we shall still be unable to produce any manufacture unless we have also the *art* or *skill* to direct our power or labour in its operation so as to produce the desired result. But having acquired the art or skill, and having the materials, and also the requisite power within our reach, we have no further difficulty in compassing our object in the production of any desired manufacture.

The raw materials which are used, and the power which is exercised, in the production of manufactures, are things which are well known, and which (apart from the question of property) may be said to be in common with all mankind, to be used or applied in any way they may think fit, and they cannot by themselves be made the subject of a patent monopoly.

(*l*) 8 T. R. 98; Dav. P. C. 225.

(*m*) See the double signification of the word manufacture, mentioned *ante*, p. 80.

And therefore, as we have already shown, it is only the art by means of which a manufacture is produced which can be made the subject of an exclusive privilege; and it is only such an art as this that (when newly discovered) is properly an invention within the meaning of our Patent Law.

The art or invention by means of which articles of manufacture are produced, may be denominated the metaphysical part of the manufacture, for it has its origin in the mind, and by the mind must power always be directed in order to produce a manufacture.

[*101] *Such arts may properly be termed useful arts, in contradistinction to the fine arts. And the nature of the art which may be made the subject of a patent privilege is well illustrated by comparing it with some of the productions of the fine arts, in which their authors or inventors obtain privileges or copyrights by virtue of the provisions of various statutes.

Thus the person who first invented the art of copper-plate engraving, or of lithography, might have had a patent privilege for his invention; for it was a new art applicable to the production of prints, according to any design which might be invented by the artist, and such prints are clearly vendible articles, or articles of commerce.

A new design for a print or engraving may be made the subject of a privilege, that is to say, the author may acquire a copyright in it by complying with the provisions of certain acts of Parliament. But such a design cannot be made the subject of a patent privilege, because, although it is new, it is not a new *art*, nor is it an art of working, or making manufactures, or articles of commerce; but, on the contrary, it is merely the produce of an art, or produced by the exercise of one of the fine arts, the art of designing, which is an old and well-known art.

The making of copies to which the privilege in such a design extends, is effected by the exercise of the art of printing, which is a very different art from that by means of which the design, or even the engraving, was produced; but in making articles according to an invention which may be legally comprised in a patent privilege, it becomes necessary to exercise the art of working or making, which has been invented by the patentee, and it may be an art applicable in the making of articles according to an infinite variety of designs.

The art of working or making, which is made the subject of a patent privilege, must (as already stated) be an art for the production of vendible articles, or articles of trade or commerce capable of being bought and sold. That a patent article, or article produced by means of an invention, must be vendible,

[*102] is laid down in several cases, (*o*) and there are two *reasons why the articles manufactured according to a patent invention must be vendible: *firstly*, Because if such articles cannot be sold, the invention will not be used, and therefore will not give any new employment to the people, and the public will receive no benefit from the invention; and, *secondly*, Because the intent of the patent is to reward the inventor by means of the profit arising from the making and selling the patent articles during the continuance of the privilege.

A patent privilege for such an art would be void, because the art is not such as comes within the meaning of the Patent Law, (*p*) and therefore is not such an art as could legally be made the subject of a patent privilege.

(*o*) See per Heath, J., in Boulton v. Bull, 2 H. Bl. 463; per Abbott, C. J., in R. v. Wheeler, 2 B. & Ald. 349; and the judgment of the Court in Cornish v. Keene, 3 N. C. 570; in which last case the patent article was said to be a vendible article produced by the *art* and hand of man.

(*p*) Vide *ante*, p. 81, 55.

And it has already been shown, (*q*) that if the Queen's grant cannot take effect according to the intent of it, it will be absolutely void; and a patent privilege for an art which is incapable of producing vendible articles must therefore be void for both of the reasons just stated. For the intent of the grant is clearly to benefit the public and reward the patentee; and an art for producing an article not vendible cannot benefit the public, nor can a sole privilege in such an art produce any profit to the patentee.

SECTION II.

Of the Novelty of an Art or Invention which is required in order to make it a good Subject of a Patent Privilege.

One essential requisite in every art or invention which is made the subject of a patent privilege, is, that it should be new at the time the privilege is granted. This is required for two reasons:—*Firstly*, Because no one can lawfully be deprived of the right to use a known art or trade; and, *secondly*, Because if an invention is known, the public will receive no consideration from the patentee for the grant of the sole right of using it.

That the grant of a privilege in a known art or trade is illegal, was decided in several cases before the passing of the Statute of Monopolies. Thus in the case of monopolies, **Darcy* v. *Allein*, (*r*) it was determined that a patent granting the sole making of playing cards was void, the art of making cards being known at the time of making the patent. So in the *Clothworkers of Ipswich* case, (*s*) it was laid down that the grant by the King of the sole right to exercise the trade or occupation of a clothworker or tailor, or of any other known art or occupation, was contrary to law and void. And in the case of *Mitchell* v. *Reynolds*, (*t*) the Court of Queen's Bench laid down as law that a grant by the Crown of the sole exercise of any *known* trade is against the Common Law and *Magna Charta*, and is therefore void.

[*103]

The same law is laid down in Sir Edward Coke's third Institute, (*u*) in Bacon's Abridgment, (*x*) Hawkins's Pleas of the Crown, (*y*) and Sheppard's Abridgment. (*z*)

The Queen's prerogative does not extend to any thing which is injurious to her subjects. (*a*) She cannot by her patent do wrong, (*b*) or enable another to do so; (*c*) and we have seen (*d*) that in granting the sole use of inventions, the Crown acts on behalf of *and for the benefit of the public.*

Every person has *primâ facie* a right to search for discoveries and improvements in the useful arts, and to use any discovery of such an art which he may make in any manner he pleases. (*e*) The grant of the sole use of an invention to any person restrains every other person from using it, during the term, even if he of himself and unaided should happen to make precisely the same discovery.

(*q*) *Ante*, p. 48.
(*r*) 11 Co. 86 a; Moor. 672.
(*s*) Godb. 254; 1 Rol. R. 4.
(*t*) 1 P. Wms. 181.
(*u*) Chap. 85, p. 181.
(*x*) Titles Monop. and Prerog. (F. 4.)
(*y*) Part I. c. 79, s. 2.
(*z*) Part III. pp. 61, 62.
(*a*) Finch, 84.
(*b*) 1 Co. R. 44 b, 45 b; Noy, R. 182; 3 Shep. Abr. 48.
(*c*) Godb. 254.
(*d*) *Ante*, Chap. II. p. 7.
(*e*) Vide *ante*, Chap. III.

It would be unjust therefore to deprive any person of his liberty to make and use such inventions, if it were not for some consideration given by the patentee to the public. The only thing which a patentee gives to the public is a knowledge of his invention, and a patent is in effect a bargain between the patentee and the public, in which the public in consideration of an inventor communicating to them a knowledge of his invention, so that they may afterwards be enabled to practice it, *grant to him the sole use of his invention for a limited time. (*f*) But if an invention is not new, the patentee does not communicate any thing to the public which they did not know before; and therefore the patentee gives them nothing which can be considered as a consideration for the grant, and therefore the patent is wholly void.

[*104]

The necessity for a consideration to support such a bargain, is not confined to the law of patents; a promise made without consideration is not binding, and no action will lie for the breach of it; (*g*) for in every contract there must be some good or valuable consideration between the parties, otherwise the contract is void. (*h*)

In the case of *Myddleton* v. *Lord Kenyon*, (*i*) Lord *Loughborough*, L. C., said that "a bargain without consideration is a contradiction in terms, and cannot exist." And as a patent is a bargain between the public and an inventor, it cannot be supported if it be made without consideration.

All the old authorities respecting the prerogative of the Crown to grant patent privileges, particularly mention novelty in the art or invention as essential to render a patent valid.

Thus in the case of *Darcy* v. *Allin*, (*k*) already cited, it is said "where any man by his own charge and industry, or by his own wit or invention, doth bring any *new trade* into the realm, or any engine tending to the furtherance of a trade that *never was used before*, and that for the good of the realm; that in such cases the King may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, *in consideration of the good that he doth bring by its invention to the commonwealth;* otherwise not."

In *Mr. Hastings'* case, (*l*) it is said that a patent was granted to him in consideration that he brought in the skill of making frisadoes as they were made in Harlem and Amsterdam, beyond seas, *being not used in England.*

In *Humphrey's* case, (*m*) a patent was granted to him for the sole use of an invention of an instrument for melting lead. *And upon his suing persons for an infringement of the patent, a question was raised whether the instrument was newly invented by him, and the Court held that if a similar instrument had been used before the grant of the patent, Humphrey could not have the sole use of the invention.

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In Moore's Reports, (*n*) it is laid down that the King cannot grant a patent to restrain people in their usual trades and occupations; and that no occupation can be prohibited or put in monopoly, *but only such thing as is newly invented* by the skill of man, and that may be appropriated by patent.

So in the *Clothworkers of Ipswich* case, (*o*) also before cited, it is said that "if a man hath brought in a *new* invention and a *new* trade within the kingdom in peril of his life and consumption of his estate or stock, &c., or if a man hath made a *new* discovery of any thing; in such cases the King of his

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(*f*) 14 Ves. 131, 136.
(*g*) Rann v. Hughes, 7 T. R. 350; Barrell v. Trussell, 4 Taunt. 117.
(*h*) Noy, Dialog. p. 44; Max. 87; Dr. & Stu. II. 24; Finch, Law, 34; and see Dyer, 76 a; Shep. Touch. 285.
(*i*) 2 Ves. Jr. 408.
(*k*) Noy, R. 182.
(*l*) Ibid.
(*m*) Ibid. 183.
(*n*) P. 672.
(*o*) Godbolt, 254.

grace and favour, in recompense of his costs and travail, may grant by charter unto him, that he only shall use such a trade or trafique for a certain time, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired, the King cannot make a new grant thereof; for when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it."

In the case of the *Tailors of Ipswich* v. *Sherring*, (*p*) it is said that "of a *new invention* the King can grant a patent," and that "where there is no new invention, the King cannot by his patent hinder any trade."

So in the case of *Mitchell* v. *Reynolds*, (*q*) it is laid down that a grant by patent of the sole use of a *new invented* art is good.

In Sheppard's Abridgment, (*r*) it is laid down that a monopoly patent may be granted "of that which any man at his own charge, wit, and invention, shall bring in as a *new* trade or device into the realm, or any *new* engine tending to the furtherance of it, for the good of the realm." In Bacon's Abridgment, (*s*) it is said that, "the King may grant to a person *the sole use of any art *first invented* by him." And the same law is laid down in Hawkins's Pleas of the Crown. (*t*) [*106]

The authorities which have been cited, show clearly that by the Common Law, and independent of the Statute of Monopolies, an invention is required to be new in order to be capable of being made the subject of a valid patent privilege.

The proviso in the 6th section of the Statute of Monopolies, (*u*) which saves the prerogative of the Crown to grant patents for inventions, declares that the previous provisions of the act (avoiding all monopolies whatsoever) shall not extend to letters patents and grants of privilege thereafter to be made of the sole working or making "of any manner of *new* manufacture within this realm," and "which others, *at the time of making such letters patent and grants*, shall not use."

We have seen also, (*x*) that every patent recites the material allegations in the patentee's petition for the patent, one of which is, that the invention is new, or that it has not been used in this country, and therefore the novelty of the invention is thus made an essential part of the consideration for the grant made by the patent.

Every patent for an invention also contains (*y*) a condition for avoiding it in case the invention is not new as to the public use and exercise of it.

The novelty of an art or invention is therefore required, both by the Common Law and the Statute of Monopolies, in order to make it the legal subject of a patent privilege; and the want of novelty in an invention granted by patent also renders the grant void, not only for want of consideration, but also by force of the condition upon which it is made.

But although an invention must be new at the time of the grant of the letters patent, (*z*) it is only requisite that it should be new *to the public*, on behalf of whom the grant of the sole use of an invention is made. And, consequently, unless the public has a knowledge of an invention, or the means of knowing

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(*p*) 1 Rol. R. 4, 5.
(*q*) 1 P. Wms. 183, 188.
(*r*) Part III. p. 61.
(*s*) Tit. Prerog. (F. 4.)
(*t*) Part I. c. 79, s. 6.
(*u*) 21 Ja. I. c. 3.
(*x*) *Ante*, Chap. IV. p. 41, 42.
(*y*) Vide *ante*, Chap. IV. p. 62.
(*z*) Galloway v. Bleaden, 1 Webs. R. 525; Cornish v. Keene, 1 Webs. R. 508; and the Statute of Monopolies expressly requires that an invention must be new at the time of the making of the patent in which is it comprised.

[*107] it, at the time a patent is granted for it, it has *sufficient novelty to make it the proper subject of a patent privilege.

The want of this requisite novelty in an art or invention may therefore be established in any way which shows that the public had *a knowledge of the invention, or the means of knowing it before the date of the patent.*

Public knowledge of an invention may be shown by the existence of some public record, or the publication of some work or paper before the date of the patent, containing a description of the invention,—or by some public use of the invention prior to the grant of the patent.

Therefore if it be shown that an invention comprised in a patent, was described in any published work or paper, or in any public record, before the date of the patent, the invention was not then new as to the public knowledge of it, and therefore the patent is void.

Thus in the case of the *King* v. *Arkwright*, (*a*) it appeared that a part of the alleged invention had been described in Emerson's book on mechanics, published long before the date of the patent, and it was held that it could not therefore be made the subject of a grant by patent.

And in the case of *Hill* v. *Thompson*, (*b*) it was held by the Court of Common Pleas, that a book printed and published prior to the grant of the patent, which in substance informed the public of what the specification of the patent professed to inform them, completely negatived the novelty of the alleged invention.

So in the case of *Huddart* v. *Grimshaw*, (*c*) Lord *Ellenborough*, C. J., said that if prior to the time of a patentee obtaining his patent, "any part of that which is of the substance of the invention has been communicated to the public in the shape of a specification of any other patent, or is a part of the service of the country, so as to be a known thing, in that case he cannot claim the benefit of his patent."

And in the case of *Cornish* v. *Keene*, (*d*) the defendants having put in evi-

[*108] dence the specification of former patent of *the plaintiff's, the Lord Chief Justice *Tindal* said, in his address to the jury, "Undoubtedly if you could show under the hand of the plaintiff, or any body's hand, that the secret had been publicly communicated to the world which was intended to be covered by the subsequent patent, there is an end to that patent; if the world at large had been informed by this specification of the fabric and manufacture, which is intended to be effected by the subsequent patent, the subsequent patent must fall to the ground, otherwise a man would have nothing to do but to take out patent after patent when the former has nearly expired, and so procure to himself an unlimited privilege."

The importation of a foreign book into this country, containing a description of an invention, would not be sufficient to defeat a subsequent patent for it, unless the work was actually published and sold to the public here prior to the date of the patent.

If however a single copy of a foreign work is deposited in the British Museum library, or in any other place to which the public can resort to obtain information, the public has the means of knowing the nature of any art or invention which the work describes, and therefore a subsequent patent for such an invention would be void for want of novelty. In *Baron Heurteloup's* case, (*e*) a portion of the invention had been described in a *French* work depo-

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(*a*) Dav. P. C. 129.
(*b*) 8 Taunt. 375; and 2 B. Moore, 448, S. C.
(*c*) Dav. P. C. 279.
(*d*) 1 Webs. R. 510.
(*e*) 1 Web. R. 553.

sited in the library of the *British* Museum before the date of the patent, and therefore the patentee applied to her Majesty in council for a confirmation of his patent, which was granted accordingly.

The *public* USE of an art or invention at any time before the date of the patent in which it is comprised, will also be sufficient to render the patent void. And a public use of an invention is sufficient to avoid a subsequent patent for it for three reasons: *firstly*, Because the public use of an invention is evidence of a public knowledge of it: *secondly*, Because the Statute of Monopolies (*f*) expressly requires that an invention granted by patent shall be such as others (than the inventor) at the time of making the patent or grant *do not *use;* and, *thirdly*, Because every patent expressly requires [*109] that the invention comprised in it shall be new as to the public use of it. (*g*)

Thus in *Tennant's* case, (*h*) the process invented by the patentee had been used five or six years before the date of the patent, and it was held that it was therefore not a new invention, and that the patent was void.

In the case of *Lewis* v. *Marling*, (*i*) it appeared that the patent, dated 15th January, 1818, was for an invention of an improved shearing machine, for shearing woollen cloths, by means of rotary cutters shearing from list to list. The defence was that the mode of shearing from list to list, by means of rotary cutters, was not new at the time of the plaintiff's patent; and it was proved that in the year 1811, a specification was enrolled in *America*, for a machine to shear cloth from list to list by means of rotary cutters, and that in that year a model of an exactly similar machine was brought to *England*, and exhibited to three or four persons. It was also proved that in the year 1811, Mr. Thompson, a manufacturer in *Yorkshire*, employed workmen to make a machine from the *American* specification, and that they had set about it, but that in consequence of the Luddite riots, Mr. Thompson was afraid to have it completed. However, in answer to this, it was shown that after the riots had ceased the machine was left unfinished, and Mr. Thompson bought the plaintiff's machine. Lord *Tenterden*, C. J., said to the jury, "To show that the machine was not new, evidence is given that a model has been seen by three or four persons, and that the making of a similar machine was begun; but it appears to me that the defendant has failed to prove that such a machine was *generally* known or *generally* used in *England*, before the taking out of this patent by the plaintiffs;" and there was a verdict for the plaintiffs.

This statement of the case of *Lewis* v. *Marling* is in accordance with the report of it contained in the fourth volume of the Reports of Messrs. Carrington and Payne. (*k*) But upon a subsequent motion in the Court of King's Bench *for a new trial in that case, (*l*) Lord *Tenterden*, C. J., said [*110] that he had left it to the jury to say whether the invention "had been in *public* use and operation before the granting of the patent;" and it does not appear that any objection was made to the charge of Lord *Tenterden* to the jury on the ground that the learned Judge used the expressions, "generally known," and "generally used," instead of "publicly known," and "publicly used." There can be no doubt, however, that it would be a mistake to say that an invention must be *generally* known or used in order to avoid a subsequent grant of it by patent, it is sufficient if it was *publicly* known or used before the date of the patent. (*m*)

(*f*) 21 Ja. I. c. 3, s. 6.
(*g*) Vide *ante*, Chap. IV. p. 62; and in this Chap. p. 106.
(*h*) Dav. P. C. 429.
(*i*) 4 C. & P. 52; 1 Webs. R. 490.
(*k*) P. 52.
(*l*) 10 B. & C. 22.
(*m*) Vide Carpenter v. Smith, *infra;* and 9 M. & W. 300.

Mr. Baron *Alderson*, upon the argument of one case, (*n*) said that "the case of *Lewis* v. *Marling* went to the extreme point of the law." And upon another occasion, (*o*) that in the case of *Lewis* v. *Marling*, he should have entertained very considerable doubts.

So in the case of *Cornish* v. *Keene* at Nisi Prius, (*p*) the Lord Chief Justice *Tindal* told the jury, that if the invention was, at the time the patent was granted, in any degree of general use,—if it was known at all to the world publicly, or practised openly, so that any other person might have the means of acquiring the knowledge of it as well as the patentee, then the patent would be void.

The recent case of *Carpenter* v. *Smith* shows most clearly the meaning of the expression "public use" when applied to an invention. That case was an action for the infringement of a patent for improvements in locks; and it was shown that a lock substantially the same as the plaintiff's had been put upon a gate in a public place, and used by Mr. Davies for many years before the date of the patent. Upon the trial of the case at Nisi Prius, (*q*) Lord *Abinger*, C. B., said that "public use" means this—that the use shall not be secret, but public; and that the use of the lock by Mr. Davies on his gate was [*111] a public use of it within the meaning of the clause in the *patent, which requires the invention to be new as to the public use and exercise of it.

His Lordship also said, "If a man invents a lock, and puts it on his own gate, and has used it for a dozen years, that is a public use of it. If it were otherwise, see what the consequence would be; Mr. Davies has a lock, which he has directed to be made, and put upon his gate, sixteen years ago at least; if that was not a public use of it which prevented a man from taking out a patent, any man might go and take a model of that lock, and get a patent for it." And the learned Judge also held, that "public use and exercise" does not mean a use or exercise by the public, but a use or exercise *in a public manner*, and that such a use of an invention by *one* person would be sufficient to avoid a subsequent patent for it.

The jury in this case having found a verdict for the defendant, the plaintiff moved for a new trial on the ground of misdirection by the Lord Chief Baron to the jury, but the Court of Exchequer refused to grant even a rule *nisi*. (*r*) Mr. Baron *Alderson* said, in giving judgment in this case, "Public use means a use in public, so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in his chamber. How then can it be contended that the lock which has been used in public by Mr. Davies for so many years is a new invention? If the plaintiff's doctrine is correct, it would follow that if Mr. Davies were to change his lock to another gate, he would be liable to an action for an infringement of the plaintiff's patent." And Lord *Abinger* again said, that "the public use and exercise of an invention means a use and exercise *in* public, not by the public."

The law thus laid down in the case of *Carpenter* v. *Smith*, shows accurately the extent of the prior use or exercise of an invention required by law, and the proviso in a patent, in order to avoid a subsequent grant of it. Mr. Davies must have employed a workman to make the lock, and the subsequent successful use of it in public shows that the invention was not intended to be kept secret. It does not appear from the report of the case that the construction of

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(*n*) In Carpenter v. Smith, 1 Webs. R. 543.
(*o*) In Morgan v. Seaward, 1 Webs. R. 190; 2 M. & W. 553.
(*p*) 1 Webs. R. 508. (*q*) 1 Webs. R. 534.
(*r*) 9 M. & W. 300.

the lock could be *discovered by the inspection of it upon the gate, but the person who made it had publicly used the art by which the [*112] lock was made before the date of the patent, and therefore the art was not one which came within the meaning of the law, so as to be capable of being granted by letters patent.

In the case of *Jones* v. *Pearce*, (*s*) it appeared that the plaintiff's patent was granted for an invention of improvements on carriage wheels. It was proved at the trial that two pair of wheels made upon the same principle as the plaintiff's invention, and nearly resembling the plaintiff's wheels, had been publicly used by Mr. Strutt before the date of the patent. Mr. Justice *Patteson* held, that if Mr. Strutt's wheels were on the same principles, and in substance the same as the plaintiff's, and used openly in public so that every body might see them, and were continued to be used up to the time of taking out the patent, then the invention was not new, and the patent was void. The jury in this case gave a verdict for the plaintiff; and it has been generally supposed that the case is one which lays down the law respecting the degree of prior use or knowledge which is sufficient to vitiate a patent, in a way very favourable for patentees. This supposition seems however to be destitute of foundation, for it appears from the charge of the learned Judge that the verdict of the jury must have been given upon the ground that Mr. Strutt's wheels were an experiment only, that he had found it did not answer, and had abandoned it as useless. And Lord *Abinger*, C. B., in the case of *Carpenter* v. *Smith*, (*t*) said that he had been counsel in the cases of *Lewis* v. *Marling* (*u*) and *Jones* v. *Pearce*, and he recollected that "those cases proceeded on the ground of the former machines being in truth *mere experiments which altogether failed.*"

We have seen that the subject of every privilege in an invention granted by patent, is an art by which vendible articles may be manufactured. (*x*) And when we say that an invention granted by patent must be new, the meaning is, that *the subject* of the privilege or *the art* must be new at the date of the patent. Therefore if such an art has once become publicly known, or been publicly used, in any way or for any purpose *whatsoever, it cannot afterwards be made the subject of a privilege, even for any new appli- [*113] cation of it.

It has already been shown that a patent privilege cannot be sustained for a new or double use of an old art or invention. (*y*) And if the cases which bear upon this subject be examined, it will be seen that the true reason is, that the art which alone can be made the subject of the patent privilege is not new, but only the use or application of it.

And it is necessary, in considering this subject in every case, carefully to distinguish between an art such as we have just defined, and which may be made the subject of a patent privilege, and the various uses and applications of which such an art is capable.

If the law permitted a new use or application of a known art or invention to be made the subject of such a privilege, the patent might operate very seriously to the disadvantage of a prior patentee. For however accurately he may have described his new art or invention, if he has not pointed out all its uses or applications, he may be deprived of part of the profit to be made by his invention, by reason of some particular use of it being appropriated by a subsequent patentee.

A public sale of an article made according to an art or invention will also invalidate a subsequent patent, granting the sole use of such art or invention.

(*s*) 1 Webs. R. 122.
(*t*) 9 M. & W. 300.
(*u*) 4 C. & P. 52.
(*x*) Vide *ante*, Sec. 1, in this Chapter.
(*y*) See Kay v. Marshall, and the other cases, cited *ante*, p. 94 to p. 99.

Such a public sale seems to be substantially the same as a prior public use or exercise of the invention, and if once a person has commenced the use of an art or invention, and made a profit of it by public sale, it would be unjust to deprive him of the benefit which he is reaping from such an application of his labour or capital. (*z*)

In the case of *Wood* v. *Zimmer*, (*a*) it appeared that the patent was for a new mode of making verdigrease, to be called *British* Imperial Verdigrease. It appeared also that the patentees had sold an article, composed precisely in the same manner as that for which the patent had been obtained, under the name of *Dutch* Imperial Green. Lord Chief Justice *Gibbs* said to the jury, with reference to the question of novelty, "Some things are obvious as soon as they are made public. Of others, the scientific world may possess itself by analysis. *Some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be new to the world. The public sale of that which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void. It is in evidence that a great quantity was sold in the course of four months before the patent was obtained; and that the bankrupts were in the habit of selling this manufacture." And his Lordship left the question to the jury to say whether the invention was in public sale before the patent, in which case his Lordship thought the patent void, and the jury found the question in the affirmative, and consequently there was a verdict for the defendant. This case was cited and approved of in the case of *Morgan* v. *Seaward*, (*b*) in which Mr. Baron *Parke* said, in delivering the judgment of the Court of Exchequer, that "If the patentee himself had before his patent constructed machines (made according to the invention) for sale as an article of commerce for gain to himself, and been in the practice of selling them publicly; that this, to any one of the public who would buy, the invention would not be new at the date of the patent. This was laid down in the case of *Wood* v. *Zimmer*, (*c*) and appears to be founded in reason; for if the inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another take out a patent, he might have practically a monopoly for a much longer period than fourteen years."

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In the case of *Losh* v. *Hague*, (*d*) Lord *Abinger*, C. B., held that a sale to any one individual would be sufficient to avoid a subsequent patent.

The same learned Judge held, in *Carpenter* v. *Smith*, (*e*) that one instance of a public sale for profit, of articles made according to an invention, is such a public use and exercise of the invention as will invalidate a subsequent patent for it. And in the case of *Morgan* v. *Seaward*, (*b*) although the Court of Exchequer decided that the transaction proved in that case was not such a sale as would defeat a patent, yet expressly guarded themselves against being understood as deciding that a single instance of a sale of an article, as an *article of commerce to any one who chose to buy, might not be deemed the commencement of such a practice, and the public use of the invention so as to defeat a subsequent patent for it.

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And whether articles made according to an invention comprised in a patent, and sold before the date of it, were sold for home or foreign consumption, is of no importance if the sale be public, in this country.

Thus, in the case of *Carpenter* v. *Smith*, (*g*) Lord *Abinger*, C. B., held that a sale of locks made according to the plaintiff's invention before the date

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(*z*) Vide *ante*, p. 34, 35.
(*a*) Holt. N. P. C. 58.
(*b*) 2 M. & W. 544.
(*c*) Holt. N. P. C. 58.
(*d*) 1 Webs. R. 202.
(*e*) Ibid. and 530.
(*g*) 9 M. & W. 300.

of his patent for the purpose of being sent to *America*, would be a destruction of the novelty of his invention. And in the case of *Morgan* v. *Seaward*, (*h*) the Court of Exchequer, after approving of the law laid down in *Wood* v. *Zimmer*, (*i*) that a public sale of an article by an inventor will defeat a subsequent patent for it, said that they were not prepared to say that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference.

And not only must the art or invention granted by a patent be new; but if it consist of several parts, every part of the invention must be new. And it is clear that the reasons already given for the grant of a known art being void, apply as strongly to any part of an invention granted by patent as to the whole of it.

And the want of novelty in any part of an art or invention not only invalidates the grant of it by patent as to the part of it which is not new, but renders the grant entirely void even as to those parts of the invention which may be new, and in every respect the legal subject of a grant by patent. The reason for this is, that the consideration for a grant by patent is what is termed in law entire, and if any part of it fail, the consideration is not sufficient to support the grant, and therefore the patent is wholly void. So also the patent is void in such a case on the ground of a false suggestion or representation appearing on the face of the patent, for the patentee, in his petition for the patent, must have represented his invention to be new; and as the petition is always recited in the patent, it appears that the representation respecting the *novelty of the invention is not true, part of the invention being old, and the consequence of the Crown having been deceived in this respect is that the whole grant is void. (*k*) [*116]

Thus, in the case of *Hill* v. *Thompson*, (*l*) it was held by the Court of Common Pleas that if any part of the alleged discovery, being a material part, failed, (the discovery in its entirety forming one entire consideration,) the patent was altogether void.

In the case of *Huddart* v. *Grimshaw*, (*m*) Lord *Ellenborough*, C. J., said to the jury, that if, prior to the time of the plaintiff obtaining his patent, *any part* of that which was of the substance of the invention had been communicated to the public, he could not support his patent.

So in the cases of *The King* v. *Else*, (*n*) and *Bovill* v. *Moore*, (*o*) the patents were held to be void on the ground of the patentees' claims being too extensive, and comprising things which were not new.

In the case of *Gibson* v. *Brand*, (*p*) it appeared that the patentees claimed eight several heads of invention, and the Court of Common Pleas held that in order to support their patent they were bound to show that each of the eight parts was new.

In the case of *Brunton* v. *Hawkes*, (*q*) it appeared at the trial that the patent was for an invention of improvements in the manufacturing of ships' anchors, windlasses, and chain cables. The mode of manufacturing anchors described in the plaintiff's specification had never been applied before to ships' anchors. But it had been applied to the adze-anchor, and the mushroom-anchor. These anchors are used only for the purpose of mooring floating lights or vessels intended to be stationary; and are never taken on board. The jury having found a verdict for the plaintiff, the defendant obtained a rule *nisi* for a new

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(*h*) 2 M. & W. 544.
(*i*) Vide *ante*, p. 113, 114.
(*k*) Vide *ante*, Chap. IV. p. 42 and 48.
(*l*) 8 Taunt. 375; and 2 B. Mo. 448, S. C.
(*m*) Dav. P. C. 265.
(*n*) Ibid. 144.
(*o*) Ibid. 361; and 2 Marsh. 211, S. C.
(*p*) 4 M. & G. 179.
(*q*) 4 B. & Ald. 541.

trial, which the Court afterwards made absolute. In his judgment the Lord Chief Justice *Abbott* said, "I feel myself compelled to say that I think so much of the plaintiff's invention, as respects the anchor, is not new, and [*117] *that the whole patent is therefore void. The mode of joining the shank to the flukes of the anchor is to put the end of the shank, which is in the form of a solid cylinder, through the hollow and conical aperture, and it is then made to fill up the hollow, and to unite itself with it. Now that is precisely the mode by which the shank of the mushroom-anchor is united to the mushroom-top, by which the shank of the adze-anchor is united to its other parts. It is indeed the mode by which the different parts of the common hammer and the pickaxe also are united together. Now a patent for a machine, each part of which was in use before, but in which the combination of the different parts is new, and a new result produced, is good; because there is a novelty in the combination. But here the case is perfectly different; formerly three pieces were united together; the plaintiff only unites two; and, *if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent;* but unfortunately the mode was well known and long pactised. I think that a man cannot be entitled to a patent for uniting two things instead of three, *where that union is effected in a mode well known and long practised for a similar purpose.* It seems to me therefore that there is no novelty in that part of the patent as affects the anchor, and if the patent had been taken out for that alone, I should have had no hesitation in declaring that it was bad. Then if there be no novelty in that part of the patent, can the plaintiff sustain his patent for the other part as to the mooring chain? As at present advised, I am inclined to think that the combination of a link of this particular form with the stay of the form which he uses, although the form of the link might have been known before, is so far new and beneficial as to sustain a patent for that part of the invention, if the patent had been taken out for that alone. But inasmuch as one of the things is not new, the question arises, whether any part can be sustained. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The King could not, in consideration of a new invention in one article, grant a patent for that article and another. The question then is, whether, if a party applies for [*118] a patent, reciting that he has *discovered improvements in three things, and obtains a patent for these three things, and in the result it turns out that there is no novelty in one of them, he can sustain his patent. It appears to me that the case of *Hill* v. *Thompson*, which underwent great consideration in the Common Pleas, is decisive upon that question. In that case the patent was granted to the plaintiff for the invention of certain improvements in the smelting and working of iron; and the Court of Common Pleas appear to have considered that the improvement introduced by the plaintiff into what may properly be called the smelting of iron, was the obtaining iron from that cinder and slag which before had been thrown away as refuse, and that that might be considered as new. It appeared, however, that the plaintiff claimed further the merit of having discovered that the application of lime in certain stages of the process would cure a disease common to all iron, not merely to that which he was to produce, but to iron originally manufactured from the fresh ore. Now it turned out that that was not a discovery, for the application of lime to iron made from the cinder, originally used in making ore, was known and practised before. No two things can be more distinct in their nature than the obtaining of iron from a material from which it was impracticable to obtain it before, and the cure or prevention of a disease to which all iron was subjected. In that case, however, the Court of Common Pleas held, that admitting there was novelty in the one, yet, as there was no novelty in the

other, the patent was wholly void. The only difference between that case and this is, that here the plaintiff, instead of saying that he has made certain improvements, states the improvements; but still he claims the merit of having invented improvements in all the three, and that they are new; and the consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The consideration is the entirety of the improvement of the three; and if it turns out there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention."

The ground upon which the partial want of novelty in an *invention avoids the whole grant contained in the patent was also [*119] clearly explained in the case of *Morgan* v. *Seaward*, (*s*) in which Mr. Baron *Parke* said, in delivering the judgment of the Court, that "A false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown, is a maxim of the Common Law, and such a grant is void, not against the Crown merely, but in a suit against a third person. (*t*) It is upon the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill* v. *Thompson*, (*u*) and *Brunton* v. *Hawkes;* (*x*) for although the statute invalidates a patent for want of novelty, and consequently, by force of the statute, the patent would be void, so far as related to that which was old, yet the principles on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it."

The specification is to be deemed a part of the patent, and the two instruments are to be construed together as one; and if it appears by the patent, or specification, that any thing is claimed by the patentee as part of his invention which is not new, the grant of privilege will be wholly void.

In the case of *Campion* v. *Benyon*, (*y*) it appeared that the patent was for an invention intituled "a new and improved method of making and manufacturing double canvas and sail cloth with hemp and flax, or either of them *without any starch whatever.*" It appeared at the trial that the plaintiff's invention was substantially only a new mode of preparing and twisting hemp or flax for making canvas and sail cloth, and that the manufacturing of canvas and sail cloth had been known and used long before the date of the patent. The Court of Common Pleas held that this patent was void on the ground, that part of what the plaintiff had claimed as his invention was not new, and that the patent was therefore too extensive. The Lord Chief Justice *Dallas* said, "That looking at the description of the invention contained in the patent, a *common person would think, not simply that it was an improvement in the method of making double canvas and sail cloth without [*120] starch, pre-supposing that starch had been known before, but that it was an improvement for making them without any starch whatever. From the moment I read the patent, I thought the object of the patentee was to make such canvas or cloth without any starch, and that the exclusion of that article was a new discovery, and adopted by him for the first time; nor do I now see any reason to think otherwise." And after commenting upon the specification, his Lordship said, "As well therefore on the terms of the specification, as of the

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(*s*) 2 M. & W. 544.
(*t*) Travell v. Carteret, 3 Lev. 135; Alcock v. Cooke, 5 Bing. 340.
(*u*) 2 Moore, 424; 8 Taunt. 375, S. C. (*x*) 4 B. & Ald. 542.
(*y*) 6 B. Mo. 71; 3 B. & B. 5, S. C.

patent itself, I have no doubt but that the claim of the plaintiff is of too extensive a nature; it is not confined to a new and improved method of making and manufacturing the canvas and sail cloth, either in the weaving or twisting the threads, but of manufacturing them without any starch whatever, which it appears had been done before, and was therefore not a new or original discovery. On this ground, therefore, I am clearly of opinion that the patent in question is void." Mr. Justice *Burrough* said, "The King has, in fact, been deceived in granting the patent to the plaintiff, as he has claimed what was known before, and is consequently not entitled to the discovery or invention he thereby sought to establish." And Mr. Justice *Richardson* said, "The true and sound principle is, that although on the one hand ingenious persons ought to be protected and rewarded for their discoveries, still on the other, care must be taken that others, as well as the public at large, must not be restricted from making improvements on that which is still open to their ingenuity, viz: of doing anything which is not peculiar to the immediate process employed by the patentee. Here the patent itself appears to consist of an improvement in making double canvas and sail cloth without starch. The specification confirms it, by referring to the advantages to be derived from the omission of that article in the manufacture of those cloths. That discovery appears to have been made long since, and therefore the patent cannot be sustained."

Although every thing which is claimed by a patentee as part of his invention, and which he therefore seeks to make the subject of his patent privilege, must [*121] be new at the date of the *patent; that rule has not the effect of avoiding a patent privilege for an art or invention which is an improvement upon, or addition to, some previously known art or invention, or which is only a combination of arts or processes already known to the public.

But the patentee's claim of invention must be confined to the improvement or addition, and the patentee's claim must not extend to any part of the previously known art or invention, or the entire privilege will be rendered void under the rule of law which has just been considered, in consequence of a part of the alleged invention not being new at the date of the patent. (*z*) Or if the invention be of a combination of arts before known, or if the object of the invention be the combination of things previously known to the world, the patent must be limited to the particular combination which the patentee has invented, and must not include any of the elements of the art or invention, or the patent will be entirely void for the reason just given.

The reason why a patent is good in such a case is, that the art which is comprised in the privilege is quite distinct from that upon which it is an improvement, or from those of which it is a combination. And if an art of this description is sought to be made the subject of a patent privilege, the patent cannot be sustained unless the art be really a distinct substantial art, and different from the previously known art or arts of which the patentee has availed himself.

It was formerly doubted whether a patent privilege for an addition or improvement was good, but the validity of such a privilege is now unquestionable.

Sir Edward Coke, in his commentary on the Statute of Monopolies, (*a*) says, that "Such a privilege as is consonant to law must be substantially and essentially newly invented; but if the substance was *in esse* before, and a new addition thereunto, though that addition make the former more profitable, yet it is not a new manufacture in law: and so it was resolved in the Exchequer Cham-

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(*z*) See Hill v. Thompson, 8 Taunt. 375; 2 B. Mo. 448; Bovill v. Moore, 2 Marsh. 211; Dav. P. C. 361; Minter v. Mower, 1 Webs. R. 142; and the other cases which have been cited.

(*a*) 3 Inst. 184.

ber, *Pasch.* 15 Eliz. in *Bircot's* case, for a privilege concerning the preparing and melting, &c. of lead of ore: *for there it was said, that that was to put but a new button on an old coat, and it is much easier to add than to invent." [*122] We are left in ignorance as to the precise nature of the addition in *Bircot's* case, and therefore it may have been such an addition as would not even now be held sufficient to support a grant by patent.

In the case of *Boulton* v. *Bull*, (*b*) the Lord Chief Justice *Eyre* mentioned *Bircot's* case, and said that the principle on which it was determined had not been adhered to.

And in the same case, (*c*) Mr. Justice *Buller*, speaking of *Bircot's* case, says, "What were the particular facts of that case we are not informed; and there seems to me to be more quaintness than solidity in the reason assigned, which is, that it was to put a new button to an old coat, and it is much easier to add than to invent. If the button were new, I do not feel the weight of the objection that the coat on which the button was to be put was old. But in truth arts and sciences at that period were at so low an ebb in comparison with the point to which they have been since advanced, and the effect and utility of improvements so little known, that I do not think that case ought to preclude the question. In later times whenever the point has arisen, the inclination of the Court has been in favour of the patent for the improvement, and the parties have acquiesced where the objection might have been brought directly before the Court."

In the case of *The King* v. *Arkwright*, (*d*) Mr. Justice *Buller* said, that if there was any thing material and new *which was an improvement* of the trade, that would be sufficient to support a patent.

In the case of *Hornblower* v. *Bull*, (*e*) Mr. Justice *Laurence* said, that the patent must be supported as granted for an improvement and addition to old engines known and in use, and that he thought the patent was good in that point of view.

And in the case of *Morris* v. *Bransom*, (*f*) tried in Hilary vacation, 1776, "The question was, whether an addition to an old stocking-frame was a subject of a patent: Lord *Mansfield* *said, if the general question of law, viz: that there can be no patent for an addition, be with the defendant that is open upon the record, he may move in arrest of judgment, but that objection would go to repeal almost every patent that was ever granted. There was a verdict for the plaintiff, and 500*l.* damages, which was acquiesced in." [*123]

This case seems to have been subsequently tried again, for in the case of *Boulton* v. *Bull*, (*g*) Mr. Justice *Buller* said, in giving judgment, that in *Morris* v. *Bransom*, which was tried at the sittings after Easter Term, 1776, the patent was for making oilet holes or net-work in silk, thread, cotton, or worsted; and the defendant objected that it was not a new invention, it being only an addition to the old stocking-frame. That, Lord *Mansfield* said, after one of the former trials on this patent, he had received a very sensible letter from one of the gentlemen who was upon the jury, upon the subject, whether on principles of public policy there could be a patent for an addition only. That he paid great attention to it, and mentioned it to all the Judges, and said that if there could be no patent for an addition, the point was open upon the record, and the defendant might move in arrest of judgment. And it appears that there was a verdict for the plaintiff, but no motion was made in arrest of judgment. And

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(*b*) Dav. P. C. 205; 2 H. Bl. 463, S. C.
(*c*) Dav. P. C. 201; 2 H. Bl. 463, S. C.
(*d*) Dav. P. C. 61.
(*e*) 8 T. R. 98; Dav. P. C. 221.
(*f*) Bull. N. P. 76, c.
(*g*) Dav. P. C. 202; 2 H. Bl. 463, S. C.

Mr. Justice *Buller* also said, that though his Lordship (Lord *Mansfield*) did not mention what were the opinions of the Judges, or give any direct opinion himself, yet we may safely collect that he thought, on great consideration, the patent was good, and the defendant's counsel, though they made the objection at the trial, did not afterwards persist in it. And (added Mr. Justice *Buller*) since that time it has been the generally received opinion in Westminster Hall, that a patent for an addition is good.

For some years past, very many of the patents which have been taken out have been for inventions intituled as improvements in things previously known; and there can be no question now that such a patent is good, (*h*) even when it is for an improvement upon something comprised in a prior patent; (*i*) [*124] *but the second patent must wait until the expiration of the previous patent, until which time the patentee cannot use the prior invention, unless indeed he obtains the license of the prior patentee.

It is to be observed, that a patent privilege is not obtained merely for an improvement or improved art, in every case in which the word improvement is used in the title of the invention. Thus, an invention may be intituled "improvements in the manufacture of lace," the object of the invention being either the production of lace of a better quality, or at a lower price; and yet the means by which that object is obtained may be some new art or some new machine totally and entirely different from anything before known or used for the manufacture of lace.

It will be seen from the cases now to be cited, that it is equally clear that a patent privilege is good for an art or invention which is a combination of several known arts or inventions, or which has for its object the combination of several previously known articles or materials.

In the case of *Hill* v. *Thompson*, (*k*) Lord *Eldon*, L. C., said, that there might be a valid patent for a new combination of materials previously in use for the same purpose.

In the case of *Boulton* v. *Bull*, (*l*) Mr. Justice *Buller* said, that it is no objection to a manufacture that the articles of which it is composed were known and in use before the patent, provided the compound article which is the object of the invention is new.

In the case of *Boville* v. *Moore*, (*m*) Lord Chief Justice *Gibbs* told the jury, that if the plaintiff had invented an engine which consisted of a perfectly new conformation of parts, although all the parts were used before, yet he would be entitled to support his patent for a new machine.

So in the case of *Huddart* v. *Grimshaw*, (*n*) Lord *Ellenborough*, C. J., said, "I suppose it will not now be disputed that a new combination of old materials so as to produce a new effect may be the subject of a patent." And his Lordship *afterwards said to the jury in the same case, (*o*) "In [*125] inventions of this sort, and every other through the medium of mechanism, there are some materials which are common, and cannot be supposed to be appropriated in the terms of any patent. There are common elementary materials to work with in machinery, but it is the adoption of those materials to the execution of any particular purpose that constitutes the invention; and if the application of them be new, if the combination in its nature be essentially new, if it be productive of any new end, and beneficial to the public,

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(*h*) See Hill v. Thompson, 8 Taunt. 375; 2 B. Mo. 448.
(*i*) *Ex parte* Fox, 1 V. & B. 67; Crane v. Price, 4 M. & G. 580.
(*k*) 3 Mer. 622.
(*l*) Dav. P. C. 199; 2 H. Bl. 487.
(*m*) Dav. P. C. 361.
(*n*) Ibid. 267.
(*o*) Dav. P. C. 278.

it is that species of invention which, protected by the King's patent, ought to continue to the patentee the sole right of vending it."

In the case of *Cornish* v. *Keene*, (*p*) the invention was of a new elastic web, made by combining non-elastic and covered elastic threads in the warp of the web, which was woven in the common way, and in the common loom. Before the date of the patent the manufacture of webs with all the warp threads elastic was well known, and there was nothing new in the invention except the particular combination of elastic and non-elastic materials in the warp of the web. This combination the Court of Common Pleas held was an invention which might be protected by patent.

In *Crane* v. *Price*, (*q*) it appeared that Crane's patent was for an invention of "an improvement in the manufacture of iron," and the improvement consisted in combining the use of hot air blast with the use of anthracite or stone coal in the smelting of iron. Both hot air blast and anthracite coal had been used in the smelting of iron before the date of the patent, and the patentee claimed the mere combination of the two things, and distinctly disclaimed each of them separately as being well known. The Court of Common Pleas held that the new combination of processes was clearly a good subject of a grant by patent.

There may also be a valid patent for an invention, where every thing used by the patentee is old and well known, and the novelty consists merely in dispensing with one of several things which was before used in any branch of manufacture.

*Thus, in *Russell* v. *Cowley*, (*r*) which was an action for the infringement of a patent granted to Whitehouse for improvements [*126] in the manufacture of tubes, it appeared that before the date of Whitehouse's patent, iron pipes had been made by turning up the edges of strips of iron plate so as to make them meet, and then by passing them in a heated state *upon a maundril*, through a circular hole between a pair of dies, to cause the edges of the strips of iron to be welded together, and so to form a tube. The invention comprised in Whitehouse's patent was to manufacture iron tubes in the same manner in every respect as already described, except that the use of a maundril was dispensed with, Mr. Whitehouse having discovered that the edges of the iron could be welded together as well without the maundril as with it, and that by dispensing with the maundril, tubes could be made much longer than with it. The Court of Exchequer held that this new invention might lawfully be made the subject of a grant by patent.

And in the case of *Minter* v. *Mower*, (*s*) the Court of Queen's Bench intimated an opinion that a patent would not be bad merely because the invention consisted in the omission of one of the several component parts of something previously known.

It has been seen that the novelty which the law requires in order to make an art or invention the legal subject of a patent privilege, is novelty to the public; that the public must neither have a knowledge of the art, or possess the means of knowing it. But an art or invention may be new to the public notwithstanding any secret knowledge or use of it prior to the grant of a patent for it, and such a secret knowledge or use of the invention will not affect the validity of the patent.

Thus, in *Dolland's* case, (*t*) the invention was of a new method of making object-glasses, and it was objected that Dolland was not the (first) inventor,

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(*p*) 3 Bing. N. C. 570; 1 Webs. 517.
(*q*) 1 Webs. R. 393; 4 M. & G. 580.
(*r*) 1 Webs. R. 463.
(*s*) Ibid. 142; and 6 A. & E. 735.
(*t*) Dav. P. C. 170.

because Dr. Hall had made the same discovery before him. But it was held that as Dr. Hall had confined his invention to his closet, and the public were not acquainted with it, Dolland was entitled to maintain his patent.

[*127] So in the case of *Lewis* v. *Marling*, (*u*) Mr. Justice *Bayley* *said, that it was no objection to an inventor's patent that any one else had made a similar discovery by his mind, or had received privately a communication from abroad, which would enable him to make it, unless it had been actually made public.

So also if the knowledge of an invention be disclosed by the inventor privately and confidentially to another, such a disclosure will not avoid a subsequent patent: and even if the invention is in consequence of such communication secretly used in the production of an article which is not sold to the public, or published to the world, the patent will not be void.

This was laid down by the Court of Exchequer in the case of *Morgan* v. *Seaward*, (*x*) which was an action for the infringement of a patent granted to Mr. Galloway and assigned to Morgan the plaintiff: the jury, by direction of the Judge, gave a verdict for the defendant, upon a plea denying the novelty of the invention, with liberty for the plaintiff to move the Court (which he did) to have the verdict entered for him on that issue. The facts of the case are fully stated in the judgment of the Court, which was delivered by Mr. Baron *Parke*, who said, "The evidence was, that before the date of the patent, (which was 2nd of July, 1829) Curtis, an engineer, made for Morgan (the plaintiff) two pair of wheels upon the principle mentioned in the patent at his own factory. Galloway, the patentee, gave the instructions to Curtis, under an injunction of secrecy, because he was about to take out a patent. The wheels were completed and put together at Curtis's factory, but not shown or exposed to the view of those who might happen to come there. After remaining a short time, the wheels were taken to pieces, packed up in cases, and shipped in the month of April on board a vessel in the Thames, and sent for the use of the Venice and Trieste Company, of which Morgan was managing director, and which carried on its transactions abroad, but had shareholders in England. Curtis deposed that 'they were sold to the Company,' without saying by whom, which may mean that they were sold by Curtis to Morgan for the Company; and Morgan paid Curtis for them. Morgan and Galloway

[*128] employed an attorney, who entered a *caveat* against any patent *on the 2nd of March, and afterwards solicited the patent in question, which was granted to Galloway and assigned to Morgan. Upon these facts, the question for us to decide is, whether the jury must have necessarily found for the defendant, or whether they might have found that this invention at the date of the letters patent was new in the legal sense of that word. The words of the statute are, that 'grants are to be good of the sole working or making of any manner of new manufacture to the first and true inventor or inventors of such manufactures, which others at the time of the making such grants did not use;' and the proviso in the patent in question founded on the statute is, that if the invention be not a new invention as to the public use and exercise thereof in England, the patent should be void. The word 'manufacture' in the statute must be construed in one of two ways: it may mean the machine when completed, or the mode of constructing the machine. If it mean the former, undoubtedly there has been no use of the machine, as a machine, in England, either by the patentee himself, or any other person; nor indeed any use of the machine in a foreign country before the date of the patent. If the term 'manufacture' be construed to be 'the mode of constructing the machine,' there has

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(*u*) 1 Webs. R. 496; 10 B. & C. 22. (*x*) 2 M & W. 544.

been no use or exercise of it in England, in any sense which can be called 'public.' The wheels were constructed under the direction of the inventor, by an engineer and his servants, with an injunction of secrecy, on the express ground that the inventor was about to take out a patent, and that injunction was observed, and this makes the case so far the same, as if they had been constructed by the inventor's own hands in his own private workshop, and no third person had seen them whilst in progress. The operation was disclosed, indeed, to Morgan, the plaintiff, but there is sufficient evidence that Morgan at that time was connected with the inventor, and designing to take a share of the patent. A disclosure of the nature of the invention to such a person, under such circumstances, must surely be deemed private and confidential. The only remaining circumstance is, that Morgan paid for the machines with the privity of Galloway, on behalf of the Venice and Trieste Steam Company, of which he was the managing director; but there was no proof that he paid *more than the price of the machines, as for ordinary work of that description; and the jury would also be well warranted in finding that he did so with the intention that the machine should be used abroad only by this Company, which, as it carried on its transactions in a foreign country, may be considered as a foreign Company; and the question is, whether this solitary transaction without any gain being proved to be derived thereby to the patentee or to the plaintiff, be a use or exercise in England of the mode of construction in any sense which can be deemed a use by others, or a public use, within the meaning of the statute and the patent? We think not. It must be admitted that if the patentee himself had before his patent constructed machines for sale, as an article of commerce, for gain to himself, and been in the practice of selling them publicly, that is, to any one of the public who would buy, the invention would not be new at the date of the patent. This was laid down in the case of *Wood* v. *Zimmer*, (*y*) and appears to be founded on reason; for if the inventor could sell his invention, keeping the secret to himself, and, when it was likely to be discovered by another, take out a patent, he might have, practically, a monopoly for a much longer period than fourteen years. Nor are we prepared to say, that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference: nor that a single instance of such a sale, as an article of commerce, to any one who chose to buy, might not be deemed the commencement of such a practice, and the public use of the invention so as to defeat the patent. But we do not think that the patent is vacated on the ground of the want of novelty, and the previous public use or exercise of it, by a single instance of a transaction such as this, between parties connected as Galloway and the plaintiff are, which is not like the case of a sale to any individual of the public who might wish to buy; in which it does not appear that the patentee has sold the article, or is to derive any profit from the construction of his machine, nor that Morgan himself is; and in which the pecuniary payment may be referred merely to an ordinary compensation for the labour and skill of the engineer *actually employed in constructing the machine; and the transaction might, upon the evidence, be no more in effect than that Galloway's own servants had made the wheels, that Morgan had paid them for their labour, and afterwards sent them to be used by his own co-partners abroad. To hold this to be what is usually called a publication of the invention in England, would be to defeat a patent by much slighter circumstances than have yet been permitted to have that effect. We therefore think, that as the jury might consistently with the evidence have found this issue (*z*) for the plaintiff, the verdict ought, pursuant to the leave reserved, to be entered on that issue for him."

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(*y*) Holt, N. P. C. 58, cited *ante*, p. 113. (*z*) Respecting the novelty of the invention.

So also in the case of *Bentley* v. *Fleming*, (*a*) it appeared at the trial that the patent was for a card machine, and the patentee had before the patent lent the machine to a person in order that he might try it. The machine was placed in a room in a mill, in which men were constantly going backwards and forwards; but Mr. Justice *Cresswell* held, that the machine having merely been lent for the purpose of testing it, this did not amount to a publication.

Experiments made prior to the date of a patent, will not be any reason for objecting to a subsequent patent on the ground of want of novelty, unless the experiments were actually successful, as well as brought into public knowledge or use before the date of the patent. And the reason of this is very evident; for until the invention of an art is actually completed, a knowledge of it *cannot* be published to the world so as to defeat a patent for it.

In the case of *Galloway* v. *Bleaden*, (*b*) the Lord Chief Justice *Tindal*, in his charge to the jury, laid it down as law, that a mere experiment, or course of experiments, for the purpose of producing a result which is *not brought to completion*, but begins and *ends in experiment*, will not, although known to several persons, prevent a subsequent inventor who brings the invention to perfection from maintaining a patent for it. And in that case the learned Judge observed, that there had been many experiments made, tending almost, if not
[*131] entirely, to the same result as the patentee's invention, and that those *experiments were known to various persons; but his Lordship held that, if they rested in experiment, and in experiment only, and had not attained the object for which the patent was taken out, the patent would not be invalidated for want of novelty in the invention. And his Lordship also held, that mere experiment supposed by the parties to be fruitless and abandoned, because they had not brought it to a complete result, would not prevent a more successful competitor, who might add the last link of improvements in bringing it to perfection, from maintaining a patent for the invention.

So in the case of *Cornish* v. *Keene*, (*c*) the Lord Chief Justice *Tindal* said, "A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments, and never communicates them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent and protect himself in the privilege of the sole making of the article for fourteen years, and it will be no answer to him to say that another person before him made the same experiments."

In the case of *Jones* v. *Pearce*, (*d*) which was an action for the infringement of a patent for an invention of improvements in carriage wheels, it was proved that Mr. Strutt had made and used wheels similar to the plaintiff's before the date of the patent. And Mr. Justice *Patteson* told the jury, that if they were of opinion that Mr. Strutt's wheel was an experiment, and that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and the plaintiff's invention which came afterwards was his own invention, and remedied the defects in Mr. Strutt's wheel, there was no reason for saying that the plaintiff's patent was not good.

And in *Carpenter* v. *Smith*, (*e*) Lord *Abinger*, C. B., laid it down as law, that if an invention is new, the inventor shall not be prejudiced by any other man having invented it before, if he never made any use of it; because the
[*132] mere speculations of ingenious men which may be fruitful of a great variety of *inventions, if they are not brought into actual use, ought

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(*a*) 1 Car. & Kirwin, 587.
(*b*) 1 Webs. R. 529.
(*c*) 1 Webs. R. 501.
(*d*) Ibid. 122.
(*e*) Ibid. 534.

not to stand in the way of other men equally ingenious, who may afterwards make the same inventions and apply them. A great many patents (said his Lordship) have been taken out, for example, upon suggestions made in a very celebrated work by the Marquis of Worcester, and many patents have been derived from hints and speculations by that ingenious author. But yet, as he never acted upon them, as he never brought out any machines whatsoever, those patents are good. And his Lordship also held that the meaning of the words public use is this;—that a man shall not by his own private invention, which he keeps locked up in his own breast, or in his own desk, and never communicates it, take away the right that another man has to a patent for the same invention.

SECTION III.

Of the Utility of an Art or Invention necessary in order to support a Patent.

The chief object of our Patent Law is to promote the benefit of the public by inducing inventors to give to the public a knowledge of their inventions or discoveries in the useful arts.

All the prerogatives of the Crown must be for the advantage and good of the people, otherwise they ought not to be allowed by the law. (*f*) Unless therefore the exercise of the prerogative of the Crown, in granting the sole use of an invention, is for the good of the people, it is contrary to law.

The Queen cannot charge her subjects, or abridge them of their liberty in any way except for their benefit, or where they shall have a sufficient consideration. (*g*) And it is clear that by the grant of the sole use of an invention to any person, all other persons are for a time deprived of the liberty of using the art which is comprised in the privilege granted by the patent; even if they themselves should unaided make an invention precisely similar in every respect; (*h*) and in order to procure *articles made according to the invention, they must also pay whatever the patentee may think [*133] fit to charge for them. In making a grant by patent of the sole use of an invention, the Queen acts on behalf of the public; (*i*) and as *the public*, by means of the patent, grants a privilege to the patentee, *the public* ought to have the consideration for the grant.

Unless an invention is of some use, and confers some benefit upon the public, the Crown cannot grant the sole use of it to the inventor or importer; for in order to support such a grant, there must be some consideration given to the public by the patentee; and if it appears that the art or invention which is the subject of a patent privilege, is of no use whatever to the public, the patent is void, and the grant is a nullity. (*k*)

We have already seen that the subject of a patent privilege is the art, by means of which vendible articles of manufacture are made or produced. (*l*) And in speaking of the quality of public utility required by law, it must be under-

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(*f*) Bac. Abr. tit. Prerog. (*g*) Vide 2 Rol. Abr. 172, s. 20.

(*h*) Vide *ante*, Chap. II. p. 11.

(*i*) Per Lord Eldon, L. C., in Harmer v. Playne, 14 Ves. 131, 136.

(*k*) See also the observations in the first Chapter, *ante*, p. 3, respecting the necessity of utility in an invention in order to make it the subject of a valid patent privilege.

(*l*) *Ante* s. 1, p. 77.

stood, that it is the subject of the patent privilege which must be useful or beneficial to the public, that is to say, the art by means of which such articles of manufacture are produced.

The subject of a patent privilege is, however, generally called by the name of an invention, and the word is used in this sense when it is said that an invention is required by law to be useful in order to be legally granted by patent. The benefit or utility which the public receives from an invention, arises from the useful employment of the labour of the people: workmen are benefited by increased means of obtaining employment and subsistence; and the rest of the public are benefited by the production of articles of trade or commerce.

The public utility of an invention is a condition required by the Common Law (independent of the Statute of Monopolies) in order to make the invention a proper subject of a grant by patent.

Thus in the case of monopolies, *Darcy* v. *Allin*, (*m*) it is laid down that where a man brings into the realm any new trade, *and that for the good of the realm*, the King may grant *him a monopoly for a reasonable time, "*in consideration of the good that he doth bring by his invention to the commonwealth: otherwise not.*"

[*134]

In Sheppard's Abridgment, (*n*) it is laid down that the King may for a reasonable time grant a monopoly patent of a new trade or device; or any new engine tending to the furtherance of it, *for the good of the realm.*

The Statute of Monopolies (*o*) did not make any change in the law in this respect, and accordingly we shall see that there are numerous cases determined since the passing of that statute, which decide that an invention must be useful in order to be made the subject of a valid patent privilege. The 6th section of the statute, which saves the prerogative of the Crown to make these grants, does not mention utility, but requires that such grants of privilege shall not be "contrary to the law, nor mischievous to the state by raising prices of commodities at home, or hurt of trade, or generally inconvenient." It is clear that the intention of the statute was not only to confine the prerogative of the Crown within the express limits defined by the 6th section, but also to preserve all the other provisions (*p*) of the Common Law inviolate; for the 6th section of the act concludes by declaring that such grants shall be of the same force as if the act had not passed, and of no other. And as the Common Law, which, prior to the making of the statute, required an invention to be useful in order to be the subject of a valid grant by patent, yet remains in full force, the grant of the sole use of an invention of no public utility, would clearly be contrary to the Common Law; and contrary to law within the meaning of the statute. Every case therefore which has been determined since the passing of the statute, respecting the utility of an invention, is a decision respecting the Common Law on the subject.

Commenting upon the words, "mischievous to the state by raising prices of commodities at home," in sec. 6 of the Statute of Monopolies, *Sir Edward Coke* says, (*q*) that "In every such new manufacture as deserves a privilege there must be *urgens* **necessitas* and *evidens utilitas*." And he further states that the reason why such a privilege is good in law, is "because the inventor bringeth *to and for the commonwealth*, a new manufacture by his invention, costs and charges, and therefore it is reason that he should have a privilege for his reward (and the encouragement of others in the like) for a convenient time.

[*135]

(*m*) Noy, R. 182,
(*n*) Part III. p. 61.
(*o*) 21 Jac. I, c. 3.
(*p*) The whole statute is clearly declaratory of the Common Law.
(*q*) 3 Inst. 184.

In the case of *The King* v. *Arkwright*, (*r*) which was a *scire facias* to repeal a patent for an invention, Mr. Justice *Buller* held, that it was a question for the jury whether the only new part of the machinery described in the specification was *material or useful, and that if they were of opinion that it was not so, the patent was void.* The jury found a verdict for the Crown; and although the defendant moved for a new trial on other grounds, no objection was made against the law upon this point as laid down by Mr. Justice *Buller* at the trial.

So in the case of *Boulton and Watt* v. *Bull*, (*s*) Mr. Justice *Rooke* said, that the public had a right to receive a *meritorious consideration* in return for the protection which the patent claims.

In the case of *Turner* v. *Winter*, (*t*) Mr. Justice *Ashurst* laid it down as law, that a patent would be contrary to law, were it not for *the advantages which the public derive* from the communication of the invention.

In the case of *Manton* v. *Parker*, (*u*) Lord Chief Baron *Thomson* held, that the plaintiff's patent was void on the ground of *the utility of the invention having failed*, and nonsuited the plaintiff.

So in the case of *Manton* v. *Manton*, (*x*) Lord Chief Justice *Gibbs* held, that in order to support a right to the exclusive enjoyment of a patent, it is necessary that the party who takes out the patent should show that the invention is *useful to the public.*

And in *Bovill* v. *Moore*, (*y*) the same learned Judge held, that it was necessary that the plaintiff should prove that his invention was useful.

*In the case of *Huddart* v. *Grimshaw*, (*z*) Lord *Ellenborough*, C. J., held, that in order to support a patent, the invention ought [*136] to be *beneficial to the public.*

In the case of *Brunton* v. *Hawks*, (*a*) Lord Chief Justice *Abbott* left it to the jury to say whether the invention was useful. And in the case of *Russell* v. *Cowley*, (*b*) in the Court of Exchequer, Lord *Lyndhurst*, C. B., said that the first question respecting the invention was, whether it was new and *useful;* and the rest of the Court fully concurred in opinion with his Lordship.

In the case of *Hill* v. *Thompson*, (*c*) Lord *Eldon*, L. C., cited with approbation the ruling of Lord Chief Justice *Dallas* at Nisi Prius, that an invention must be useful. So in *Minter* v. *Wells*, (*d*) Mr. Baron *Alderson* held, that in order to establish his patent, a patentee must show that his invention was useful. And the same learned Judge, in *Morgan* v. *Seaward*, (*e*) in his address to the jury said, that if the invention was useful it was a subject to be protected by patent; but if it was of no use, then it was not a subject to be protected by patent.

In the case of *Neilson* v. *Harford*, (*f*) the Court of Exchequer held, that to make the patent valid, a machine constructed according to the invention must be one *beneficial to the public.*

And in the case of *Crane* v. *Price*, (*g*) the Lord Chief Justice *Tindal*, in delivering the judgment of the Court of Common Pleas, said, (speaking of the labour, pains, and expense incurred by the plaintiff in bringing his invention to perfection,) "If the invention be new and *useful to the public*, it is not

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(*r*) Dav. P. C. 138.
(*t*) 1 T. R. 602; Dav. P. C. 151.
(*x*) Ibid. 333.
(*z*) Dav. P. C. 265.
(*b*) 1 Webs. R. 467.
(*d*) 1 Webs. R. 129.
(*f*) 8 M. & W. 806; 1 Webs. 331.
(*s*) 2 H. Bl. 463; Dav. P. C. 162.
(*u*) Dav. P. C. 327.
(*y*) Ibid. 399.
(*a*) See 4 B. & Ald. 541.
(*c*) 3 Mer. 622.
(*e*) 2 M. & W. 544.
(*g*) 4 M. & G. 580; 1 Webs. R. 393, S. C

material whether it be the result of long experiments and profound research, or whether by some sudden and lucky thought, or mere accidental discovery."

These authorities clearly establish the law to be, that an invention must be useful to the public, in order to make it a good subject of a privilege granted by letters patent. And utility is not only required by law, but appears upon the face of every patent to be the consideration or motive for the Queen making the grant. For we have seen, (*h*) that the recital contained in patents for inventions concludes with these words, "and we being willing to give encouragement to all *arts and inventions which may be for the public good*, are graciously pleased to condescend to the petitioner's request." It is evident, therefore, that the Queen always intends that the patentee shall give to the public, as a consideration for a grant of this description, some art or invention which shall be for the public good, or in other words, useful to the public.

[*137]

It has already been shown, (*i*) that, if the consideration which the Queen intends to have for such a grant fails, the patent is wholly void. And if it should appear that an invention which is made the subject of a grant by patent is of no utility to the public, then there was no consideration for the making of the grant, and the patent is for that reason entirely void.

The law, however, only requires an invention to be of *some* utility, and if it is of *any* use to the public, that is sufficient, provided the Crown does not appear to have been deceived as to the extent of the utility of the invention. Thus, in the case of *Morgan* v. *Seaward*, (*k*) at Nisi Prius, Mr. Baron *Alderson* held that it was not for the jury to consider to what extent the invention was useful, and that it was sufficient if the invention was of *any* use. And one part of the invention being an improvement in steam-engines, his Lordship was of opinion that if the new engine was of a different construction from any other steam-engine, and of *any* use to the public, the *utility* would be sufficient to support the patent.

So in the case of *Haworth* v. *Hardcastle*, (*l*) which was an action for infringing a patent for an invention of machinery for taking up calicoes, muslins, linens, and other similar fabrics, for the purposes of drying, Mr. Justice *Alderson*, at Nisi Prius, directed the jury that it was sufficient if the invention was of *any* use, and the Court of Common Pleas held the direction to be right. The jury, in that case, found that the invention was useful upon the whole, but that the machine was not useful in some cases for taking up goods. And the Court of Common Pleas held, (*m*) that this did not invalidate the patent, and therefore discharged a rule *nisi* for a nonsuit.

[*138]

In the case of *Lewis* v. *Marling*, (*n*) it appeared at the trial at Nisi Prius, that the patent was for an invention of improvements in machines for shearing woollen cloths. One part of the invention described in the specification was a plush brush for raising the wool, which was afterwards found to be unnecessary, and was never used. It was objected, on the part of the defendant, that the patent was void on the ground of the brush being wholly useless; but Lord *Tenterden*, C. J., held that as the patentee did not claim the brush as an *essential* part of the machine, the want of utility in the brush did not invalidate the patent. This case afterwards came before the Court of King's Bench, upon a motion for a new trial, and the Court laid down the law in precisely the

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(*h*) *Ante*, Chap. IV. pp. 47, 48.
(*i*) Vide *ante*, Chap. IV. p. 48.
(*k*) 1 Webs. R. 172, 186.
(*l*) 1 Bing. N. C. 182; 4 Mo. & Sc. 720, S. C., and vide *ante*, Chap. I.
(*m*) 1 Bing. N. C. 182; 4 Mo. & Sc. 720, S. C.
(*n*) 4 C. & P. 52; 10 B. & C. 22, S. C.

same terms as Lord *Tenterden* had at Nisi Prius. Lord *Tenterden*, C. J., said, "It does not appear that the patentee says the brush is an essential part of the machine, although he claims it as an invention. When the plaintiffs applied for the patent, they had made a machine to which the brush was affixed; but before any machine was made for sale, they discovered it to be unnecessary. I agree that if the patentee mentions that as an essential ingredient in the patent article which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs' claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful." Mr. Justice *Bayley* said, "At the period when this specification was made, the plush (brush) was in use, and there is no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument, where something of that kind was always thought material, and I am of opinion that the subsequent discovery that the plush was unnecessary, is no objection to the validity of the patent. If the party knew that it was unnecessary, the patent would be bad, on the ground that this was a deception; but if he *thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms a ground of objection." [*139]

And in the case of *Morgan* v. *Seaward*, (*o*) Mr. Baron *Parke* said, in delivering the judgment of the Court of Exchequer, we do not mean to intimate any doubt as to the validity of a patent for an entire machine or subject, which is, taken altogether, *useful*, though a part or parts may be useless; *always supposing that such patent contains no false suggestion.*

But if there are several distinct inventions comprised in a patent, then it is clear that *each* invention must be of *some* utility to the public, or the *whole* grant will be void.

Thus, in the case of *Morgan* v. *Seaward*, (*p*) at Nisi Prius, it appeared that the invention consisted of improvements both in steam-engines and in machinery for propelling vessels. The defendants having pleaded that the invention was of no use, Mr. Baron *Alderson*, in his charge to the jury, said that they could not find a verdict for the plaintiffs unless they were satisfied that both the steam-engine and the machinery for propelling vessels were useful.

The reason for this is stated very clearly by Lord Chief Justice *Dallas*, in the case of *Hill* v. *Thompson*, (*q*) to be, "That if any part of the alleged discovery, being a material part, fail, (the discovery in its entirety forming one entire consideration,) the patent is altogether void." And the same law was laid down (as to novelty) by the Court of Queen's Bench, in the case of *Brunton* v. *Hawks*. (*r*)

And if any material part of the representation or suggestion which appears by a patent to have been made in the petition to the Crown, respecting the utility of the invention, shall fail or be untrue, the consideration fails in part, and the grant is totally void; (*s*) and that not only on the ground of the partial failure of the consideration, but because the representation being false the Queen was deceived in her grant. (*t*)

Thus in the case of *Turner* v. *Winter*, (*u*) in which it appeared *that the patent was for an invention to do three things in one process, it was objected that one of the things, viz: white lead, could not be pro- [*140]

(*o*) 2 M. & W. 563.
(*p*) 1 Webs. R. 172.
(*q*) 8 Taunt. 375; 2 B. Mo. 448, S. C.
(*r*) 4 B. & Ald. 541.
(*s*) Bloxam v. Elsee, 6 B. & C. 178.
(*t*) Morgan v. Seaward, 2 M. & W. 561.
(*u*) 1 T. R. 602; Dav. P. C. 145, S. C.

duced at all; and Mr. Justice *Buller* told the jury, that if the objection was well founded it would avoid the patent. The jury having found a verdict for the plaintiff, the defendant moved the Court of King's Bench for and obtained a rule for a new trial. Mr. Justice *Ashurst* said, in delivering his judgment, "The patent is for making white lead and two other things by one process; if the process, as directed by the specification, does not produce that which the patent professes to do, the patent itself is void." And Mr. Justice *Buller* said, "If the patentee says that by one process he can produce three things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant."

In the case of *Bloxam* v. *Elsee*, (*x*) the patentee had represented that his invention was a machine for making paper in single sheets, without seam or joining, *from one to twelve feet and upwards wide*, and from one to forty-five feet and upwards in length. It appeared in evidence that the machine was so constructed as to be capable of producing paper of one definite width only, and that in order to vary the width a new machine was required. It was held by the Court of King's Bench that the meaning of the patentee's representation was, that paper of various widths might be obtained by one and the same machine; and as that representation was not true, the patent was void. In delivering judgment the Lord Chief Justice *Abbott* said, "By the patent it appears that the patentee had represented to the Crown that he was in possession of a machine for making paper in single sheets without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. Upon this representation the patent is granted. The consideration of the grant is the invention of a machine for making paper in sheets of width and length varying within the limits designated. If any material part of the representation was not true, the consideration has failed in part, and the grant is consequently void, and a defendant in an action for infringing the patent has a right to say that it is so."

[*141] *And in the case of *Morgan* v. *Seaward*, (*y*) it appeared that the plaintiff, by his patent and specification, claimed two separate inventions under the title of "improvements in steam-engines, and in machinery for propelling vessels, which improvements are applicable to other purposes." The defendant pleaded that the invention was not an improvement in *steam-engines*, and the jury having found a verdict for the defendants on that plea, the Court of Exchequer held, that although the jury by their verdict had found that one part of the invention was an improvement in machinery for propelling vessels, yet one of the inventions not being an improvement, the grant was wholly void. Mr. Baron *Parke* said, in delivering the judgment of the Court, "We cannot help seeing, upon the face of this patent as set out in the record, that an improvement in steam-engines is suggested by the patentee, and is part of the consideration for the grant, and we must reluctantly hold that the patent is void for the falsity of that suggestion."

In the case of *Losh* v. *Hague*, (*z*) in the Court of Exchequer, the invention was of improvements in wheels for railway carriages. The defendant by his second plea alleged that the improvements were only trifling and insignificant alterations in the mode of making wheels before known, and were not legal subjects of a patent. Upon the issue raised by this plea, Lord *Abinger*, C. B., left it to the jury to consider whether the invention was worth a patent or not. The question thus raised in this case seems to have been in effect, whether the representation made to the Crown, that the invention was improvements in

(*x*) 6 B. & C. 169.
(*y*) 2 M. & W. 544.
(*z*) 1 Webs. R. 202.

the construction of railway carriage wheels, was true or not; for the representation must mean some substantial improvements in such wheels, and if the improvements were trifling and insignificant, the representation was false, and the patent would have been void.

The Statute of Monopolies, it has been seen, (*a*) provides that grants of privilege shall not be "contrary to the law; nor mischievous to the state by raising prices of commodities at home, or hurt of trade, or generally inconvenient."

And in the case of *Morgan* v. *Seaward*, (*a*) the Court of Exchequer said, that "A grant of a monopoly for an invention *which is altogether useless, may well be considered as 'mischievous to the state, to the [*142] hurt of trade, or generally inconvenient,' within the meaning of the statute of James I., which requires, as a condition of the grant, that it should not be so, for no addition or improvement of such an invention could be made by any one during the continuance of the monopoly, without obliging the person making use of it to purchase the useless invention."

This clause of the statute seems also to mean that the excepted grants must not be for the sole making of any thing which is to be used for any purpose which is illegal, or "contrary to law," such as implements for house-breaking, picking pockets, locks, &c. Such grants, however, it is clear would be void, not only on the ground of want of public utility, but also because they are contrary to the policy of the law; and indeed it would be absurd if, by one law, patents might be granted to reward persons for providing the means of violating any other law.

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*CHAPTER VI. [*143]

OF THE DURATION OF THE PRIVILEGE GRANTED BY A PATENT FOR AN INVENTION, AND THE PROLONGATION OF IT.

SECT. I.—*Of the Term which may be granted by Patent in the first instance.*
II.—*Of the Extension of the Term by New Letters Patent.*
III.—*Of the Prolongation of the Term by Act of Parliament.*

SECTION I.

Of the Term in a sole Privilege which may be granted by Patent in the first instance.

BEFORE the passing of the Statute of Monopolies, the Crown had power by the Common Law to grant the sole use of an invention *for a reasonable time.* (*b*)

The 6th section of the Statute of Monopolies (*c*) contains a saving of this prerogative of the Crown, as to "letters patents and grants of privilege *for the*

(*a*) *Ante*, p. 134.

(*b*) Noy, 182; 3 Inst. 184; 2 Rol. R. 4; 3 Shep. Abr. 61; Bac. Abr. Monop. (A.) Prerog. (F 4); 1 Hawk. P. Cr. c. 79, s. 6. (*c*) 21 Ja. I. c. 3.

term of fourteen years or under," thereafter to be made; and it is declared that the fourteen years are "to be accounted from the date of the first letters patents or grants of such privilege," thereafter to be made, but with the proviso, that "the same shall be of such force as they should be," if the act had not been made, "and of none other."

This statute, therefore, limited the prerogative of the Crown so far, that a patent could not be granted for *more* than fourteen *years, but still [*144] leaving the question open for consideration whether a patent for fourteen years was for a reasonable term, and good at the Common Law.

Sir Edward Coke says, (*c*) "The cause wherefore the privileges of new manufactures, either before this act granted, or which after this act should be granted, having these seven properties, were not declared to be good, was for that the reason wherefore such a privilege is good in law, is because the inventor bringeth to and for the commonwealth a new manufacture by his invention, cost, and charge, and therefore it is reason that *he should have a privilege for his reward* (and the encouragement of others in the like) *for a convenient time;* but it was thought that the times limited by this act were too long for the private, before the commonwealth should be partaker thereof, and such as served such privileged persons by the space of seven years, in working of the new manufacture, (which is the time limited by law of apprenticehood) must be apprentices or servants still during the residue of the privilege, by means whereof such numbers of men would not apply themselves thereunto, as should be requisite for the commonwealth after the privilege ended. And this was the true course wherefore, both for the time passed and for the time to come, they were left of such force, as they were before the making of this act."

It seems from this commentary as if *Sir Edward Coke* thought that the inventor ought to be rewarded by a term in proportion to the benefit of his invention to the commonwealth. The other reason which he gives against the legality of the term of fourteen years mentioned in the act, has never been attended to; and patents for inventions have always, in practice, been granted for the full term of fourteen years allowed by law, and no patent has ever been decided to be invalid, on the ground of the term of the grant being too long.

There can be no question, however, that the Queen may grant the use of an invention for any term less than fourteen years; and the provision in the statute that the term of fourteen years is to be computed from the date of the *first* letters patent or grant, seems to show that the Queen might grant [*145] *several terms shorter than fourteen years, provided the terms do not altogether exceed in duration the fourteen years allowed by the statute.

SECTION II.

Of the Extension of the Term by New Letters Patent.

Before the passing of the statute 5 & 6 Will. IV. c. 83, (*d*) the only mode by which the duration of a patent privilege in an invention could be extended, was by act of Parliament. By the fourth section of that statute it is in effect provided, that if any person who shall obtain any letters patent, shall publish such advertisements as therein mentioned, and shall apply by petition to the

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(*c*) 3 Inst. 184; *ante*, pp. 14, 15, 16.

(*d*) See the statute in the Appendix, Chapter I. s. 1.

Queen in Council for a prolongation of his term; and if the consideration of the petition shall be referred to the Judicial Committee of the Privy Council, the petitioner, and also persons entering *caveats* against the prolongation are to be heard by their counsel and witnesses; whereupon the Judicial Committee of the Privy Council may report to the Queen, that a further extension of the term should be granted, not exceeding seven years. And her Majesty is thereby authorized and empowered, if she shall think fit, to grant new letters patent for the invention, for a term not exceeding seven years after the expiration of the first term. (*e*)

We have seen that the object of our Patent Law is to reward those who give to the public the knowledge of new and useful inventions, and in this manner to encourage others to give the public the benefit of such inventions. (*f*)

The principle upon which an extension of a patent privilege is granted to a patentee, is, that he has not been rewarded or sufficiently rewarded for the benefit which the invention has conferred upon the public.

When an inventor has obtained his patent, he must in the first place apply himself to the task of bringing his invention *to such a degree of perfection as to make it useful to the public, and in doing so, must [*146] necessarily incur expense and expend a considerable portion of the term granted by the patent.

And however useful and meritorious an invention may be, it is generally very difficult to introduce new articles into such general use as to remunerate the patentee for his necessary outlay; and in many instances a patentee does not during the term of fourteen years, allowed by law to be granted to him in the first instance, receive anything like an adequate reward for the benefit which he confers upon the public.

It is but just, therefore, that the law should follow out the principle upon which patents for inventions are granted; and where it is shown that a patentee without any fault of his own has not been remunerated for his labour, and necessary outlay, or has not been adequately rewarded for the benefit which the invention has conferred upon the public, he ought to have such a further term granted to him as will be sufficient for effecting both those objects.

Considering the general object of our Patent Law, and the preamble of the statute 5 & 6 Will. IV. c. 83, there can be no doubt that the intent of the 4th section of that act was to provide for the more adequately rewarding of inventors, where they have given the public useful inventions, and have received no sufficient remuneration. And there can be no question respecting the good policy of granting such extensions, in proper cases, for obtaining "the more ample benefit of the public" (*g*) from such meritorious inventions.

Acting upon this intent of the law, and also in accordance with the grounds upon which acts of Parliament have been granted for extending the terms granted by patents, the Judicial Committee of the Privy Council require every petitioner, for the prolongation of a patent term, to show not only that the invention is of considerable benefit to the public, but also that he has been unable to obtain any sufficient remuneration for his ingenuity and necessary outlay. (*h*) And the practice of the Judicial Committee has been to report in favour of *extensions for such terms as the merits of [*147] inventions, and the exigencies of the cases, require. In some cases the full

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(*e*) For the proceedings to be taken in order to obtain the prolongation of a patent term, see the practice, *post*, Chap. XII.; and for the construction of the act see Russell v. Ledsam, not yet reported.

(*f*) Vide *ante*, Chap. III.

(*g*) These words are in the preamble of the statute 5 & 6 Will. IV. c. 83.

(*h*) See further, as to what must be proved in support of a petition for prolongation of a patent term, Practice, Chapter XII.

term of seven years has been granted, but in many others, the extension has been for shorter periods.

Cases have occurred in which the extra term of seven years authorized by the statute 5 & 6 Will. IV. c. 83, s. 4, would entirely fail to remunerate an inventor sufficiently, and therefore the power granted to the Queen in Council, was, by s. 2, of the stat. 7 & 8 Vict. c. 69, (*i*) extended so as to authorize grants being made in such cases for terms not exceeding fourteen years.

The object of this enactment also clearly appears on the face of it to be, to enable inventors to obtain a due remuneration for their expense and labour in perfecting their inventions in cases where an additional term of seven years would be insufficient for that purpose.

The object of the Patent Law being to reward meritorious inventors, the Privy Council will sometimes, in case of an application by an assignee of a patent for a prolongation, carry the object of the law into effect by annexing a condition in favour of the original patentee to the grant of the prolongation which the assignee seeks to obtain.

Thus, in the case of *Whitehouse's* patent, (*k*) the application for an extension of the term was made by the assignee of the patent, and it appeared that the assignment under which he claimed reserved an annuity of 300*l.* a year to the patentee. The Judicial Committee of the Privy Council deemed the case to be a fit case for an extension of the term for six years, but granted it only upon condition that the patentee had an annuity of 500*l.* a year secured to him during the continuance of the additional term, which was granted in pursuance of their Lordship's report. Upon the new patent being granted, the securing of this annuity to the first patentee was recited as part of the consideration for the grant of the patent to the assignee, and the performance of the assignee's agreement to pay the annuity was secured by a proviso in the patent, that the [*148] patent should be void if the assignee failed to perform his *agreement. (*l*) Such cases as this are calculated to produce a very beneficial effect, as evincing a determination on the part of those who so ably administer the law to do justice to meritorious inventors, and reward them (as far as the law enables them) according to the degree of their merits.

In granting a prolongation of a patent term, the Judicial Committee of the Privy Council will also take into consideration the position of licensees, and see that they are not unfairly prejudiced by the prolongation. A person who obtains a license to use a patent privilege, only purchases the right during the continuance of the patent privilege; but he also makes the purchase, and perhaps invests considerable capital in machinery, or stock for working the invention, with the expectation that he will be at liberty to enjoy the unrestricted use of the invention at the end of the term.

But if a new privilege be granted to the patentee, to take effect from the expiration of the first, licensees under the first patent would be unable to continue the use of the invention without the consent of the patentee under the new patent, who might impose oppressive terms upon them, or altogether refuse a renewal of their licenses. The fair and equitable mode of adjusting the respective rights of a patentee and his licensees in such a case seems to be, that every licensee should have the privilege of using the invention during the continuance of the new patent upon the same terms as he enjoyed his former license.

Therefore, whenever there are several licensees entitled to use a patent invention, the patentee will not be able to obtain an extension of his term,

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(*i*) See the statute in the Appendix, Chap. I. s. 1.
(*k*) 1 Webs. R. 473. (*l*) 1 Webs. R. 476, n. (*h*).

unless he makes some arrangement with them, or undertakes to grant them licenses upon the same terms as their former licenses. It was for this reason that in the case of *Southworth's* patent, (*m*) the petitioner proved in evidence that arrangements had been made with all the licensees that they should have licenses on the same terms in the event of the term of the patent being extended.

But the Judicial Committee of the Privy Council will not, in other cases, interfere in favour of parties who, not being inventors, set up legal or equitable claims to participate in the *benefits to arise from the prolongation of a patent privilege, but will recognize the legal proprietors of the first patent only, leaving other parties to pursue their legal or equitable claims before the ordinary tribunals. (*n*) [*149]

Some doubt having arisen in the construction of section 4 of the statute 5 & 6 Will. IV. c. 83, respecting the power conferred by that act to grant prolongations in cases where patentees have wholly or partly assigned their privileges, (*o*) the question was set at rest by the statute 7 & 8 Vict. c. 69, s. 4, (*p*) by which it is declared that an extension may be granted either to an assignee or assignees, or to the original patentee or patentees, or to an assignee or assignees and patentee or patentees conjointly.

SECTION III.

Of the prolongation of the Term in a Patent, by Act of Parliament.

Before the Crown was enabled to grant an extension of a patent term, by the statute 5 & 6 Will. IV. c. 83, s. 4, (mentioned in the preceding section of this chapter,) the terms of patents for inventions were frequently prolonged by Parliament. The practice of prolonging patents in this manner seems to have originated soon after the passing of the Statute of Monopolies, (1623) for we find an order of the House of Commons respecting petitions for bills to extend the terms in patents dated as far back as 1685.

Many of the acts which have been passed for this purpose are mentioned in the Appendix to the Report of the Committee of the House of Commons in 1829, respecting the Law of Patents.

Almost all (if not all) the acts which have been passed to extend the terms granted by patents, have been granted by Parliament upon the ground of the utility or benefit of the inventions to the public, and the acts themselves recite this *to be the reason or motive for granting the extension sought by the patentees. [*150]

In granting extensions under the 5 & 6 Will. IV. c. 83, s. 4, and 7 & 8 Vict. c. 69, s. 2, the Judicial Committee of the Privy Council seem to have considered themselves (as in truth they are) merely acting in the place of Parliament; and in execution of the powers thus delegated to them, have granted extensions of terms in patents in such cases only as Parliament would have granted them to inventors.

(*m*) 1 Webs. R. 486, 487.

(*n*) See the case, Wright's patent, 1 Webs. R. 561.

(*o*) In Southworth's case however Lord Brougham said, that the new letters patent ought to be granted to the parties who had a legal interest in the existing patent.

(*p*) See the stat. in the Appendix, Chap. I. s. 1.

There have been no acts passed for prolonging such terms since the statute 5 & 6 Will. IV. c. 83 came into operation; and since the statute 7 & 8 Vict. c. 69, extends the power of the Queen in Council so as to authorize a prolongation for an additional term of fourteen years, there seems to be very little probability of any application to Parliament for such an act being successful.

And it is clear that such an application would not succeed in any case except under extraordinary circumstances, and in all probability not until the patentee has obtained an extension of his term by a new patent under the recent statutes, and found that the extended term is insufficient to procure him an adequate remuneration.

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*CHAPTER VII.

OF THE SPECIFICATION OF AN INVENTION WHICH IS MADE THE SUBJECT OF A PATENT PRIVILEGE.

SPECIFICATIONS were unknown until the reign of Queen Anne; but before that time, it was usual in a patent, granting the sole use of an invention, to insert a recital containing a description of the invention which was made the subject of the grant. (*a*) And there can be little doubt that a patent without such a recital, and also without a condition requiring a specification or description of the invention in some way or other for the use of the public, would be absolutely void for want of consideration.

The descriptions of inventions which were formerly contained in patents were, however, very meagre and unsatisfactory, and the practice being found inconvenient, about the middle of the reign of Queen Anne it became usual to insert in patents merely a short description or title of the invention, but at the same time with a proviso requiring that the patentee should enrol a particular description of the invention in Chancery, within a short time after the date of the patent.

This was the origin of the instruments which are now generally denominated specifications.

The specification or description of a patent invention, by instrument enrolled in Chancery, is not however required either by the Common Law or by the Statute of Monopolies, as has frequently been supposed, but only by the condition or proviso which is contained in the patent itself.

The form of this condition in patents (*b*) invariably provides that if the patentee shall not *particularly describe and ascertain the nature of his invention, and in what manner it is to be performed* by an instrument in writing under
[*152] his hand and *seal, and cause the same to be enrolled in Chancery within the time named (four or six months) after the date of the patent, then the patent and the privilege granted by it are to cease and become void.

There are two things required by this proviso: *first*, That the patentee shall describe his invention by an instrument in writing, usually termed a specification; and, *second*, That this instrument shall be enrolled in Chancery, within a limited time, so as to become a record for the benefit of the public. We will first consider the specification itself.

(*a*) Vide *ante*, Chap. IV. p. 69. (*b*) See the Form, *ante*, Chap. IV. p. 68.

The condition requires that the specification shall be under the hand and seal of the patentee, (*c*) or if there be two or more patentees, then under the hand and seal of the patentees, or of one of them. But no executor, administrator, assignee, nor any other person except the patentee himself can make a valid specification of the invention. And, therefore, in case of the death of the patentee before specification of the invention, the patent must become void for want of a compliance with this condition.

A specification is also required to be in writing, and it may be written upon parchment, vellum, or paper, but it is apprehended not upon any other substance. (*d*) But, although it must be in *writing*, it is not necessary that it should be entirely in *words*, it may be made partly in writing, and partly by means of plates, drawings, or figures.

In the case of *Macfarlane* v. *Price*, (*e*) Lord *Ellenborough*, C. J., said, that the patentee in his specification ought to inform the person who consults it, what is new and what is old; he should say, my improvements consist in this, describing by words if he can, or if not, by reference to figures.

In the case of *Bloxam* v. *Elsee*, (*f*) Lord Chief Justice *Abbott* said, "An inventor of a *machine* is not tied down to make such a specification, as, by words only, would enable a skilful mechanic to make the machine, but he is to be allowed to call in aid the drawings which he annexes to the *specification; and if, by a comparison of the words and the drawings, [*153] the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."

In the case of *The King* v. *Arkwright*, (*g*) Mr. Justice *Buller* directed the jury, that in determining the specification they were to consider it in conjunction with the plan annexed. And Mr. Baron *Alderson* directed the jury in a similar manner in the case of *Morgan* v. *Seaward*. (*h*)

It is, however, no objection to a specification that it has no drawing annexed to it, if it sufficiently describes the invention. (*i*) Nor is it any objection that the drawings annexed to a specification are roughly executed, if they are sufficient with the specification to enable a competent person to use the invention. (*k*)

There is no particular form requisite for a specification, nor are there any technical words necessary to be used in describing a patent invention.

The instrument must, however, in some way at least refer to the patent intended to be specified, or contain words which sufficiently indicate an intention to perform the condition in the patent.

Custom has, however, sanctioned a particular form for the commencement or introductory part of specifications, which patentees, with great prudence, almost invariably adopt.

Specifications framed in the usual way commence in the same form as a deed poll, with a direction such as the following:—"To all to whom these presents shall come, or be made known, I, James Gowland, of Leathersellers' Buildings, London Wall, in the city of London, Chronometer Maker, send greeting." And this direction is proper, because all persons are interested in the subject of the patent, and are at their peril bound to take notice of the contents of the

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(*c*) Although a specification is, in pursuance of the condition, always made under the hand and seal of the patentee, it seems that it is not a deed, for an instrument requires delivering as well as sealing in order to become a deed; Shep. Touch. 54, 55; Co. Lit. 36, a; Perkins, s. 137.

(*d*) Vide Shep. Touch. 54; Co. Lit. 229, a.

(*e*) 1 Stark. R. 199.

(*f*) 1 C. & P. 558, 564.

(*g*) Dav. P. C. 128.

(*h*) 1 Webs. R. 173, 176.

(*i*) Per Rook, J., in Boulton v. Bull, Dav. P. C. 188, 189.

(*k*) Per Gibbs, C. J., in Bovill v. Moore, Dav. P. C. 369.

specification *as enrolled;* (*l*) and it will become essentially a part of the patent itself, if it be a sufficient and legal compliance with the condition upon which the patent was granted.

[*154] *The specification then proceeds to recite the grant by patent of the invention intended to be specified in a form substantially as follows:—"Whereas her most excellent Majesty, Queen Victoria, by her letters patent, under the Great Seal of Great Britain, bearing date at Westminster, the day of in the year of her said Majesty's reign, did give and grant unto me the said James Gowland, my executors, administrators, and assigns, her especial license, full power, sole privilege and authority, that I, the said James Gowland, my executors, administrators, and assigns, and such others as I, the said James Gowland, my executors, administrators, and assigns, should at any time agree with, and no others, from time to time, and at all times thereafter during the term of years therein mentioned, should, and lawfully might make, use, exercise, and vend, within that part of the United Kingdom of Great Britain and Ireland, called England, the Dominion of Wales, and Town of Berwick-upon-Tweed, [the islands of Guernsey, Jersey, Alderney, Sark and Man, and all her said Majesty's colonies and plantations abroad] my invention of '*a certain improvement, or certain improvements in the mechanism of Timekeepers,*' in which said letters patent there is contained a proviso, that I, the said James Gowland, shall particularly describe and ascertain the nature of my said invention, and in what manner the same is to be performed, by an instrument in writing, under my hand and seal, to be enrolled in her said Majesty's High Court of Chancery, within [six] calendar months next, and immediately after the date of the said in part-recited letters patent, as reference being thereunto had will more fully and at large appear."

This recital is amply sufficient to identify the patent, and the invention which is intended to be described. It is also useful, if not indeed necessary, in order to give notice to the public of the grant and authority in pursuance of which the description is made and enrolled amongst the public records of the country.

The specification then, according to the usual form, proceeds to declare the intent of the instrument thus:—

[*155] "Now, know ye, that in compliance with the said proviso, I, the said James Gowland, do hereby declare that the nature *of my said invention, and the manner in which the same is to be performed, are described and ascertained as follows (that is to say:) my said invention consists," &c.

Then follows the description of the invention which is intended to be given in compliance with the condition in the patent.

But if the patentee makes use of drawings to aid him in describing his invention, the form is as follows:—

"Now, know ye, that in compliance with the said proviso, I, the said James Gowland, do hereby declare that the nature of my said invention, and the manner in which the same is to be performed, are described and ascertained with the aid of the drawings annexed hereto (or appearing on the margin of these presents) by the words, letters, and figures following (that is to say:) my said invention," &c.

After which follows the description of the invention, referring from time to time to the drawings when necessary.

This commencement of an ordinary specification is sufficient to show that the intent is to specify the invention comprised in the patent which is recited.

Some such declaration of the intent or purpose of the instrument is clearly necessary, for if a specification was entirely without such a declaration, it

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(*l*) 1 Co. R. 45, a.

would be difficult, if not impossible, to ascertain to what it referred, and therefore it could not be a sufficient compliance with the condition in the patent.

The effect of this commencement is, *primâ facie*, to claim as part of the invention every thing comprised in the following description. (*m*) And therefore, if anything is comprised in the description which forms no part of the invention, it becomes necessary afterwards to disclaim it, in order to prevent the patent from being void by reason of the claim being too extensive.

Having examined the formal commencement of a specification, we now come to the consideration of the essential or substantial part of it.

The condition already stated requires that this instrument shall "*particularly* describe and ascertain" the invention, *and that it shall describe and ascertain not only "the *nature* of the invention," but also "*the manner in which it is to be performed.*" [*156]

The patent itself merely contains what is called the title of the invention; but the terms in which titles usually describe inventions in patents, do not descend to any particularity, and they never give any precise information respecting the nature of the inventions, much less as to the manner in which they are to be carried into effect.

The condition in a patent, therefore, requires that the specification shall contain a *description* of the invention, and the description is required to be *particular*, so that it may clearly *ascertain* what the invention is.

We have seen that the subject of every patent, granting the sole use of an invention, is in fact a sole privilege of using an art for manufacturing vendible articles. (*mm*) The condition for specification, therefore, requires that that instrument shall describe not only the nature of the art or invention, but *the manner in which it is to be performed.*

The object of the proviso or condition which requires the enrolment of a specification is two-fold: first, That the public may know what it is they are prohibited from using during the term granted by the patent; (*n*) and, secondly, That after the term has expired, the public may have the full benefit of the invention which forms the consideration for the grant.

Thus, in the case of *Harmar* v. *Playne*, (*o*) Lord *Ellenborough*, C. J., said, that the object of requiring a specification to be enrolled seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell, from the inspection of the specification itself, what the invention was for which the patent was granted, and how it was to be executed. And in the case of *Bovill* v. *Moore*, (*p*) Lord Chief Justice *Gibbs* said, that the object of the condition which requires the specification is, that the patentee shall thereby describe the mode of the manufacture, so as to enable any person to make it after his term is expired.

The patentee is required to enrol a specification of his invention, *because the public is entitled to know what the patent has been granted for, what they are prohibited from doing during the existence of the patent privilege, and what they are to become entitled to when it expires, as the consideration for the grant which has been made by the Crown on their behalf. [*157]

The vague description of an invention in the title of it contained in a patent, gives little if any notice to the public of the real nature of the manufacture they are prohibited from using, and unless some specific information were to be given to persons respecting what they are commanded by the patent to refrain from

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(*m*) Bovill v. Moore, Dav. P. C. 399.
(*n*) Macfarlane v. Price, 1 Stark. R. 201.
(*p*) Dav. P. C. 398.
(*mm*) Vide *ante*, Chap. V. s. 1, p. 77.
(*o*) Dav. P. C. 316.

doing, they could not be punished for any violation of the patent right committed in ignorance of its nature and extent.

Whenever therefore an action is brought against a party for infringing a patent, in order to ascertain whether he is guilty of an infringement or not, it is necessary to ascertain whether the thing which is complained of as a contravention of the patent, is really or substantially described in the patentee's specification, as the whole or part of the invention for which the patent was granted. (*q*) And if the specification does not sufficiently describe some art of manufacturing which is substantially the same as that used by the party charged with the infringement, no action can be maintained against him for such an alleged violation of the patent privilege.

In the case of *Morgan* v. *Seaward*, Mr. Baron *Alderson* held, (*r*) that the patentee ought to state in his specification the precise way of doing every thing which is part of his invention; and that if any thing cannot be completely done by following the specification, then a person will not infringe the patent by doing it.

And in the case of *Nielson* v. *Thompson*, (*s*) Lord *Cottenham*, L. C., said that the public are entitled to know for what it is that the patentee claims as the invention, that they may be saved inconvenience upon the subject; therefore the specification must tell the public for what it is that he claims protection.

A patent for an invention in fact contains a bargain made between the Queen acting on behalf of the public, and an inventor, by means of which [*158] *the inventor obtains the sole right for a limited time to use the art which he has discovered, in consideration of his giving to the public a knowledge of his invention, (*t*) so as to enable other persons to use it after the expiration of his privilege. And such bargains are to be judged on the principle of keeping good faith by making a fair disclosure of the invention, and to be construed as other bargains. (*t*)

No branch of Patent Law has undergone more discussion or consideration than that relating to the specification, and more patents have failed by reason of defects in their specifications than from any other cause.

For many purposes the specification must be considered as part of the patent itself, for it is enrolled in pursuance of an authority contained in the patent, and therefore it may perhaps be laid down, that for all purposes except for showing its own sufficiency or proving a due compliance with the proviso, by which it is required to be enrolled, it must be considered as part of the patent itself.

Thus in case of *Hornblower* v. *Boulton*, (*u*) Mr. Justice *Grose* said, "I consider the patent and specification so connected together as to make a part of each other, and that to learn what the patent is, I may read the specification, and consider it as incorporated with the patent." There are indeed no other means of obtaining any definite information respecting the invention which is comprised in a patent, than by having recourse to the specification; and therefore for the purpose of a patentee showing what his invention is; and, (in answer to any objections made to it,) that it possesses all the qualities of novelty, utility, &c., required by law; as well as that any act which he complains of was really an infringement of his patent, the patentee is at liberty to refer to his specification, and to treat it as part of his patent.

Thus, in the case of *Crossley* v. *Beverley*, (*x*) which was an action for the infringement of a patent, Mr. Justice *Bayley* said, "I think the specification

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(*q*) See further as to what is an infringement, *post*, Chap. XI.

(*r*) 1 Webs. R. 182. (*s*) Ibid. 283.

(*t*) See the observation of Lord Eldon, C. J., in Cartwright v. Amatt, Dav. P. C. 317, 318; Harmar v. Playne, 14 Ves. 131, 136.

(*u*) 8 T. R. 105; Dav. P. C. 230, S. C. (*x*) 9 B. & C. 62; 1 Webs. R. 117, S. C.

and the patent are to be taken *as one muniment in enforcing this claim on the part of the patentee." Unless there be some variance between the title in the patent and the description contained in the specification, the specification must be deemed *primâ facie* to describe the same invention, as that in respect of which the patentee originally petitioned the Crown for a patent privilege, and the description must, for all purposes, be deemed a part of the patent, except for the purpose of determining whether the patentee has sufficiently described the nature of the invention, and the manner in which it is to be used or performed according to the stipulations contained in the proviso in the patent, in pursuance of which he has enrolled it. [*159]

In considering the requisites of a specification, it is necessary to have regard not only to the words of the proviso in the patent, but also to the object with which a specification is required, and which has already been mentioned, viz: *the furnishing of sufficient and certain information to the public respecting what they are prohibited from doing whilst the privilege continues, and what they will be enabled to do after it is expired.*

Many rules have been laid down by different writers respecting the requisites of a specification, but it is difficult, if not impossible, to lay down such a set of rules as will be applicable to every possible case.

All that can be done is to state such rules as are of most general application; and by citing the decided cases and dicta of the judges on the subject, the reader will be better enabled to apply those rules in practice to the construction of the instrument. It ought always, however, to be borne in mind, that the enrolment or publication of the specification is to be the performance by the patentee of his part of the bargain which he has made with the public, and that part of the bargain *he is expected to perform with perfect good faith.*

1. The patentee must in his specification describe the invention which is comprised in his patent, and not any other; and if it appears that there is any variance, or that the invention as described in the specification is not precisely similar to that mentioned in the patent, the patent will be void.

Thus, in the case of *The King* v. *Wheeler*, (*y*) it appeared *that the invention was described by the title in the patent as "a new or improved method of drying and preparing malt." The specification stated the invention to consist in heating malt to a high degree, so that it should be changed to a deep brown colour. The jury having, by direction of Lord Chief Justice *Abbott*, returned a verdict for the Crown, the defendant moved for a new trial, which the Court of King's Bench refused, and the Lord Chief Justice, in delivering the judgment of the Court, said, "The defendant has represented himself to the Crown to be the inventor 'of a new or improved method of drying and preparing malt.' Malt was an article of common use before the granting of this patent, possessing qualities long and well known, and prepared or made by a process practised for many years, of which drying was one of the last stages. And it is in our opinion impossible to read this patent without supposing the patentee to claim the merit of having invented some new or improved method, either of organ or process of preparing, or at least of drying this old and well known article. Then, has the patentee by his specification shown himself to be the inventor of any method of drying or preparing this well known article? For this we are to look at the specification; and we there find that he claims to be the inventor, not of a method of drying or preparing this well known article, but of a method of giving to it, when previously prepared, some qualities which it did not possess before, or which it possessed only in a very slight degree; namely, the qualities of being soluble in water, and colour- [*160]

(*y*) 2 B. & Ald. 345.

ing the liquor in which it shall be dissolved, which latter is the object in view. And this is to be effected by a second and additional process, the application of a very high degree of heat. We think *the invention mentioned in this specification so entirely different from that mentioned in the patent, as that the latter* (if any such there be) *remains wholly undescribed and unspecified*, and consequently that the issue (respecting the sufficiency of the specification) could not be found for the defendant."

So in the case of *Campion* v. *Benyon*, (*y*) Lord Chief Justice *Dallas* said, with respect to the specification of an invention, that if there be any departure in terms from the *patent, the whole is void; it must be commensurate with the patent itself. And in the same case, Mr. Justice *Burrough* said, that it is clear that the specification must cover and support the patent.

[*161]

2. The patentee must in his specification make a full and complete disclosure of the nature of his invention, and of the manner in which it is to be performed.

In the case of *The King* v. *Arkwright*, (*z*) Mr. Justice *Buller* said, that the public have a right to a fair, full, and true description of the invention in the specification.

So also in the case of *Turner* v. *Winter*, (*a*) Mr. Justice *Ashurst* said, that it is incumbent on a patentee to give a specification of his invention in the clearest and most unequivocal terms of which the subject is capable. And his Lordship added, that "It is certainly of consequence that the terms of the specification should express the invention in the clearest and most explicit manner." And in the same case, (*b*) Mr. Justice *Buller* said, "Many cases upon patents have arisen within our memory, most of which have been decided against the patentees, upon the ground of their not having made a full and fair discovery of their inventions. *Whenever it appears that the patentee has made a fair disclosure*, I have always had a strong bias in his favour, because in that case he is entitled to the protection which the law gives him."

In the case of *Lewis* v. *Marling*, (*c*) Mr. Justice *Bayley* said, that in order to support a patent, it is necessary that the specification should make a full disclosure to the public; but if he makes a full and fair disclosure, *as far as his knowledge at the time extends*, he has done all that is required.

So also in the case of *Morgan* v. *Seaward*, (*d*) Mr. Baron *Alderson* laid it down, that the public have a right to expect and require that the specification shall be fair, honest, open, and sufficient, and contain a full description of the way in which the invention is to be carried into effect. And his Lordship told the jury that the question respecting the specification was, whether upon the whole evidence they were of *opinion that the specification did fairly and fully give to the public that information which the public were entitled to receive.

[*162]

3. The specification must be intelligible, so that every person may be able to understand it, and learn from a perusal of it, what the art or invention is to which the patent is intended to apply. It must also describe the invention accurately so that no person shall be deceived or misled, and if the invention consists of several parts, it must contain a sufficient and correct description of every part.

In the case of *Hill* v. *Thompson*, (*e*) Lord *Eldon*, L. C., laid it down that

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(*y*) 6 B. Mo. 82.
(*a*) Dav. P. C. 151
(*c*) 10 B. & C. 22; 1 Webs. R. 496.
(*e*) 3 Mer. 626; 1 Webs. R. 237, S. C.
(*z*) Dav. P. C. 61.
(*b*) Ibid. 153.
(*d*) 1 Webs. R. 174, 179.

a specification must be intelligible, and clearly express what the patentee claims as his invention.

In the case of *Turner* v. *Winter*, (*f*) it appeared that fusion was necessary to one part of the patent process. The specification directed heat to be continued until the effect was produced; but although it spoke of calcination, it did not mention fusion, and Mr. Justice *Buller* held that the omission rendered the specification insufficient.

In the case of *Campion* v. *Benyon*, (*g*) Lord Chief Justice *Dallas* said, with respect to the specification, that it must contain a full and accurate explanation how the invention is to be carried into effect. And in the same case, Mr. Justice *Park* said, that in the specification of a patent, the nature of the invention must be accurately and particularly described, and *the statement of the claims* of the patentee must be set forth in the most minute detail.

In the case of *Morgan* v. *Seaward*, (*h*) Mr. Baron *Alderson* said, that if either of the patentees' inventions (there were two comprised in the patent) was insufficiently specified, the patent would fail; for if a person runs the hazard of putting two inventions into one patent, he cannot hold his patent unless each can be supported as a separate patent. And in order to support the patent, each invention must be described in the specification in such a manner as to enable people clearly to know what the invention is, and how it is to be carried into effect.

*So in the case of *Jones* v. *Ripley*, (*i*) Lord *Denman*, C. J., held that if a specification be silent as to part of an invention stated [*163] in the title, or as to any part of the invention which is essential, the plaintiff will be nonsuited.

But in the case of *Nickels* v. *Haslam*, (*k*) in which the invention was intituled "improvements in the manufacture of plated articles," and the specification described one improvement only, the Court of Common Pleas held that the specification was sufficient. (*l*)

4. In making the claim of invention, the specification must accurately point out what is claimed, and if the claim be wrong, the patent cannot be sustained, although the specification describes (without claiming) what the patentee really invented.

Thus, in the case of *Sanders* v. *Aston*, (*m*) it appeared that the patent was for "improvements in constructing or making buttons." The specification claimed the invention to be an improvement (upon a prior invention of the plaintiffs) by substituting flexible for metal shanks to buttons. The substitution of flexible for metal shanks, however, was not new, and therefore not sufficient to support the patent. The specification described the application of a toothed collet in the production of the flexible shanks in a particular way, which was new; but it did not any where appear in the specification that the patentee relied upon the collet as a material part of his invention, and there were other modes in which the object of the invention could be accomplished. The Court of King's Bench held that as the patentee had not claimed the use of the particular mode of substituting the flexible shank by means of the toothed collet, the patent was void.

So in the case of *The King* v. *Cutler*, (*n*) it appeared that the defendant's patent, (of January, 1815) was for an invention of "improvements applicable

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(*f*) Dav. P. C. 154. (*g*) 6 B. Mo. 82, 83.
(*h*) 1 Webs. R. 173.
(*i*) 2 Rep. Arts. 150, N. S.; 5 L. Jour. C. S. 35; Webs. P. L. 137, (108*).
(*k*) 8 Jur. 474.
(*l*) See Bainbridge v. Wigley, Rep. Pat. 1829; Appendix, p. 197; 18 Rep. Arts. 127.
(*m*) 3 B. & Ad. 881. (*n*) 1 Stark. R. 354.

to fire-places, stoves," &c. (*o*) It appeared, also, from the specification, that the invention consisted of a new mode of feeding the fire in a grate by a supply of fuel from below, instead of from above in the usual way. [*164] The *coals intended to be consumed in the course of the day were to be deposited in a chamber beneath the grate, so placed, that the higher surface of the chamber was to be on a level with the lower surface of the grate. The fire being afterwards lighted in the grate, as the coals in the grate were gradually consumed, their place was to be supplied by winding up the coals from the chamber by means of a rack and pinion. The coals, as long as they remained in the box, were unignited, the air being excluded from below, and they did not become ignited until, by being wound up into the grate, they had been brought into contact with the coals previously ignited, and exposed to the access of the air. The defendant, in his specification, summed up his claim thus: "My invention consists in this, that the fuel necessary for supplying the fire shall be introduced at the lower part of the grate in a perpendicular, or in an oblique direction. As to the manner of performing it, it is set forth in the annexed descriptions and drawings." Before the date of the patent, a grate had been made for cooking, which was furnished with a door; when this door was open, the grate in no respect differed from an ordinary one, (*p*) but when the door was shut, no part of the grate was visible except a few of the highest bars; and the whole of the grate having been filled with coals, and the coals within the bars above the door having been lighted, the coals in the lower part of the grate were carried up for the purpose of supplying the consumption above by means of a rack and pinion, at the discretion of the cook. The principle of this grate, it was contended, was precisely the same with that for which the patent was claimed; the lower part of the grate when the door was shut being in effect a closed chamber to which the air had no access, and the coals being gradually wound up from this chamber so as to afford a supply to the fire above. The same principle had been applied to a common grate long before the date of the patent. It was contended for the defendant that his invention went beyond that exhibited in these grates; in the latter there was no fresh introduction of fuel into the grate, so as to give a perpetual supply, there was nothing more than a means of contracting or compressing coals [*165] already *within the grate, which could not be done without gradually diminishing the size of the grate itself. According to the defendant's construction, on the contrary, the chamber was independent of the grate, placed below it, and the fuel was gradually wound up from the chamber, without at all contracting the size of the grate itself. Lord *Ellenborough*, C. J., was of opinion that "The principle on which the two grates were constructed, was *identical with that described in the terms of the specification*, which was for a mode of supplying fuel from below, and there was nothing predicated in the specification of raising the fuel from below the grate; it was merely for elevating a supply of fuel from below, and that the defendant had confined himself, by thus summing up the extent of his invention, to the benefit of this principle."

5. The language of a specification must not be ambiguous; but must be as clear and precise as the nature of the subject will admit.

Thus in the case of *Turner* v. *Winter*, (*q*) Mr. Justice *Ashurst* said, that it is incumbent on a patentee to give a specification of his invention in the clearest and most unequivocal terms of which the subject is capable. And that if there is any unnecessary ambiguity affectedly introduced into the specifica-

(*o*) See Pritchard's list of patents, p. 103, No. 1405.
(*p*) The grate must have been *deeper* than ordinary grates.
(*q*) Dav. P. C. 151.

tion, the patent is void. And in the case of *Campion* v. *Benyon*, (*r*) Lord Chief Justice *Dallas* expressed himself nearly to the same effect.

So in the case of *Galloway* v. *Bleaden*, (*s*) the Lord Chief Justice *Tindal* said, that if there is a want of clearness in a specification so that the public cannot afterwards avail themselves of, much more if there is any studied ambiguity in it, so as to conceal from the public that which the patentee for a term is enjoying the exclusive benefit of, the patent itself would be completely void.

6. When an inventor applies for his patent, he describes the nature of his invention in general terms, and it is to be presumed, in the absence of any thing to show the contrary, that he has contracted to give the public the whole of his discovery, and all his knowledge on the subject, as the consideration for the privilege granted to him by the Crown. It is indeed *absolutely essential for the protection of the public, that this rule should be [*166] adopted and acted upon, for patentees would otherwise be enabled to commit great frauds, by concealing the most important parts of their inventions.

The specification must therefore describe the invention according to the best of the patentee's knowledge.

Thus in the case of *The King* v. *Arkwright*, (*t*) Mr. Justice *Buller* said, that a specification must put the public in possession of the invention in as ample and beneficial a way as the patentee himself uses it. So in the case of *Turner* v. *Winter*, (*u*) the same learned Judge said, that if the patentee makes the article for which the patent is granted, with cheaper materials than those which he has enumerated in his specification, although the latter will answer the purpose equally well, the patent is void because he does not put the public in possession of his invention, or enable them to derive the same benefit which he does himself.

And in the case of *Bovill* v. *Moore*, (*x*) Lord Chief Justice *Gibbs* said, "There is another consideration respecting the specification which is also a material one, and that is, whether the patentee has given a full specification of his invention, not only one that will enable a workman to construct a machine answering to the patent, but one that will enable a workman to construct a machine answerable to the patent *to the extent most beneficial within the knowledge of the patentee at the time;* for a patentee who has invented a machine useful to the public, and can construct it in one way more extensive in its benefit than another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it, although he will have so far answered the patent as to describe in his specification a machine to which the patent extends; yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of for exercising the privilege granted to him."

And in the case of *Morgan* v. *Seaward*, (*y*) Mr. Baron *Alderson* said, that if a patentee is acquainted with any particular mode by which his invention may be most conveniently *carried into effect, he ought to state it [*167] in his specification.

7. And if the patentee omits or conceals any material part of the invention, or anything which he knows to be useful, the specification will not be sufficient.

Thus, in the case of *Liardet* v. *Johnson*, (*z*) which was an action for infringing a patent for steel trusses, the patentee omitted what was very material for tempering the steel, which was rubbing it with tallow. And because this was omitted the specification was held to be insufficient, and the patent was avoided.

(*r*) 6 B. Mo. 81.
(*s*) 1 Webs. R. 524.
(*t*) Dav. P. C. 106.
(*u*) Ibid. 154.
(*x*) Dav. P. C. 400; 2 Marsh. 211.
(*y*) 1 Webs. R. 174.
(*z*) Buller, N. P. 76; Dav. P. C. 155.

So in the case of *Neilson* v. *Harford*, (*a*) Mr. Baron *Parke* told the jury that if they thought the patentee knew that partitions were useful (in their blowing apparatus which he had invented,) and omitted to state that in the specification, that would make the specification void. His Lordship also said, that if the partitions were necessary to make the apparatus operate beneficially, in that case the patent would be void, because it was not introduced as a necessary circumstance into the specification. And that if the patentee had known that the tubular form (of a part of the apparatus) would answer best, he ought to have introduced it, and the specification would have been bad upon the ground that he concealed the best mode of working out his own discovery.

The case of *Wood* v. *Zimmer*, (*b*) was an issue out of Chancery to try the validity of a patent granted to Jacob Zinck, in which the invention was described as a method of manufacturing verdigrease. The specification stated it to be produced from certain proportions of granulated copper and oil of vitriol, boiled a certain time in a copper of a particular construction (which was described,) and afterwards strained off and mixed with a solution of potash or soda. It appeared, however, that Zinck was accustomed clandestinely and unobserved by his workmen to put aquafortis into the boiler, by means of which the copper was dissolved more rapidly, but the specification did not mention aquafortis in any way whatever.

Lord Chief Justice *Gibbs* said, "A man who applies for a patent, and possesses a mode of carrying on that invention in *the most beneficial [*168] manner, must disclose the means of producing it in equal perfection, and with as little expense and labour as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same way, and with the same advantages. If any thing which gives an advantageous operation to the thing invented be concealed, the specification is void. Now, though the specification should enable a person to make verdigrease substantially as good without aquafortis as with it; still, inasmuch as it would be made with more labour by the omission of aquafortis, it is a prejudicial concealment, and a breach of the terms which the patentee makes with the public." And the jury having found that aquafortis was used by the inventor as an ingredient in the verdigrease, his Lordship held that the patent was void.

So also in the case of *Bovill* v. *Moore*, (*c*) already cited, Lord Chief Justice *Gibbs* held, that if at the time when the patentee obtained his patent he was apprized of a more beneficial mode of working his invention, and did not by his specification communicate it to the public, that would be a fraudulent concealment from the public, and would render his patent void. And his Lordship told the jury, that if they thought that the patentee had studiously kept it back from the public, in order that he might have an advantage over others, that would be a suppression that would avoid his patent.

In the case of *Lewis* v. *Marling*, (*d*) Mr. Justice *Bayley* said, that if a patentee suppresses any thing, or if he does not communicate all he knows, his specification is bad.

And in *Morgan* v. *Seaward*, (*e*) Mr. Baron *Alderson* also held, that a patentee ought to give to the public all the knowledge he himself has respecting his invention.

8. And the rule that a patentee must give the public the benefit of all his knowledge respecting his invention, has been carried so far, that in the case of *Crossley* v. *Beverley*, (*f*) it was laid down that he must give to the public all

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(*a*) 1 Webs. R. 321, 322.
(*b*) Holt, N. P. C. 58.
(*c*) Dav. P. C. 401; 2 Marsh. 211, S. C.
(*d*) 10 B. & C. 22; 1 Webs. R. 496.
(*e*) 1 Webs. R. 182.
(*f*) 9 B. & C. 63.

improvements which he may invent after obtaining his patent, and before the enrolment of his specification. In that case the *invention was of "an improved gas apparatus," and it appeared that between the [*169] date of the patent and the specification, the patentee invented improvements in the apparatus which he described in the specification as part of his invention. The improvements clearly came within the meaning of the title contained in the patent, and all formed part of the same apparatus, the effect being in fact more completely to carry into effect the object which the patentee had in view when he made his invention. It was objected, that the patent was void by reason of the patentee having inserted improvements in his specification which formed no part of the invention for which he had obtained his patent. The Court of King's Bench, however, held, that the insertion of these improvements in the specification not only did not render the patent void, but that it was the duty of the patentee to communicate them to the public. Lord *Tenterden*, C. J., said, in giving judgment, "I do not see myself why time is allowed to prepare the specification, except upon the idea that the person, at the time he took out his patent, has not brought his machine, or whatever he has invented, to that degree of perfection which it may be supposed he is capable of bringing it to, and therefore he is allowed further time to do it." And Mr. Justice *Bayley* said, "I think it is most beneficial to the public to say, that it is the duty of the inventor, if, between the period of taking out the patent and enrolling the specification, he makes discoveries which will enable it better to effectuate the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and that it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he has obtained before the specification."

So also in the case of *Jones* v. *Heaton*, (*g*) Lord Chief Justice *Tindal* held, that a patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification.

9. Every thing necessary to the working of the invention must *be described, for if that be not done, the specification will not [*170] particularly ascertain the manner in which it is to be performed, as required by the proviso in the patent. The patentee must therefore give the public every information which is necessary to enable them completely to perform every part of the patent process which is new, although it may be sufficient to refer in general terms to such things as are old or well known.

In the case of *De Rosne* v. *Fairie*, (*h*) it appeared that the plaintiff's patent was for an invention intituled "improvements in extracting sugar or syrups from cane juice, and other substances containing sugar, and in refining sugar and other syrups. The specification stated the invention to consist in a means of discolouring (depriving of colour) syrups of every description by means of charcoal produced by the distillation of bituminous schistus alone, or mixed with animal charcoal, and even of animal charcoal alone; the charcoal to be disposed of on beds very thick on a filter of any suitable form. After describing the process, the patentee in the specification said, "The carbonization of bituminous schistus has nothing particular, it is produced in close vessels, as is done for producing animal charcoal; only it is convenient, before the carbonization, to separate from the bituminous schistus the sulphurets of iron which are mixed with it." But the patentee did not describe any mode by which the sulphurets of iron could be separated from bituminous schistus. It did not

(*g*) 11 Lon. J. C. S.; Webs. P. L. 137, (129.)
(*h*) 5 Tyr. 393.

appear clear upon the evidence whether bituminous schistus was or was not capable of being purified from the sulphurets of iron with which it is mixed, so that it should not be prejudicial to the sugar by colouring it in the course of the operation. The defendant objected to the sufficiency of the specification, because it did not show in what manner bituminous schistus could be purified from iron. Lord *Abinger*, C. B., directed the jury to find a verdict for the plaintiff or defendant according as they found the description of the bituminous schistus to be sufficient, or insufficient, so that all the world could or could not use it. The jury gave a verdict for the plaintiff, but the Court of Exchequer set it aside, and granted a new trial. *Lord *Abinger* in giving judgment, said that his impression at the trial was strong that there [*171] was no evidence to go to the jury in support of the patent, and that it was incumbent on the plaintiff to show either that there was some bituminous schistus found in this country, which after having been exposed to the process of distillation described in the specification, might be used with effect, and without detriment to the sugar, though one of its component parts, iron, was not entirely removed from it; or that there was some known process of removing that iron from it. It appeared by the evidence that in all the various forms in which the article (bituminous schistus) exists in this country, sulphuret of iron is found; and the witnesses not describing any known process by which it could be extracted, his Lordship was of opinion that the plaintiff ought to have proved one of two things, either that the sulphuret of iron in bituminous schistus is not so absolutely detrimental as to make its presence disadvantageous to the process, (in which case the patent would be good,) or that the process of extracting the iron from it is so simple and known, that a practical man would be able to accomplish it with ease. And his Lordship added, that as the plaintiff had not given any evidence to show that bituminous schistus, in the state in which it is found and known in England, could be used in the process with advantage, the defendant was entitled to a nonsuit.

The rest of the Court (Mr. Baron *Parke*, Mr. Baron *Bolland*, and Mr. Baron *Alderson*) entirely agreed with the Lord Chief Baron; and Mr. Baron *Alderson* added, that if it had been shown that bituminous schistus, deprived of iron, could be made by a process known to ordinary chemists of skill, or that it was a substance capable of being ordinarily purchased in the market as an article of commerce, it would have been unnecessary to have shown (in the specification) the operation of separating the iron from it.

So in the case of *Macnamara* v. *Hulse*, (*i*) Lord *Abinger*, C. B., was of opinion that the specification was bad, because it did not mention the angles at which the patentee's paving blocks were to be cut according to his invention.

And in the case of *Neilson* v. *Harford*, (*k*) Mr. Baron **Parke* laid down as law, in his charge to the jury, that if the patentee [*172] had omitted to make mention, in his specification, of anything which was necessary for the beneficial use or enjoyment of the invention, the specification would be bad.

10. When a patent is obtained for an improved machine or other article, it seems to be unnecessary minutely to describe all the known parts of the old machine. In case of *Harmar* v. *Playne*, (*l*) Lord *Ellenborough*, C. J., said, "It may not be necessary in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement; but on many occasions it may be sufficient to refer generally to them. As in the instance of a common watch, it may be

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(*i*) Car. & Marsh. 478.
(*k*) 1 Webs. R. 317, 321.
(*l*) Dav. P. C. 318.

sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them."

11. The specification must be sufficient to enable persons not only to understand the nature of the invention, but also to put it into successful practice.

Thus in the case of *Newberry* v. *James*, (*m*) Lord *Eldon*, L. C., said, that in order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the term for which it has been granted is at an end. So it was laid down in *Liardet* v. *Johnson*, (*n*) that the question respecting a specification is, whether it is sufficient to enable others to make the patent article, for the meaning of the specification is, that others may be taught to do the thing for which the patent is granted, so that after the term, the public shall have the benefit of the discovery.

In the case of *The King* v. *Arkwright*, (*o*) Mr. Justice *Buller* said, that "It is clearly settled as law, that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret and specify his invention in such a way that others may be taught to do the thing for which the patent is granted; for the end and meaning of the specification is to teach the public, after the term for which the patent is granted, what the art is."

And in the case of *Morgan* v. *Seaward*, (*p*) Mr. Baron **Alderson* said, that the invention must be described in the specification [*173] in such a manner as to lead people clearly to know what the invention is, and how it is to be carried into effect.

In the case of *Bovill* v. *Moore*, (*q*) Lord Chief Justice *Gibbs* said, that a patentee ought in his specification to describe the mode of the manufacture, so as to enable any person to make use of it after his term has expired.

And in the case of *Galloway* v. *Bleaden*, (*r*) Lord Chief Justice *Tindal* laid it down, that if there was a want of clearness in the specification, so that the public could not afterwards avail themselves of the invention, the patent would be completely void.

12. The specification must be understood as addressed to persons of ordinary skill and ordinary knowledge of that branch of the useful arts to which the invention relates.

Thus in the case of *Morgan* v. *Seaward*, (*s*) Mr. Baron *Alderson* said to the jury in summing up, "A specification is addressed to all the world; and therefore all those possessed of a competent skill ought to be able to construct the machine by following the specification. The specification should be such as to enable a workman of *ordinary* skill to make the machine." And the learned Judge afterwards added, (*t*) that the question respecting the specification was, whether a man of ordinary knowledge and skill, bringing that ordinary knowledge and skill to bear upon the subject, would be able to make the patent machine from the instructions contained in the specification.

And in the case of *Neilson* v. *Harford*, (*u*) Mr. Baron *Parke* said, in summing up to the jury, that if a person of ordinary and competent skill would be enabled by the specification to erect the patent machine, the specification would be good. And the learned Judge went on to say, that the jury were not to ask themselves the question, whether persons of great skill—a first-rate engineer or a second-class engineer—whether they could do it; because generally those persons are men of great science and philosophical knowledge, and

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(*m*) 2 Mer. 451.
(*n*) Bull. N. P. 76.
(*o*) Dav. P. C. 106.
(*p*) 1 Webs. R. 173.
(*q*) Dav. P. C. 361.
(*r*) 1 Webs. R. 524.
(*s*) 1 Webs. R. 176.
(*t*) Ibid. 178.
(*u*) Ibid. 314–322.

[*174] they *would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom a specification may be supposed to be addressed; it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge, and the ordinary degree of capacity, to the subject; and if such a person would construct an apparatus that would answer some beneficial purpose, according to the terms of the specification, then the specification is good, and the patent may be supported.

And in *Elliott* v. *Aston*, (*x*) Mr. Justice *Coltman*, speaking of the specification, said, that the question was, whether the patentee had given such a description in his specification as would enable a workman of competent skill to carry the invention into effect.

And in the case of *Manton* v. *Manton*, (*y*) Lord Chief Justice *Gibbs* said, that it was necessary that the patentee should show that he had accurately explained the nature of his invention in his specification, so as to enable a person of tolerable skill to make the thing by means of his specification.

In the case of *Brooks and another* v. *Ripley and another*, (*z*) Lord *Lyndhurst*, C. B., said, that if the specification was not sufficiently clear to be understood by an ordinary workman, witnesses will not be allowed to be called to explain the intention of the patentees, and the plaintiffs will be nonsuited.

13. But it is not necessary that a specification should describe an invention, and the manner in which it is to be performed, so fully as to instruct persons wholly ignorant of the subject.

Thus, in the case of *Arkwright* v. *Nightingale*, (*a*) Lord *Loughborough* said, that a specification is addressed to persons having skill in the subject, not to men of ignorance; and if it is understood by those whose business leads them to be conversant in such subjects, it is sufficient.

In the case of *The King* v. *Arkwright*, (*b*) Mr. Justice *Buller* said, that if the specification be such that *mechanical men* of common understanding can comprehend it to make a machine by it, it is sufficient; but then it must be

[*175] such, that *mechanics may be able to make the machine by following the directions of the specification.

In the case of *Hornblower* v. *Boulton*, (*c*) Mr. Justice *Grose* said, that if the specification be such as to enable *artists* to adopt the invention, and make the manufacture, it is sufficient.

In the case of *Huddart* v. *Grimshaw*, (*d*) Lord *Ellenborough*, C. J., said, that the specification must convey to the public a corresponding advantage with that of the patentee, whose sole right is protected for a time, so that any person who is skilled in the subject, upon looking at the specification, may be able to accomplish the end.

In the case of *Harmar* v. *Playne*, (*e*) Lord *Ellenborough*, C. J., said, that the object of requiring a specification to be enrolled, seemed to be to enable persons of reasonable intelligence and skill in the subject-matter to tell, from the inspection of the specification itself, what the invention was for which the patent was granted, and how it was to be executed. And also, that when Lord *Mansfield* said (in the case of *Liardet* v. *Johnson*, (*f*)) that the meaning of the specification was, that others might be taught to do the thing for which the patent was granted, it must be understood to enable persons of reasonably com-

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(*x*) 1 Webs. R. 224.
(*y*) Dav. P. C. 349.
(*z*) 2 Lon. J. C. S. 35; Webs. P. L. 134 (102.)
(*a*) Dav. P. C. 56.
(*b*) Ibid. 106.
(*c*) Dav. P. C. 228.
(*d*) Ibid. 279.
(*e*) Ibid. 316.
(*f*) Bull. N. P. 76.

petent skill in such matters to make it; for no specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch. And his Lordship afterwards said, that a person must carry a reasonable knowledge of the subject-matter with him, in order clearly to comprehend specifications of inventions though intended to be fairly made.

So also, in the case of *Rowntree* v. ———, (*g*) before Lord *Eldon*, which was an action for infringing a patent for a method of applying fire for heating boilers, &c., the patent was held to be void, because the jury was of opinion that the specification was not sufficiently clear to enable an ordinary tradesman to put the invention in practice.

In the case of *Morgan* v. *Seaward*, (*h*) Mr. Baron *Alderson* said, in his charge to the jury, that a specification ought to *be framed so as not to call on a person to have recourse to more than those ordinary [*176] means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. You may call upon a man to exercise all the actual existing knowledge common to the trade, but you cannot call upon him to exercise any thing more.

So in the case of *Bickford* v. *Skewes*, (*i*) Lord *Denman*, C. J., said, in delivering the judgment of the Court of Queen's Bench, the specification is addressed, not to persons entirely ignorant of the subject matter, but to artists of competent skill in that branch of manufactures to which it relates.

14. And a specification must be sufficient to enable persons of ordinary skill to use the invention *without any new inventions or additions of their own, or any assistance from others.*

Thus, in the case of *The King* v. *Arkwright*, (*k*) Mr. Justice *Buller* laid it down as law, that the specification ought to be such that mechanics might be able to make the (patent) machine, by following the directions of the specification without any new inventions or additions of their own; and this was strongly approved of by Mr. Baron *Alderson*, in the case of *Morgan* v. *Seaward*, (*l*) in which his Lordship said, that the public ought to be told the manner in which the thing may be done in respect of which the patent is granted, not by themselves becoming inventors of a method of carrying it into effect, but by following the specification, without making any new invention, or any addition to the specification.

Mr. Baron *Alderson* also held, in *Morgan* v. *Seaward*, that the specification ought to be sufficient to enable workmen of ordinary and competent skill and knowledge to use the patent invention without any other instructions. And that, in judging of the sufficiency of the specification, the criterion is, whether *at the time when the specification is given to the world* a person would be able by means of it and his ordinary knowledge and skill, to use the invention without deriving information from any other source.

And in the case of *Neilson* v. *Harford*, (*m*) the Court of Exchequer held, that to be valid, a specification should be *such as if fairly followed out by a competent workman without invention or addition, would [*177] produce the article for which the patent is taken out.

15. The specification must not cast upon the public the trouble of making experiments to enable them to use the invention; nor will it be sufficient if it merely suggest something as likely to be useful. The representation of the patentee to the Crown that he had made an invention must be taken to mean, that he had made a complete invention; and it therefore was his duty to give

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(*g*) Parl. Rep. 192.
(*h*) 1 Webs. R. 174.
(*i*) 1 Webs. R. 218.
(*k*) Dav. P. C. 106.
(*l*) 1 Webs. R. 173, 174.
(*m*) 1 Webs. R. 371; 8 M. & W. 806.

the public such complete information as would render it unnecessary for them to make experiments to enable them to carry the invention into effect.

Thus, in the case of *Turner* v. *Winter*, (*n*) Mr. Justice *Ashurst* said, that the terms of the specification should express the invention in the clearest and most explicit manner; so that a man of science may be able to produce the thing intended without the necessity of trying experiments.

In the case of *Morgan* v. *Seaward*, Mr. Baron *Alderson* held, that if a specification does not give such information as will render it unnecessary for parties to make experiments, it is insufficient. (*o*) And his Lordship also said, that a specification must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect so as to save a party the trouble of making experiments and trials. (*p*)

So in the case of *Neilson* v. *Harford*, (*q*) Mr. Baron *Parke* told the jury, that if experiments were necessary in order to enable a person to construct the patent machine, the specification was defective. But if experiments are only necessary in order to produce the greatest beneficial effect, the specification would not for that reason be insufficient. (*r*)

In the case of *Crompton* v. *Ibbotson*, (*s*) Lord *Tenterden*, C. J., said, "The patent was obtained for the discovery of a proper conducting medium. The plaintiff found, after repeated trials, that nothing would serve the purpose except *the cloth described in his specification; yet he says the cloth may be made of any suitable material, and merely that he prefers the particular kind there mentioned. *Other persons, misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail;* and the public, therefore, has not the full and entire benefit of the invention,—the only ground on which the patent is obtained."

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16. It has already been shown in a former part of this work, (*t*) that a false representation or suggestion to the Crown of anything material respecting the invention will render the patent void by reason of the fraud practised upon the Crown. And as against the patentee it must be presumed that when he applied for the patent, he made the same statements to the Crown as those contained in the specification. And if a specification be false or untrue in any material particular, or if it be framed so as to mislead or puzzle, the patent will be void. The patent being a bargain between the public and the patentee, the specification is the price which he pays for the privilege granted to him in his invention. And if he inserts anything in his specification which is untrue, or calculated to mislead or puzzle, he commits a breach of good faith, and the specification being a fraud upon the public the patent is void.

Thus in the case of *The King* v. *Arkwright*, Mr. Justice *Buller* said, in his charge to the jury, that if the specification in any part of it was materially false or defective, the patent could not be supported. (*u*) His Lordship also held, that if certain things mentioned in the specification were of no use, and merely thrown in to puzzle, the patent was void. (*x*)

In the case of *Turner* v. *Winter*, (*y*) Mr. Justice *Ashurst* said, that if there was anything in the specification which tended to mislead the public, or if the process as directed by the specification did not produce that which the patent professes to do, the patent was void. And in the same case Mr. Justice *Buller*

(*n*) Dav. P. C. 152.
(*o*) 1 Webs. R. 180.
(*p*) Ibid. 175.
(*q*) Ibid. 320, 326.
(*r*) See also Macnamara v. Hulse, Car. & Marsh. 477.
(*s*) Dan. & Lloyd, 33.
(*t*) *Ante*, Chap. IV. p. 42.
(*u*) Dav. P. C. 106.
(*x*) Ibid. 118.
(*y*) Ibid. 151, 152.

said, (*z*) that if the patentee could only make the patent article with two or three of the ingredients mentioned in the specification, and if he had inserted others which *would not answer the purpose, that would avoid the patent. (*a*) The same law was laid down by the Court of Queen's Bench in the case of *Bickford* v. *Skewes*. (*b*) [*179]

In the case of *Lewis* v. *Marling*, Lord *Tenterden*, C. J., said, (*c*) that if a patentee mentions that as an essential ingredient in the patent article which is not so, nor even useful, and whereby he misleads the public, his patent might be void; and indeed there can be little doubt that it would be so. And in the same case, Mr. Justice *Bayley* said, (*d*) that if a patentee by his specification misleads the public, his specification is void. So if he says that there are many modes of doing a thing, when in fact one only will do, this will avoid the patent.

In the case of *Neilson* v. *Harford*, (*e*) Mr. Baron *Parke* held at Nisi Prius that a material statement in the specification being incorrect or untrue would avoid the patent. And in the same case, (*f*) the Court of Exchequer held that a specification would be bad which contains a false statement in a material circumstance, of a nature that if literally acted upon by a competent workman would mislead him, and cause the experiment to fail.

In the case of *Savory* v. *Price*, (*g*) it appeared that the patent was for an invention of a neutral salt, which is called seidletz powder. The new salt or medicine was composed of three ingredients: 1st, Rochelle salts; 2nd, Carbonate of soda; and 3rd, Tartaric acid. These ingredients were well known substances before the date of the patent, but the patentee, instead of describing them by any of their known names, inserted in his specification three recipes numbered 1, 2, and 3, the produce of which respectively were the three substances already mentioned. The specification then described the modes and proportions in which the three ingredients produced by the three recipes were to be mixed together in order to produce the "seidletz powder;" and it was proved that the mixture answered the purpose stated by the patentee. Lord Chief Justice *Abbott*, however, held that the *patent was void, and said, "It is the duty of any one to whom a patent is granted to point out in his specification the plainest and most easy way of producing that for which he claims a monopoly; and to make the public acquainted with the mode which he himself adopts. If a person on reading the specification would be led to suppose a laborious process necessary to the production of any one of the ingredients, when in fact, he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or of any one of them, may be bought in shops, this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported." (*h*) [*180]

17. Although the condition which requires the specification makes it necessary that it should describe the invention with particularity, it seems that it is not necessary that the specification should particularize every thing which will produce the effect intended by the patentee.

Thus, in the case of *Bickford* v. *Skewes*, (*i*) the Court of Queen's Bench held, that it was immaterial if other materials not specified, but within the

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(*z*) Ibid. 154.
(*a*) See also Crompton v. Ibbotson, Dan. & Lloyd, 33, cited *ante*, p. 177.
(*b*) 1 Webs. R. 218; 1 Q. B. 938.
(*c*) Ibid. 495.
(*d*) Ibid. 496.
(*e*) 1 Webs. R. 295.
(*f*) 8 M. & W. 806.
(*g*) Ry. & Mo. N. P. C. 1.
(*h*) See also Crompton v. Ibbotson, Dan. & Lloyd, 33, cited *ante*, p. 177.
(*i*) 1 Webs. R. 218; 1 Q. B. 938.

description given in the specification, would answer the purpose, and that it was certainly not necessary to specify all articles that would answer the purpose.

But in the case of *De Rosne* v. *Fairrie*, (*k*) Mr. Baron *Alderson* said, that a specification must state one or more methods which can be followed for the purpose of accomplishing and carrying into effect the invention.

18. The particular form of a machine or patent article need not be described, if the shape does not form an essential part of the invention.

Thus in the case of *Neilson* v. *Harford*, (*l*) the patentee stated, that the shape of the vessel in which the air was to be heated was immaterial, and the Court of Exchequer held that the specification was sufficient.

19. It seems that things necessarily implied need not be particularized in the specification.

[*181] *Thus, in the case of *Boulton* v. *Bull*, (*m*) Lord Chief Justice *Eyre* said, "Suppose a new invented chemical process, and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, it would be necessary, in order to this operation, that the gold should be put into a crucible, and should be melted in that crucible; but it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold into a state of fusion was to be performed. They are mere incidents with which every man acquainted with the subject is familiar."

In the case of *Crossley* v. *Beverley*, (*n*) the patent was for an invention of "an improved gas apparatus." It appeared from the evidence that the specification did not give any directions respecting a condenser, which was well known to be an essential part of every gas apparatus. It was objected for the defendant, that the things comprised in the specification would not make a gas apparatus, because it would be incomplete for want of a condenser. Lord *Tenterden*, C. J., said, that a workman who was capable of making a gas apparatus would know that he must put that in. And his Lordship held, that although the specification did not direct a condenser to be put in, yet, as it did not say that it was to be left out, the specification was sufficient.

20. Although a specification must describe an invention with sufficient precision to make it a compliance with the condition in the patent, yet it seems that absolute or perfect precision is not practicable, and cannot therefore be required.

Thus, in *Boulton* v. *Bull*, (*o*) Lord Chief Justice *Eyre*, after observing as to the specification in that case that more precision was not necessary, said that absolute precision was not practicable.

In the case of *Arkwright* v. *Nightingale*, (*p*) Lord *Loughborough* said, that "the clearness of the specification must be *according to the subject-matter of it*," and if it is understood by those whose business leads them to be conversant in such subjects, it is sufficient.

[*182] *21. There must be no misdescription of the invention, or of any part of it. And if any part of the invention is misdescribed in any material particular, the specification will be bad.

In the case of *The King* v. *Metcalfe*, (*q*) the patent was obtained for the manufacture of hair brushes, which were described to be tapering brushes. (*r*)

(*k*) 5 Tyr. 407.
(*l*) 1 Webs. R. 295–328.
(*m*) Dav. P. C. 215.
(*n*) 3 C. & P. 515.
(*o*) Dav. P. C. 216.
(*p*) Dav. P. C. 56.
(*q*) 2 Stark. R. 249.
(*r*) The patent described the invention to be of "a tapered hair or head brush."—Pritchard's List of Patents, No. 1592, p. 115.

It appeared from the specification that the mode of manufacturing the patent brushes differed from the common mode, chiefly in this respect: that the specification directed, that the hairs or bristles were to be taken of the length of an inch and a quarter, and before their insertion in the holes in the stock of the brush, were to be mixed up together; so that when they were collected and drawn through the holes, and secured by a brass wire, the bristles would be of unequal lengths; whereas, according to the usual mode, the bristles were to be inserted in the stock, so as to be as nearly of the same length as possible, and were afterwards cut down, so as to be of the same length. Lord *Ellenborough*, C. J. held, that the invention was not properly described, and said, "Tapering means gradually converging to a point. According to the specification, the bristles would be of unequal length, but there would be no tapering to a point, which the description assumes." It was contended for the defendant, that the description was sufficient, as each tuft of hairs converged to a point, and the brushes were known in the trade by the description of tapering brushes. Lord *Ellenborough* said, "If the word tapering be used in its general sense, the description is defective; there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be received in its perverted sense. At present, however, I cannot hold out any prospect that the difficulty arising from the grammatical construction can be removed." The defendant having failed to give any evidence to remove the difficulty, Lord *Ellenborough* advised the jury to find that the brush was not a tapering, but only an unequal brush, and there was a verdict for the Crown accordingly. The defendant *afterwards moved the Court of King's Bench for a new trial on this point, but the Court refused even to grant a rule *nisi*. [*183]

In the case of *Felton* v. *Greaves*, (*s*) it appeared that the patent had been obtained for an invention of a machine for sharpening knives, razors, scissors, and other cutting instruments. The machine described in the specification was proved to be useful for sharpening knives, but would not do for sharpening scissors, and for this reason Lord *Tenterden*, C. J., held that the patent was void.

So also in the case of *Bainbridge* v. *Wigley*, (*t*) in which it appeared that the patent was for improvements on the flageolet or English flute. In the specification it was stated that by the improvements the instrument produced *notes* not before produced on the old instrument. It also appeared in evidence that the invention was a great improvement, but only *one* new note was produced. Lord *Ellenborough*, C. J., held that this was fatal to the patent, the consideration on which it was granted not being truly stated. For the patentee had stated that by his improvement he had given new *notes*, when in fact he had given but one new note. (*u*)

It is to be observed, that in each of the cases of *R.* v. *Metcalfe*, (*x*) *Felton* v. *Greaves*, (*y*) and *Bainbridge* v. *Wigley*, (*z*) just cited, the patentee had made a false representation to the Crown respecting his invention, and that false representation avoided the patent. (*a*)

22. If an invention be properly and sufficiently described in a specification, it seems that if any unnecessary matter which may have been inserted will not vitiate the specification, if the public is not misled in any way, but will be rejected as surplusage.

(*s*) 3 C. & P. 611.
(*t*) Parl. Rep. 1829, p. 197.
(*u*) Sed vide Nickels v. Haslam, 8 Jur. 474, cited *ante*, p. 163.
(*x*) 2 Stark. R. 249.
(*y*) 3 C. & P. 611.
(*z*) Parl. Rep. 1829, p. 197.
(*a*) Vide *ante*, Chap. IV. p. 48, and in this Chap. p. 178.

Thus, in the case of *Boulton* v. *Bull*, (*b*) Lord Chief Justice *Eyre* said, that if there was a specification which went to the subject of the invention as described in the patent, he thought that the rest might very well be rejected as superfluous.

[*184] 23. But if the specification describes more than the *invention itself, it must clearly point out which of the things described are old and which of them are new. And if the subject of the patent privilege be an addition to, or an improvement upon, an old machine or other article, the specification must not describe the whole machine or article without distinguishing between the old and the new parts. For the proviso in the patent (*c*) requires that the invention shall not only be ascertained, but ascertained with particularity, and it is impossible to contend that an invention is so ascertained by a specification, if it describes without distinction many things which are old, as well as the invention itself.

Thus, in the case of *Williams* v. *Brodie*, (*d*) the invention was an improvement upon an old stove, but in the specification the whole stove was described, including both the old and the new parts, without describing the invention as a new improvement upon an old thing, and it was held that the patent was therefore void.

In the case of *Manton* v. *Manton*, (*e*) Lord Chief Justice *Gibbs* said, that in order to support a patent, the party who takes it out must show that he has accurately explained the nature of his invention in his specification, *separating that which is new from that which is old.*

In the case of *Hill* v. *Thompson*, (*f*) Lord *Eldon*, L. C., said, that there may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. But in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of the materials.

And in *Hill* v. *Thompson*, (*g*) in the Court of Common Pleas, the Lord Chief Justice *Dallas* said, "This, like every other patent, must undoubtedly stand on the ground of improvement or discovery. If of improvement, it must stand on the ground of improvement invented; if of discovery, it must stand on the ground of the discovery of something altogether new; *and the patent must distinguish and adapt itself accordingly.* *If the patent be taken out for discovery, when the alleged discovery is merely an addition or improvement, it is scarcely necessary to observe that it will be altogether void."

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So in the case of *Minter* v. *Wells*, (*h*) the invention claimed was the application of self-adjusting leverage to the back and seat of a chair, and Mr. Baron *Alderson* held, that if any self-adjusting leverage had been, before the plaintiff's patent, applied to a chair, the patent would be void, because the specification, by describing self-adjusting leverage, generally claimed too much.

In the case of *Carpenter* v. *Smith*, (*i*) Lord *Abinger*, C. B., laid it down that a patentee should state in his specification what he claims to be new, and what he admits to be old; for if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and does not state that he claims either a particular part, or the combination of the whole as new, then his patent must be taken to be a patent for the whole, and for each

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(*b*) Dav. P. C. 216.
(*c*) Vide *ante*, p. 151, 155.
(*d*) Dav. P. C. 96, 97.
(*e*) Ibid. 349.
(*f*) 3 Mer. 622.
(*g*) 8 Taunt. 375; 2 B. Mo. 448.
(*h*) 1 Webs. R. 130.
(*i*) Ibid. 532.

particular part, and his patent will be void if any particular part turns out to be old, or the combination itself is not new.

In the case of *Macfarlane* v. *Price*, (*k*) it appeared that the patent was for an invention of improvements in the making of umbrellas and parasols. The specification professed to set out the improvements as specified in certain descriptions and drawings annexed. The subjoined description contained a minute detail of the construction of umbrellas and parasols, partly including the usual mode of stretching the silk of the umbrella by means of metallic stretchers or rods attached to a tube moveable along the stem, and also certain improvements, which consisted chiefly in the insertion of the stretchers, which were knobbed at the end, in sockets formed in the whalebone, instead of attaching them to the whalebone in the usual way, by means of forked ligaments, which came in contact with the silk, the advantage of which was, that by the specified mode, the bone being interposed between the stretcher and the silk, the stretcher did not wear the silk in spreading the umbrella, as it was apt to do in umbrellas of the old construction, where the stretcher came in contact with [*186] *the silk. Some other advantages, of minor importance, were also stated, and drawings were given of the umbrellas and parasols in their improved state. Throughout the whole specification, no distinction was made between what was new and what was old. Upon an objection taken by the defendant that the specification was insufficient, it was contended for the plaintiff that the specification was sufficient, since one of the annexed drawings contained a representation of the particular invention which had been pirated, and was confined to the exhibition of the insertion of the knobbed stretchers in the whalebone sockets, from which an artist would be able to construct an umbrella on the improved plan But Lord *Ellenborough*, C. J., said, "The patentee in his specification ought to inform the person who consults it what is new and what is old. He should say, My improvement consists in this, describing it by words if he can, or if not, by reference to figures. But here the improvement is neither described in words nor by figures, and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new, and what was old. The specification states that the improved instrument is made in manner following: this is not true, since the description comprises that which is old as well as that which is new. Then it is said, that the patentee may put in aid the figures, but how can it be collected from the whole of these in what the improvement consists. A person ought to be warned by the specification against the use of the particular invention; but it would exceed the wit of man to discover from what he is warned in a case like this." And his Lordship held, that the patent was void, and nonsuited the plaintiff.

In the case of *The Queen* v. *Nickels*, (*l*) the patent had been obtained for an invention intituled, "improvements in machinery for recovering fibres applicable in the manufacture of braid and other fabrics;" the defendant's specification commenced in the usual form, viz: by declaring that the nature of the invention, and the manner in which it was to be performed, were "described and ascertained in and by the following statement thereof, reference being had to the drawing *annexed, and to the figures and letters marked thereon (that is to say,) the invention relates "to certain improvements in, or additions to, the apparatus or parts constituting what is called braiding or plaiting machines, whereby I am enabled," &c. The defendant then proceeded to describe different kinds of braided fabrics which the machinery would produce, after which he proceeded as follows: "The construc- [*187]

(*k*) 1 Stark. R. 199. (*l*) MS.

tion of braiding or plaiting machinery, wherein all the threads partake of like movements, and all aid in forming the fabric of plaited threads, being well known in the manufacture of braids, it will not be necessary to enter into a long description of the same. *All that will be required to make the invention clear, and enable a workman acquainted with such machinery, readily to perform my invention.*" It would be expected from this, that the specification was about to declare what it is, which would be sufficient to enable a workman to perform the invention; but the sentence is not completed, the patentee merely proceeding to say "which is (*m*) only applicable to such machines as work with four or more heads or circular tables for actuating a system or series of bobbins," &c. The specification then proceeded to describe the uses of the machinery for making the various fabrics which it was intended to produce, after which it described the drawing annexed. The specification did, in fact, describe the whole of the machinery, including both the old parts, and those claimed by the patentee to be new; but it did not in any part of it point out which of the parts were new, and which of them were old. At the end of the specification the defendant stated, that he made no claim to any of the parts of the apparatus constituting the machine separately, nor combined so far as the same had been before known; but there was nothing in the specification which could enable any person to ascertain to which of the parts of the machinery the disclaimer was intended to apply. It was objected by the counsel for the prosecutor, that the specification was insufficient, because it clearly appeared upon [*188] the face of it that some parts of the machinery described *were old, and there was no part of that document which either pointed out what was the new invention claimed by the patentee, or the old parts which he disclaimed. It was contended for the defendant, that he was at liberty to give evidence to show what was new and what was old; but the cases of *The King* v. *Wheeler*, (*n*) and *Neilson* v. *Harford*, (*o*) were cited to show that the construction of the specification was for the Court, and not the jury, and that such evidence was not admissible. Lord *Denman*, C. J., adopted the language of Lord *Ellenborough*, in the case of *Macfarlane* v. *Price*, (*p*) and said, that the alleged improvements were not sufficiently ascertained or described, either by words or by figures, and that it would not be in the wit of man to discover from the specification what was new, or what was old, or what he was warned from doing. His Lordship also held, that parol evidence was not admissible to explain the specification, and show what was new, and he directed the jury to give a verdict for the Crown, which was done accordingly.

24. The patentee must not in the specification claim more than is granted by the patent, or more than he is fairly entitled to; and if he attempts to appropriate more to himself than he is actually entitled to, the grant of privilege contained in the patent will be wholly void.

Thus in the case of *Hill* v. *Thompson*, (*q*) Lord *Eldon*, L. C., said, that the specification must not attempt to cover more than that which is the only proper subject for the protection of a patent. And his Lordship said, that he was compelled to add, that if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled.

In the case of *The King* v. *Elsee*, (*r*) the patent was for a new invented manufacture of lace called French or ground lace. The specification went

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(*m*) These words, "which is," &c., follow immediately after the portion of the specification ending with the words "perform my invention," as given above.

(*n*) 2 B. & Ald. 345.

(*o*) 8 M. & W. 806.

(*p*) 1 Stark. R. 199, cited *ante*, p. 185.

(*q*) 3 Mer. 622.

(*r*) Dav. P. C. 144.

generally to the invention of mixing silk and cotton thread upon the frame. On the part of the prosecutor it was clearly shown that, prior to the patent, *silk and cotton thread had been used together, and intermixed upon the same frame, and the defendant's counsel acknowledged the fact; but said he could prove clearly that the former method of using the silk and cotton thread was quite inadequate to the purpose of making lace, on account of its coarseness, and that the defendant alone had invented the method of intermingling them, so as to unite strength with firmness. Mr. Justice *Buller* said, "It will be to no purpose. The patent claims the exclusive liberty of making lace composed of silk and cotton thread mixed, not of any particular mode of mixing it, and therefore, as it has been clearly proved and admitted that silk and cotton thread were before mixed on the same frame for lace in some mode or other, the patent is clearly void, and the jury must find for the Crown." And a verdict was given for the Crown accordingly. [*189]

So in the case of *Minter* v. *Mower*, (*s*) the Court of Queen's Bench held the patent to be void, because the specification claimed more than the patentee had invented, and would have included something which was known before the date of the patent.

In *Jessop's* case, (*t*) the patent was held to be void, because it extended to the whole watch, and the invention was of a particular movement only. And in *Boulton* v. *Bull*, (*u*) Mr. Justice *Buller* said, that when a patent is taken for an improvement only, the public have a right to purchase that improvement by itself, without being incumbered with other things. So in the case of *Losh* v. *Hague*, (*x*) Lord *Abinger*, C. B., said, a man can always take out a patent for a new improvement, but when he makes his specification, he must take care that he does not put among his improvements that which another man had before made, or had got a patent for.

In the case of *Huddart* v. *Grimshaw*, (*y*) Lord *Ellenborough*, C. J., said, that if a patentee in his specification oversteps his right, and appropriates more than is his own, he cannot avail himself of it. And if he states that which of itself is not new, but old and known to the world, though it was unnecessary for him to do so, yet having done so, he has overstepped *his right, and has included in his patent that which is not his invention, and his patent would be void. [*190]

In the case of *Campion* v. *Benyon*, (*z*) the Court of Common Pleas held the plaintiff's patent to be void, because it had been taken out for more than he had invented or discovered.

In the case of *Bovill* v. *Moore*, Lord Chief Justice *Gibbs* laid it down, (*a*) that if the patentee in his specification had exceeded the limits of what he had invented, and of which he was entitled to the sole privilege, though in other respects there might be no objection to his patent, that would overturn it, for he would not then have registered (enrolled) a specification of his invention, it would be irregular in having exceeded the limits of the invention. And his Lordship afterwards said, that if the patentee had, in his specification, asserted to himself a larger extent of invention than belonged to him: if he stated to himself to have invented that which was well known before, then the specification would be bad, because it would affect to give him, through the means of the patent, a larger privilege than could legally be granted to him. In this case the invention was stated to be of a machine or machines for manufacturing lace,

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(*s*) 6 A. & E. 735.
(*t*) Dav. P. C. 203.
(*u*) Ibid.
(*x*) 1 Webs. R. 206.
(*y*) Dav. P. C. 279.
(*z*) 6 B. Mo. 71; and see the words of Richardson, J., ibid. p. 86.
(*a*) Dav. P. C. 398.

and the specification described the whole machine, without pointing out any particular part or parts of it, as the invention of the patentee. And the Lord Chief Justice held, (*c*) that if a combination of a certain number of the parts of the machine up to a given point had existed before the date of the patent, and if the patentee's invention sprung from that point, and added other combinations to it, then the specifications stating the whole machine as his invention was bad. And his Lordship left it to the jury to say whether they thought the patentee had in his specification described an invention to a greater extent than the proof went to establish. And his Lordship said, in answer to an observation by a juryman, that even if the patentee had claimed too much inadvertently, and not fraudulently, yet he must answer for his inadvertence. The jury found a verdict for the defendant, and upon a motion for a new trial, the Court of *Common Pleas approved of the direction given to the jury by the Lord Chief Justice, and refused to grant even a rule *nisi*. (*d*)

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It is no objection to a specification, however, that the patentee has described in it improvements which he has made between the date of the patent and the date of the specification. And indeed it seems rather to be the patentee's duty to give the public the full benefit of all his knowledge respecting the invention at the time when he specifies it. (*e*)

There is one case, *Harmar* v. *Playne*, (*f*) in which it was held, that a specification was sufficient, although it could not be ascertained what the patentee's improvements were, except by comparing the specification with a prior specification which had been enrolled by the same patentee, and to which he referred. The circumstances of that case were peculiar, and the decision does not break in upon the principle of any of the cases which have been cited.

In *Harmar* v. *Playne*, (*f*) a case was stated by the Lord Chancellor for the opinion of the Court of King's Bench, from which it appeared that "by letters patent dated 20th March, 1787, the King granted to John Harmar, the plaintiff, for fourteen years, the sole privilege of making, using, and vending a certain machine by him invented for raising a shag on all sorts of woollen cloths, and cropping or shearing them, which, together, come under the description of dressing woollen cloths; and also for cropping and shearing of fustians, with the usual proviso or condition for avoiding the patent on failure of enrolling a specification. In pursuance of this proviso, Harmar duly enrolled a specification of the said invention, with drawings of the machine in the margin thereof. On the 29th March, 1794, his Majesty granted another patent to Harmar, whereby, after reciting that Harmar had obtained letters patent of the 20th March, 1787, authorizing him to make, use, and vend his invention of a machine for raising a shag on all sorts of woollen cloths, &c., for fourteen years; and further, that he had invented considerable improvements in the said machine, for which improvements in the said *machine he prayed his Majesty's letters patent for the exclusive enjoyment thereof for fourteen years, pursuan' to the statute; the letters patent, therefore, granted to him the sole privilege and authority to make, use and vend his said invention, and have the whole profit thereof. The letters patent also contained a proviso that if Harmar should not particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in the Court of Chancery, within one calendar month next, and immediately after the date of the said letters patent, then they should become void. In pursuance

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(*c*) Ibid. 413. (*d*) 2 Marsh. 211.

(*e*) Vide *ante*, p. 168, and the cases of Crossley v. Beverley, and Jones v. Heaton, there cited.

(*f*) 11 East, 101: and Dav. P. C. 311, S. C.

of this proviso, Harmar did, in due time, enrol a specification in Chancery, with drawings of the machine in the margin thereof: the introductory part of which specification was as follows: 'To all to whom, &c., I, John Harmar, of Sheffield, send greeting, Whereas his Majesty, by his letters patent, dated the 29th day of March, in the thirty-fourth year of his reign, hath granted to me his special license, &c., that I, my executors, administrators and assigns, at all times during the term of years therein expressed, should and lawfully might make, use, and vend the machine by me invented and found out, for raising a shag on all sorts of woollen cloths, &c., and that I should enjoy the whole profit, &c., of the said invention for fourteen years, from the date of the said letters patent, according to the statute, &c. And whereas in the said letters patent there is a proviso or condition, that if I, the said John Harmar, should not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under my hand and seal, and cause the same to be enrolled in the Court of Chancery within one calendar month after the date of the said letters patent, that then the said letters patent, and all liberties, &c., thereby granted, should be void. Now, know ye, that in obedience to the said letters patent, and proviso therein contained, I, the said John Harmar, do, by these presents, particularly describe and ascertain the nature of the said invention, referring to the drawings in the margin of these presents, which I explain as follows." The specification then proceeds under different letters of the *alphabet, corresponding with similar letters on the drawing, to set forth a full description of the whole of the machine; and the specification ends with these words: "And I, the said John Harmar, do hereby declare that my said invention is intended to be worked in the manner hereinbefore particularly mentioned." *It was admitted by the defendant*, that the improvements for which the second patent was granted are included in the general description of the second or improved machine, as set forth in the specification of the second patent; and *that the second specification does contain a full and proper description of the whole machine in its improved state.* But the second specification does not in any manner point out or describe the improvements upon the former machine by any verbal description, or by any delineation or mark in the drawing; and which drawing is not a representation of the improvements alone, but of the whole machine in its improved state; nor are the improvements in any manner substantively and individually explained by the second specification; nor is the machine in the improved state contradistinguished from the state and condition of it under the former patent by any explanation whatever, nor by any delineation or mark in the drawing. *But what the former machine was, and what were the said improvements thereupon, are ascertainable and appear by referring to the first specification and the drawings thereon, and comparing the second specification and the drawings thereon with the same.* The defendants insisted that the second specification was not a due performance of the condition of the second patent; and the question, therefore, for the opinion of the Court was, whether the proviso or condition in the letters patent of the 29th of March, 1794, had been duly performed by the enrolment of the said specification thereof."

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It was contended for the patentee, that as the second patent and specification referred to the first, and therefore directed a party to the source from which information might be obtained, the second specification was a "sufficient compliance with the condition in the patent. *That the patentee had only an exclusive right to the whole combination for which his (second) patent was granted, and the use of particular parts only would be no breach of his rights; that the description, therefore, of the particular improvements, distinct *from the parts in general use before, would be*

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useless to all, and less intelligible to many." During the course of the argument, Lord *Ellenborough*, C. J., said, "The difficulty which presses most is, whether this mode of making the specification be not calculated to mislead a person looking at it, and induce him to suppose that the term for which the patent is granted may extend to preclude the imitation of other parts of the machine than those for which the new patent is granted; when he can only tell by comparing it with some other patent what are the new and what are the old parts: and if this may be done by reference to one, why not by reference to many other patents, so as to render the investigation very complicated? It may not be necessary, indeed, in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement; but, on many occasions, it may be sufficient to refer generally to them. As in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them." For the defendant it was contended that the specification ought to have informed the public what the thing was for which the patent was granted, and how it was to be made, and not merely inform them where else that information was to be acquired, as that would not be a compliance with the condition in the patent. And also that the true sense of the condition was to give the public direct and complete information of the manner of executing the invention, without further search or trouble. Mr. Justice *Le Blanc* said, "There lies the difficulty; for, suppose the specification had merely described the improvement, such as the addition of a crank or a screw to such or such a part, must not the party still have referred to the original specification, or at least have brought a full knowledge of it with him, before he could understand truly how to adopt the new parts described to the old machine?"

Lord *Ellenborough* also said, "I own I was disposed to think that it was a departure from the terms of the proviso for the patentee merely to tell the inquirer who came to consult the specification, how he might learn what the [*195] invention was, instead of giving him that information directly. But *I feel impressed by the observation of my brother Le Blanc, that the trouble and labour of referring to and comparing the former specification with the latter, would be fully as great if the patentee only described in this the precise improvements upon the former machine. Reference must, indeed, often be necessarily made in these cases to matters of general science, or the party must carry a reasonable knowledge of the subject-matter with him in order clearly to comprehend specifications of this nature, though fairly intended to be made. We will, however, consider the case and certify our opinion."

The Court afterwards certified to the Lord Chancellor that they were of opinion that the condition in the second patent had been performed by the enrolment of the specification.

The reasons of the Court for their opinion in this case were not given, and therefore it is not quite certain whether they held the specification to be made good by the reference to the prior patent and specification, or whether the second patent was in fact not for the improvements themselves separate and apart from the former machine, but for the new combination of parts, (*h*) in which case the description of the entire machine was correct and proper. If the Court was of opinion that the patent was for the improvements separate and distinct from the previously known parts of the machine, then they must have held that the specification was made good by the reference to the prior patent. And if this be so, it is to be observed, that this case does not, as has

(*h*) See what was contended for the patentee, stated *ante*, p. 193.

been supposed, amount to a decision that parol evidence may be given to show which of the parts of the machinery were new and which were old. The specification must be deemed by the reference to include all that was contained in the former specification, *which is recorded in the same place as the second specification*, and the reference to the former patent and specification shows most clearly that the patentee did not intend in his second specification to claim those parts of the machinery which were comprised in the first, and which were therefore clearly old at the date of the second patent. The former parts then being in effect disclaimed, and it being admitted by the defendant *that the specification did sufficiently describe all parts of the machinery, the only effect of the decision in *Harmar* v. *Playne* is, [*196] that reference being made to a former specification which is contained amongst the records of the same Court as the second, the first specification may be used as evidence to show which of the parts or things mentioned in the second specification are not intended to be claimed as part of the second invention.

In specifying an invention, it is generally necessary, in order to make the instrument intelligible, to describe things which form no part of the invention; and it has consequently become usual, at the end of a specification, to insert a clause, whereby the patentee particularly points out all that he claims as his invention, or disclaims all that is not of his invention; and many specifications contain both a claim and a disclaimer.

Any material mistake in the claim or disclaimer, in a specification, is fatal: the patentee cannot be entitled to anything more than he claims, and if he claims more than he ought, the patent is void.

In the case of *The King* v. *Cutler*, (*i*) the defendant's invention was materially different from what was known before the date of the patent, but in summing up his claim, he confined himself to that which was old, and his patent was, consequently, held to be void.

In the case of *The King* v. *Elsee*, (*k*) the patentee made his claim too extensive, and his patent was, therefore, held to be void.

So also the patents were held to be void by reason of the claims being too extensive in the cases of *Campion* v. *Benyon*, (*l*) *Bovill* v. *Moore*, (*m*) *Minter* v. *Mower*, (*n*) and several other cases.

And in the case of *Saunders* v. *Aston*, (*o*) the specification omitted to claim the only thing which was new, and the patent was held void.

The various cases which have been cited show the requisites of a specification as a performance of the condition contained in the patent, in pursuance of which it is enrolled. The *general rule for the construction of a specification, (the object or purpose of the instrument being borne [*197] in mind,) is precisely the same as that which applies to all other instruments, and which was so clearly expressed by Lord *Ellenborough*. C. J., in the case of *Robertson* v. *French*, (*p*) in which that eminent judge, speaking of a policy of assurance, said, "The same rule of construction which applies to all other instruments applies equally to this instrument, of a policy of insurance, viz: that it is to be construed according to its sense and meaning, as collected in the first place from the terms used in it, which terms are themselves to be understood in their plain, ordinary, and popular sense, unless they have generally, in respect to the subject-matter, as by the known usage of trade, or the like, acquired a peculiar sense distinct from the popular sense of the same words; or, unless the context evidently points out that they must, in the particular in-

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(*i*) 1 Stark. R. 354, cited *ante*, p. 163.
(*k*) Dav. P. C. 144.
(*l*) 6 B. Mo. 71.
(*m*) Dav. P. C. 361.
(*n*) 6 A. & E. 735.
(*o*) 3 B. & Ad. 881.
(*p*) 4 East, 135–136.

stance, and in order to effectuate the immediate intention of the parties to that contract, be understood in some other special and peculiar sense."

Specifications and patents were formerly construed more strictly against patentees than they are now, which induced Lord *Tenterden*, C. J., in the case of *Hullett* v. *Hague*, (*q*) to say, "I cannot forbear saying, that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them."

In the case of *Russell* v. *Cowley*, (*r*) Mr. Baron *Parke* said, in giving judgment, that, "In the construction of a patent, the Court is bound to read the specification so as to support it, if it can fairly be done." Mr. Baron *Alderson* concurred, and said, "We ought not to be astute to deprive persons of the benefits to be derived from ingenious and new inventions."

The use of words in an improper sense will not vitiate a specification if the intention be clear, and the public is not misled.

In the case of *Bloxam* v. *Elsee*, (*s*) the specification contained several Gallicisms; as, the French word "vice," for a screw, &c.: but the specification does not appear to have been held bad on that ground.

[*198] *So in the case of *De Rosne* v. *Fairrie*, (*t*) the patentee, who was a Frenchman, in his specification, used the word "discolouring," to signify depriving of colour, and the word "baked," instead of the word crystalized, but the specification, was not held to be defective on that ground.

And in the case of *Neilson* v. *Harford*, (*u*) the Court of Exchequer construed the word effect in one part of the specification as meaning beneficial effect, because it was evidently used in that sense in some other parts of the specification. (*x*) And Lord *Lyndhurst*, L. C., afterwards approved of that construction of the specification. (*y*)

(*q*) 2 B. & Ad. 377.
(*r*) 1 Cr. M. & R. 864.
(*s*) 1 C. & P. 563, 568.
(*t*) 5 Tyr. 393; 2 C. M. & R. 476.
(*u*) 8 M. & W. 806.
(*x*) And see Neilson v. Harford, 1 Webs. R. 340, 369.
(*y*) 1 Webs. R. 373.

*CHAPTER VIII. [*199]

OF THE CONFIRMATION OF PATENTS, AND THE ALTERATION AND AMENDMENT OF PATENTS, SPECIFICATIONS, AND ENROLMENTS.

SECT. I.—*Of the Confirmation of Patents under the Stat.* 5 & 6 *Will. IV. c.* 83, *sec.* 2.
II.—*Of the Alteration of Patents and specifications by Memorandum or Disclaimer under the Stat.* 5 & 6 *Will. IV. c.* 83, *sec.* 1.
III.—*Of the Alteration and Amendment of Patents, Specifications, and Enrolments at Common Law.*

SECTION I.

Of the Confirmation of Patents under the Statute 5 & 6 *Will. IV. c.* 83, *sec.* 2.

IT has been shown in a former part of this work, (*a*) that a want of novelty in the whole or any part of an invention which is made the subject of a grant by patent, renders the patent entirely void. And if it can be shown that a description of any part of the invention was contained in any document published in any part of Great Britain or the colonies before the date of the patent, the patent cannot be sustained, even if it be shown that the invention has not been used in any way whatsoever. Thus if any part of the invention was described in a work printed and published in British North America before the grant of the patent, the patent is void, even if the invention has never been known or used in England. (*b*)

This strict rule of the law was, in some cases, productive of great hardship, but until the passing of the statute 5 & 6 Will. IV. c. 83, the patentee was without remedy.

By section 2 of that statute it was enacted, "That if in *any [*200] suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same or some part thereof before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some parts thereof, before the date of such letters patent, it shall and may be lawful for such patentee, or his assigns, to petition his Majesty in council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council; and such committee upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof had not been publicly and generally used before the date of such first letters

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(*a*) *Ante*, Chap. V. s. 2, p. 102.
(*b*) See Brown v. Annandale, 1 Webs. R. 433.

patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in Law and Equity to give to such petitioner to sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same."

This provision of the act is only intended to apply to cases in which it shall appear that the patentee at the time he obtained his patent was ignorant of his title being defective, and believed himself to be the *first and original* inventor.

If the defect in the patentee's title arise from the circumstance of his not having been a *true and actual* inventor, he cannot have been ignorant of the fact, and the statute is inapplicable to such a case. (*b*) But if the patentee did actually *make the invention, and if at the time when he obtained his patent, he did really believe that he was the *first* inventor, he is enabled by the act upon discovering that he was not the *first* inventor, to petition for a confirmation of his patent.

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The defects which may be cured by a confirmation are such as arise out of the fact of an invention having been invented or used before the date of the patent. A confirmation would therefore obviate any objection to a patent, either on the ground of the patentee not being the *first* inventor, or the invention not being new at the date of the patent, provided the invention or some part of it had not been publicly *and* generally used before the date of the patent.

A confirmation is to render the patent available to give the petitioner "the sole right of using, making, and vending the invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding." Although these words are very general and would seem to cure any defect in the patentee's title, yet it is evident that the intent is that a confirmation should only have the effect of obviating objections arising from the invention having been invented or partially used before the date of the patent, leaving the patent still open to all other objections to which it may be liable.

The granting of a confirmation is entirely discretionary with the Judicial Committee of the Privy Council, and will only be exercised in extreme cases, and where the confirmation will not prejudice any existing rights.

In *Baron Heurteloup's* case, (*c*) it appeared that the petitioner had, in May, 1834, obtained a patent for an invention of "improvements in certain parts of certain descriptions of fire-arms." A portion of the invention consisted of a small tube made of soft metal, and filled with detonating powder for priming the gun, the end of the tube being advanced to the touch-hole by the action of cocking the gun, while a small piece is cut off just by the touch-hole, and detonated there by the falling of the hammer, without exploding the powder in the remaining part of the tube. The petitioner had discovered that a prior patent was granted in France to one Valdahon for an invention, part of which consisted of a straw filled with *detonating powder brought to the touch-hole of the gun, and cut off, as required, to prime and fire; but the mode of bringing the straw tube to the touch-hole was totally different from the petitioner's, and did not constitute the gun a self-priming gun. Valdahon's invention had never been used in France, England, or elsewhere, and

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(*b*) Vide *ante*, Chap. III. as to who is the true and first inventor of an invention within the meaning of the law.

(*c*) 1 Webs. R. 553.

was not known in England otherwise than by a French work, a copy of which had been deposited in the British Museum two years before the date of the petitioner's patent. Under these circumstances, the Judicial Committee of the Privy Council, after notice to Valdahon, recommended a confirmation of the petitioner's patent, which was granted accordingly.

In *Wells'* case, (*d*) it appeared that the petitioner was assignee of a patent, granted in May, 1831, to Gibbins and Westrupp, for an invention of "improvements in an apparatus for converting sea water, or otherwise impure water, into fresh and pure water." The application was opposed on the ground that part of the invention had been published many years before the patent in a well known book, and had also been made the subject of two prior patents, but had not been publicly or generally used. It was also objected, that the petitioner's proper remedy was by disclaimer of that part of the invention which was old. (*e*) Lord *Lyndhurst* said, that he did not think the clause of the act was ever intended to apply to the case where the patentees chose to shut their eyes, when they might have gone to the office and seen the prior specifications. The act could never be intended to apply to a case when two patents have been taken out for the same thing, that the subsequent patentee should have a right to come to the Court to apply to have the exclusive benefit of the invention adversely to the rights and interests of the former patentee. And the petition was dismissed with costs.

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*SECTION II. [*203]

Of the Alteration of Patents and Specifications by Memorandum or Disclaimer under the Statute 5 *&* 6 *Will. IV. c.* 83, *s.* 1.

If a patent is granted for two inventions, and either of them does not possess the requisite degree of novelty, the patent is entirely void, and cannot be sustained for the other invention, even if it be perfectly free from objection. So if any part of what a patentee claims by his specification as part of his invention, was not new at the date of the patent, the patent is entirely void. (*f*) When the title of an invention is inaccurate, and misdescribes the invention in any one respect, the patent is void on the ground of a misrepresentation, although there may have been no intention whatsoever to deceive either the Crown or the public. (*g*)

And if a specification is insufficient as to any part of the invention comprised in the patent, or if it contains any mis-statement respecting any material particular relating to the invention (however inadvertently inserted) the patent is entirely void. (*h*)

Before the passing of the statute 5 & 6 Will. IV. c. 83, such defects as these were incurable, and there are several instances of parties losing the benefit of highly meritorious inventions in consequence of such objections being taken to part of the invention which were perfectly immaterial to the real merits of the case. This was a great defect and a serious reproach to our Patent Law, but it has been to a great extent, if not wholly, removed by recent statutes.

(*d*) 1 Webs. R. 554.
(*e*) As to disclaimers, see the second section of this Chapter.
(*f*) As to the novelty of an invention, vide *ante*, Chap. V. p. 102.
(*g*) As to the title of an invention, vide *ante*, Chap. IV. p. 43.
(*h*) As to the requisites of a specification, vide *ante*, Chap. VII. pp. 151, 159, 162, 178.

By section the first of the statute 5 & 6 Will. IV. c. 83, (*i*) it was enacted, (so far as the enactment relates to England,) "That any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent, [*204] for the sole *making, exercising, vending, or using of any invention, may, if he think fit, enter with the Clerk of the Patents of England, having first obtained the leave of his Majesty's Attorney General or Solicitor General, certified by his fiat and signature,—a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer,—or may with such leave as aforesaid enter a memorandum of any alteration in the said title or specification; (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent) and such disclaimer or memorandum of alteration being filed by the said Clerk of the Patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent, or such specification in all Courts whatever: Provided always that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which caveat, being so entered, shall give the party entering the same a right to have notice of the application being heard by the Attorney General or Solicitor General respectively: Provided also that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled; but in every such action or suit the original title and specification alone shall be given in evidence, and deemed, and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also that it shall be lawful for the Attorney General, or Solicitor General, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such Attorney General or Solicitor General shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made."

There are two proceedings made available to a patentee under this section of this act:—*firstly*, a *disclaimer* by means of which he may get rid of any objectionable part either of the title in the patent, or of the description in the specification; and, *secondly*, a *memorandum of alteration* by which he may cure any misdescription of the invention either in the patent or in the specification.

[*205] *1. *Disclaimer.*

A disclaimer may be entered by any person, who, as "grantee, assignee, or otherwise," has *obtained* a patent.

In the construction of this part of the enactment it was decided, in the case of *Spilsbury* v. *Clough*, (*k*) that a patentee who had assigned over the whole of his interest in his patent, and afterwards obtained a re-assignment of a portion only, is competent to enter a disclaimer under the act of Parliament. Mr. Justice *Patteson* in that case expressed an opinion that the patentee is the proper person to enter a disclaimer under the act, even if he have parted with all his interest in the patent, assignees being in the opinion of that learned Judge, and also the rest of the Court, sufficiently protected by the power given them to enter *caveats* and oppose a disclaimer before the Attorney or Solicitor General.

(*i*) See the statute in the Appendix, Chap. I. s. 1.
(*k*) 2 Q. B. 466.

The opinions expressed by the Judges in the case of *Spilsbury* v. *Clough*, (*l*) just cited, raised great doubt whether an assignee of a patent was enabled to enter a disclaimer under the statute, but all doubt and difficulty on this subject has been obviated by the subsequent act of 7 & 8 Vict. c. 69; (*m*) by section five of which it was enacted, "That in case the original patentee or patentees hath or have departed with his or their whole, or any part of his or their, interest by assignment to any other person or persons, it shall be lawful for such patentee, together with such assignee or assigns, if part only hath been assigned, and for the assignee or assignees, if the whole hath been assigned, to enter a disclaimer and memorandum of alteration under the powers of the said recited act; and such disclaimer and memorandum of such alteration having been so entered and filed, as in the said recited act mentioned, shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be, or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever on the ground that the party making such disclaimer or memorandum of such alteration had not sufficient authority in that behalf.

*In order to enter a disclaimer, the leave of the Attorney or Solicitor General must be obtained, and the granting of leave is entirely discretionary with either of those officers to whom the application may be made. The leave to enter a disclaimer must be certified by the fiat and signature of the Attorney General, (*n*) before it can be entered by the Clerk of the Patents, or enrolled in the manner required by the act. [*206]

It is difficult to lay down any certain rule respecting the cases in which disclaimers are available or expedient. The power granted by the statute, is, however, chiefly applicable to cases in which patentees after they have obtained their patents or enrolled their specifications, find that they have included something for which a patent cannot be sustained. Thus, if a patentee finds that a part of his invention does not contain the requisite degree of novelty, he may by a disclaimer obviate an objection which would have the effect of avoiding his patent entirely. So if he finds that he has inadvertently omitted to describe in his specification a portion of the invention particularly mentioned in the title, that part of the title may be got rid of by a disclaimer.

Or if the patentee discovers that he has made his claim of invention more extensive than is warranted by the title, the redundant part may be disclaimed. (*o*) Want of utility in any part of an invention will render a disclaimer necessary, if the useless part be a separate portion of the invention, or if the utility of that particular part appears to have formed part of the consideration for the patent grant. (*p*) So if a portion of the invention will not produce the effects stated by the patentee, he may disclaim the objectionable part.

But a disclaimer must not be such as will extend the right granted by the patent. This was a very necessary provision to make for the protection of the public and subsequent patentees; for if a patentee's power of disclaiming had not been limited in this way, he might, under pretence of disclaiming something contained in the title or specification, really extend the operation of the patent much beyond the original invention for which it was granted.

*A party entering a disclaimer must take especial care that it does not violate the statute in this respect, for he enters the dis- [*207]

(*l*) Ibid.
(*m*) See the statute in the Appendix, Chap. I. s. 1.
(*n*) See the Forms in the Appendix, Chap. II. s. 2.
(*o*) As to the titles of inventions, see Chap. IV. *ante*, p. 43,
(*p*) See Chap. V. s. 3, p. 132, as to the utility of inventions.

claimer at his own peril, and if it be contrary to the statute, it will be void, notwithstanding the leave granted by the Attorney or Solicitor General. (*q*) And if a disclaimer does not come within the provision of the act in this respect, it will not only be void, but may be very prejudicial to the patentee. It may contain (amongst the reasons for the disclaimer) an admission that there is something comprised in the title or specification for which the patent cannot be sustained.

The disclaimer must show the reason for making it, as, for instance, that the patentee has discovered that the parts disclaimed were not new, or are not useful, or that they will not produce the effect stated, or that doubts are entertained respecting such matters. And it seems that a patentee is required to state his reason not only that the Attorney or Solicitor General may be better able to judge of the propriety of assenting to it, but also that the public may be better enabled to understand how it varies the effect of the patent.

Advertisements may be and frequently are required to be published, giving notice of the application for a *fiat*. (*r*) *Caveats* may be entered against leave being given to enter a disclaimer, and the application for leave may be opposed by parties who have entered *caveats*. This provision is intended not only for the benefit of the public, but also for the protection of assignees and licensees having an interest in the patent, (*s*) so that they may be enabled to oppose leave being granted to enter any disclaimer which may operate to their prejudice.

When the disclaimer is completed and the *fiat* obtained, it is to be filed by the Clerk of the Patents, and enrolled with the specification, and then it becomes in effect a part of the patent and specification to which it relates. But the entry of a disclaimer will not have the effect of making a void patent good, *ab initio*, as to the undisclaimed parts of the invention, so as to make any person a wrong doer by relation. This was decided in the case of *Perry* v. *Skinner*, (*t*) in [*208] which it was *held that although the act is obscurely worded, yet the intent could not have been to make a party a wrong doer by relation, and therefore that the act must be understood as if it had said that after a disclaimer had been filed and enrolled, the disclaimer should be "deemed and taken to be part of such letters patent, or such specification, *from thenceforth* in all Courts whatsoever." The chief difficulty in construing this section of the act of Parliament arises from the introduction of the proviso that a disclaimer should not be receivable in evidence in any action (except an action of *scire facias*) pending at the time when it is enrolled, and which would seem to be unnecessary if a disclaimer could not affect any thing done prior to the enrolment. But notwithstanding this difficulty, the Court of Exchequer held, in the case of *Perry* v. *Skinner*, (*u*) just cited, that an act of Parliament cannot be construed, so as make a party a wrong doer by relation unless the words showing such an intent are manifest and plain. The object of a disclaimer must always be to cure some defect in a patent, or obviate some doubt respecting its validity, and as it must state the reason why it is made, it will in some cases bear evidence upon the face of it of an admission by the patentee, that there was something for which he could not sustain the patent.

With respect to the disclaimed parts in such cases, it is clear that the patentee by the disclaimer abandons all right to them; and as to the residue of the invention, he will be debarred from proceeding against any one for a prior infringe-

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(*q*) See the observations of the Master of the Rolls in *re* Sharpe's patent, 1 Webs. R. 641.

(*r*) See the rules of practice on this subject in the Appendix, Chap. I. s. 2; see also the practice, *post* Chap. XII.

(*s*) See Spilsbury v. Clough, 2 Q. B. 466.

(*t*) 2 M. & W. 471.

(*u*) 2 M. & W. 471.

ment of the privilege, if he has admitted that it was void until the defect was cured by the disclaimer.

There may however be cases in which a disclaimer will contain no admission of the prior invalidity of the patent; and in such cases it seems that the disclaimer will not affect the patentee's right to recover damages for an infringement of the undisclaimed parts of the invention before the enrolment of the disclaimer. (*x*)

The proviso declares that a disclaimer is not to be receivable in evidence in any action or suit pending at the time it is enrolled, (except an action of *scire facias*) and that in such *actions or suits the original title and specification alone are to be given in evidence. The intent of this [*209] proviso is, that a patentee shall not be enabled to give a disclaimer in evidence to the prejudice of any party against whom he may then have any action or suit pending, but it could hardly be intended that the defendant in such a suit should not be at liberty to make use of a disclaimer as evidence against the patentee, if it contains any admission respecting the prior invalidity of the patent. In such a case the disclaimer shows that the supposed privilege which the defendant is alleged to have infringed had no legal existence at the time when the alleged infringement was committed, and the patentee ought not to be permitted to enfore a patent against a defendant which he admits contained something that rendered it void; and it may be that that part of the invention which the defendant is charged with pirating, may be the very part which the patentee has disclaimed.

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2. *Memorandum of Alteration.*

The provisions of the statutes 5 & 6 Will. IV. c. 83, and 7 & 8 Vict. c. 69, are precisely the same with respect to a memorandum of alteration as with respect to a disclaimer. The same persons who are enabled to enter disclaimers may also enter memorandums of alterations, provided they obtain the requisite leave.

A memorandum of alteration is available for the purpose of correcting any mistake or misdescription in the title of the invention, or in the specification, or for the purpose of explaining anything in the specification which is not sufficiently intelligible.

The patentee must be careful to see that any alteration he may seek to make, will not be such as, if valid, would have the effect of extending the exclusive right granted by the patent. The Attorney or Solicitor General will only examine a proposed alteration or disclaimer with a view to see how far it may affect the rights and interests of other parties, and the public in general, leaving the patentee to take care of his own interest, and if he enter a memorandum of alteration *which is not warranted by the statute, it will be void, [*210] and may be very prejudicial to his interests.

The provision in the act that a disclaimer or alteration shall not be such as to extend the patent right, must however be understood with some qualification; for if a disclaimer or memorandum of alteration has the effect of rendering a void patent valid, it may be said in one sense to extend the patent right. It seems that the true question in all cases will be, whether a disclaimer or alteration made by a patentee would have the effect of extending the patent privilege, if the patent were a valid patent at the time the disclaimer or alteration is filed

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(*x*) See per Tindal, C. J., in Stocker v. Waller, 9 Jur. 136.

and enrolled. If the disclaimer or alteration could not produce such an effect, then it would not be void as having a tendency to extend the patent right; but if the patent and specification, and the disclaimer or alteration, taken and construed together, purport or appear to be more extensive in effect than the patent and specification alone, then the disclaimer or memorandum of alteration is not warranted by the statute, and is therefore null and void.

The act requires that the reason for a disclaimer should be stated, but is silent with respect to any statement of the reason for an alteration, and that was probably because it would be difficult to make any alteration beneficially for the patentee, without the reason being apparent in some way or other. It is however usual in practice to state the reason why an alteration is made.

A proposed memorandum of alteration must be advertised in the same way as a disclaimer, and may be opposed in a similar manner. (*y*)

The observations which have been made (*z*) respecting the effect of a disclaimer apply also to a memorandum of alteration. It is clear from the express provisions of the act of Parliament, that a memorandum of alteration could not be used in evidence in any action pending at the time it was enrolled. But if the alteration which has been made does not show that the patent was void before the making of the alteration, there does not seem to be any reason for concluding that the memorandum of alteration should have the effect of depriving *the patentee of any remedy against prior infringers. (*a*) Thus suppose a patentee to make an alteration for the purpose of rendering his specification more clear and explicit, and obviating any doubt respecting its sufficiency, he does not admit the invalidity of his patent, but he thinks it prudent to provide against an adverse decision on a doubtful point. In such a case it would be hard to deprive a patentee of his remedy against parties for prior infringements, if it should turn out that the patent was really valid and sufficient without the alteration which he has only made by way of precaution. But if a patentee were under such circumstances to proceed against any person for a prior infringement, he must show that the patent was sufficient without the aid of the memorandum of alteration, which he could not be permitted to give in evidence, but the defendant would be at liberty to give the instrument in evidence against the plaintiff if it contained any admission respecting the prior invalidity of the patent.

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It frequently happens that a patentee desires not only to make a disclaimer, but also an alteration in some part of the title or specification of his invention; and in such a case the disclaimer and alteration may both be effected by one instrument.

SECTION III.

Of the Alteration and Amendment of Patents, Specifications, and Enrolments at Common Law.

The statute 5 & 6 Will. IV. c. 83, left untouched the Common Law power of altering and amending the entries and proceedings relating to patent grants; and there are several alterations and amendments which can only be made at Common Law.

(*y*) Vide *ante*, p. 204, and the rules in the Appendix, Chap. I. s. 2.
(*z*) Vide *ante*, p. 205.
(*a*) See Perry v. Skinner, and Stocker v. Waller, cited *ante*, p, 208.